



PROVISIONAL INSTITUTIONS OF SELF GOVERNMENT

**KUVENDI I KOSOVËS**  
**СКУПШТИНА КОСОВА**  
**ASSEMBLY OF KOSOVO**

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**Law No. 02/L-54**

**ON TRADEMARKS**

The Assembly of Kosovo,

Pursuant to the Chapter 5.1 (d) and 9.1.26 (a), of the Constitutional Framework for Provisional Self Government in Kosovo (UNMIK Regulation No. 2001/9 of 15 May 2001).

Recognizing the need to bring the registration, regulation and protection of trade marks in Kosovo generally into compliance with European Union requirements and internationally recognized best standards and practices regarding this field;

Hereby adopts the following,

**LAW ON TRADEMARKS**

**PART I**  
**GENERAL PROVISIONS**

**Article 1**  
**Purpose and Scope**

1.1. The purpose of the present law is to provide for the protection of trademarks, commercial designations in accordance with the requirements of international conventions and the law and practice of the EU and its member states.

1.2. The protection of trademarks, commercial designations and indications of geographic origin under the present law shall not exclude the application of other legal and regulatory provisions providing protection for these signs.

1.3. All persons, undertakings and public authorities are required to comply with the present law.

## Article 2 Definitions

2.1. Wherever used in the present law, the following terms and phrases shall have the following meanings unless the context within which such term or phrase appears clearly intends another meaning:

“**Agreement**” means any contract, agreement, understanding or arrangement, whether or not in writing.

“**Assignment**” means a written agreement providing for the assignment of the rights of one party to another party;

“**Court**” means the Competent Court in Pristina, Kosovo.

“**Official Gazette**” means the Official Gazette of the Government of Kosovo.

“**Paris Convention**” means the Paris Convention for the Protection of Industrial Property of 20 March 1883, as amended or supplemented by any protocol that is in force in the EU.

“**Convention Country**” means a country that is a party to that Convention.

“**Patent Office**” means the Patent Office established by Law No. 2004/49 of 27 September 2004, “Patent Law,” as promulgated by UNMIK Regulation No. 2004/56 of 21.12. 2004.

“**Person**” shall mean a natural person.

“**Present law**” means the present law and the subsidiary normative acts and instruments issued in furtherance of or under the authority of the present law, including the implementing rules issued pursuant to or under the authority of the present law.

“**Public authority**” shall mean any governmental executive authority, public body, ministry, department, agency, or other such authority that exercises executive, legislative, regulatory, administrative or judicial powers in Kosovo. The term “public authority” shall also include any otherwise private organization or establishment to the extent it exercises any of the afore-mentioned powers pursuant to a grant of authority under a normative or sub normative act or pursuant to a delegation of authority from another public authority.

“**Public enterprise**” shall mean a public authority or an undertaking owned, controlled or administered, in whole or in part, by a public authority, if such public authority or undertaking is engaged in the conduct of economic activity.

“**Commercial Designation**” means a company symbol or a title of a work as those terms are defined, respectively, in Article 5.2 and Article 5.3.

“**Trademark Register**” or “**Register**” means the Trademark Register established and maintained by the Patent Office in accordance with Part IV of the present law, described in Article 58.

“**Undertaking**” shall mean (i) any enterprise (including a personal business enterprise), public enterprise, business organization, partnership, joint venture, legal entity, association (including an association of undertakings), project, branch, office, or other organization or establishment (regardless of proprietorship, registration, domicile or place of business or establishment) that is engaged in economic activity, and/or (ii) any person acting on behalf of any of the foregoing.

“**Madrid Agreement**” means the Madrid Agreement concerning the International Registration of the Trade Marks.

“**Madrid Protocol**” means the Protocol relating to the Madrid Agreement concerning the International Registration of Trade Marks.

"**The International Bureau**" has the meaning given by Article 2 (1) of that Protocol; and

"**International trademark**" means a trademark that is entitled to protection in Kosovo under that Protocol.

2.2. More detailed definitions of the terms used in the present law, as well as definitions of other terms, may be established by or set forth in the by-laws implementing the present law; provided, however, that such more detailed definitions and definitions of other terms shall not impair the operation of any provision of the present law.

## PART II PREREQUISITES, SCOPE AND LIMITS OF PROTECTION OF TRADEMARKS AND COMMERCIAL DESIGNATIONS

### Chapter 1 Trademarks and Commercial Designations; Priority and Seniority

#### Article 3 Signs that may be protected as Trademarks

3.1. Any signs, particularly words, including personal names, designs, letters, numerals, audio marks, three-dimensional configurations, including the shape of goods or their wrapping or other packaging, including colors, or combinations of colors, that are capable of distinguishing the goods or services of one undertaking from those of other undertakings may be protected as trademarks.

3.2. A sign that consists exclusively of a shape shall not be protected as trade mark if such shape:

- a. results from the nature of the concerned good itself;
- b. is necessary to obtain a technical result; or
- c. gives substantial value to the concerned good.

3.3. References in the present law to a trademark include, unless the context otherwise requires, references to a collective mark within the meaning of Article 50 or a certification mark within the meaning of Article 51.

#### Article 4 Accrual of Trademark protection

The protections of the present law applicable to trademarks shall apply to a sign:

- a. that has been registered as a trademark in the Trademark Register in accordance with the present law;
- b. to the extent that such sign, through use in the course of business, has acquired a secondary meaning as a trademark within the affected trade circles; or
- c. that has acquired notoriety as a trademark within the meaning of Article 6bis of the Paris Convention.

Article 5  
Commercial Designations:

5.1. Company symbols and titles of works shall be protected as commercial designations.

5.2. A company symbol is a sign that is used in the course of trade as a name, firm name or special designation of an undertaking. A company symbol or other sign that is intended to distinguish one business from another and that is regarded within the affected trade circles as the distinctive sign of a business establishment shall be equivalent to the special designation of an undertaking.

5.3. A title of a work is the name or special designation of a printed publication, a cinematographic work, a musical work, a dramatic work or a comparable work.

Article 6  
Priority and Seniority

6.1. Where there is a conflict between or among the rights described in Articles 4, 5 and/or 12.4 and the seniority of such rights is relevant under the present law for determining the respective priority of each, such seniority shall be determined in accordance with Articles 6.2 and 6.3.

6.2. For a filed or registered trademark, the date of filing as determined in accordance with Article 38 shall be relevant for determining seniority or - if priority has been claimed pursuant to Article 40 or Article 41 - the date of priority.

6.3. For rights within the meaning of Articles 4 (items “b” and “c”), 5 and 12.4, the date of the acquisition of such rights shall be relevant for determining seniority.

6.4. If, pursuant to Articles 6.2 and 6.3, rights are determined to have the same seniority due to the same date shall rank equally and shall not have any superior right for each other.

Article 7  
Exhibition Priority

7.1. If the trademark applicant has displayed the goods or services designated by a specific sign at an official or officially recognized international exhibition in Kosovo or in any of the member States of the Paris Convention, he may request that the date of the first day of the exhibition of the goods or of services be accorded as the date of the first application, provided that he files the application in Kosovo, within six months as from that date.

7.2. The applicant invoking the exhibition priority right shall, in addition to the application he is filing with the Office, submit a certificate issued by the competent authority of the member State of the Paris Convention indicating the type of the exhibition, the venue thereof, its opening and closing dates and the first day of the exhibition of the goods or services specified in the application.

Chapter 2  
Prerequisites for the Protection of a Trademark by Registration

Article 8  
Proprietorship

8.1. The following may be a proprietor of a filed or registered trademark:

- a. a natural person;
- b. a legal person; or
- c. an undertaking that is not a legal person if it has the legal capacity to acquire rights and incur liabilities.

8.2. A registered trademark is a property right obtained by the registration of the trademark in accordance with the present law. The proprietor of a registered trademark shall have the rights and remedies provided by the present law.

Article 9  
Absolute Grounds for Refusal of Registration

9.1. As trade marks shall not be registered the marks that are composed by following characteristics:

- a. a trademark that is devoid of any distinctive character;
- b. a trademark that consists exclusively of signs or indications that may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or of the rendering of the services, or to designate other characteristics of the goods or services;
- c. a trademark that consists exclusively of signs or indications that have become customary in the current language or in the bona fide and established practices of the trade for designating goods or services;
- d. a trademark that is of such a nature as can reasonably be expected to deceive the public, in particular, as to the nature, quality or geographical origin of the goods or services;
- e. a trademark that includes the armorial bearings, flag or other emblem of a state;
- f. a trademark that includes the armorial bearings, flag or other official emblem of Kosovo, or of a municipality, association of communities or association of other communal entities lying within Kosovo;
- g. a trademark that includes an official sign, emblem or other hallmark, indicating control or warranty, of a public authority or public enterprise;
- h. a trademark that includes the armorial bearings, flag or other sign, seal or designation of an international intergovernmental organization;
- i. a trademark the use of which is contrary to other legal or regulatory provisions in Kosovo;
- j. a sign that is not capable of being represented graphically.
- k. trade mark that are against the moral and public order

9.2. The prohibitions against registration established by items “a,” “b” and “c” of Article 9.1 shall not bar the registration of a trademark if - before the date of the decision on registration and considering the use that has been made of it - such trademark has established itself in the affected trade circles as the distinguishing sign for the goods or services for which the trademark has been filed.

9.3. The prohibitions against registration established by items “e” through “h” of Article 9.1 shall also apply if the trademark includes the imitation of a sign specified in such items; however, the prohibitions against registration established by items “e” through “h” of Article 9.1 shall not bar the registration of a trademark if the applicant is authorized to include a sign described in such items in such trademark, even if it may be confused with a sign described in such items.

9.4. The prohibition against registration established by item “g” of Article 9.1 shall not bar the registration of a trademark where the goods or services for which the registration application has been filed are neither identical with nor similar to those for which the official sign, emblem or other hallmark, indicating control or warranty, has been introduced.

9.5. The prohibition against registration established by item “h” of Article 9.1 shall not bar the registration of a trademark if such trademark is not of such a nature as to falsely suggest to the public that a connection exists between the trademark and the international intergovernmental organization.

## Article 10 Relative Grounds for Refusal of Registration

10.1. The registration of a trademark shall be refused or cancelled:

a. If:

- (i) it is identical with an earlier filed or registered trademark and
- (ii) the goods or services for which registration is sought are identical with the goods or services covered by such earlier filed or registered trademark;

b. if, because of its identity with or similarity to an earlier filed or registered trademark and the identity or similarity of the goods or services covered by both trademarks, there exists a reasonable likelihood of confusion on the part of the public, including the likelihood that the public will associate the trademark for which registration is sought with the earlier filed or registered trademark; or

c. if:

- (i) the trademark is identical with or similar to an earlier filed or registered trademark,
- (ii) registration of the trademark is being sought for goods or services that are not similar to those covered by the earlier filed or registered trademark,
- (iii) the earlier filed or registered trademark has acquired a reputation in Kosovo, and
- (iv) the use of the trademark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier filed or registered trademark.

10.2. The registration of a trademark may be refused or canceled where another person, prior to the date relevant for the seniority of the registered trademark, has acquired an earlier right that confers on such person the power to prohibit the use by others of the concerned trademark in Kosovo. An earlier right within the meaning of this Article 10.2 includes:

- a. a right to a trademark within the meaning of item “b” of Article 4 or to a commercial designation within the meaning of Article 5; or
- b. a right other than a right described in Article 10.1 or item “a” immediately above, including - but not limited to - a right created by a law on copyright or registered designs or any law relating to a right to a name, a right of personal portrayal, a name of plant variety, an indication of geographical origin or an industrial property right.

10.3. Where by virtue of any such law or earlier right referred to in Article 10.2, a person or undertaking would be entitled to prevent the use of a trademark in Kosovo, that person or undertaking is in the present law referred to as the proprietor of an “earlier right” in relation to the trademark.

10.4. A trademark shall not be registered if:

- (a) it is identical with or similar to an earlier trademark, whether or not registered, that is well known in Kosovo within the meaning of Article 6bis of the Paris Convention, and
- (b) the criteria specified in item “a,” “b” or “c” of Article 10.1, are otherwise present. In determining whether the criteria specified in item “a,” “b” or “c” of Article 10.1 are present, the references to “filed or registered” in such items shall be ignored.

10.5. Nothing in this Article 10 shall prevent the registration of a trademark if the proprietor of the earlier or well known trademark or earlier right consents in writing to the registration.

## Article 11

### Trademark Registered without Proprietor’s Authorization

Where a trademark is registered, or is sought to be registered, without the proprietor’s written authorization, the registration of the trademark may be refused or cancelled.

## Article 12

### Earlier Trademarks and other Earlier Rights

12.1. In the present law an “earlier trademark” means:

- a. a registered trademark, an international trademark, or a Community trademark that has a date of application for registration earlier than that of the trademark in question, taking into account - where appropriate - the priorities claimed for the trademarks;
- b. a Community trademark that has a valid claim to seniority from an earlier registered trademark or international trademark, even when the latter trademark has been surrendered or allowed to expire; or
- c. a trademark that, at the date of application for registration of the trademark in question or - where appropriate of the priority claimed for the application, was entitled to protection under the Paris Convention as a well-known trademark.

12.2. The term “earlier trademark” shall also include an application for a trademark that would otherwise be considered an “earlier trademark” under item “a” and “b” of Article 12.1, subject to its approval and registration.

12.3. Where the registration of a trademark specified in item “a” or “b” of Article 12.1 expires, the trademark shall continue to be taken into account in determining the registrability of a later trademark for a period of one year after the expiration unless the Patent Office, on the basis of objective evidence, determines in writing that there was no bona fide use of the trademark during the two years immediately preceding the expiration

12.4. The registration of a trade mark can be canceled when another person, prior to the date of the registration of the last trademark, is entitled to a right other than the rights specified in Article 10, and that this right gives him/her competences to prohibit the use of the registered trade mark throughout the entire territory of Kosovo.

12.5. Other rights within the meaning of article 12.4 are:

- a. the right to use the name;
- b. the right of personal portrayal;
- c. copyright;
- d. names of plant varieties;
- e. indications of geographical origin; and
- f. other industrial property rights.

### Chapter 3 Effects of Registered Trademark

#### Article 13 Rights Conferred by Registered Trademark

13.1. The proprietor of a registered trademark shall have exclusive rights in relation to the goods or services covered by the registration to:

- a. use the trademark;
- b. authorize another to use the trademark;
- c. consent to the use of the trademark; or
- d. obtain judicial remedy for a violation of the trademark described in Article 14.

13.2. Violation of a registered trademark, as used in the present law, shall refer to any violation of the rights of the trademark proprietor.

13.3. The rights of the proprietor of a registered trademark shall have effect from the date of registration of the trademark, as determined under Article 41.3.

13.4. Notwithstanding Article 13.3:

- a. no violation proceedings may be initiated before the date of publication of the registration of the trademark; and
- b. no offense shall be regarded as committed under Article 82 by anything done before that date.

Article 14  
Violation of Registered Trademark

14.1. No person or undertaking may use a sign in the course of trade that is substantially identical with, or deceptively similar to, a registered trademark, without the consent of the trademark proprietor. The unauthorized use of a registered trademark shall be considered a violation of the rights of the proprietor of the registered trademark.

14.2. No person or undertaking may use a sign in the course of trade or business where there exists a possibility that such use will lead to the general deception or confusion of the public, including also confusing the sign with the trademark.

14.3. A violation of a registered trademark shall occur if a person or undertaking:

- a. uses in the course of trade a sign that is identical with or similar to the trademark, and
- b. uses such sign in relation to goods or services that are not similar to those for which the trademark is registered, if the trademark has a reputation in Kosovo and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or reputation of the trademark.

14.4. For the purposes of this Article 14, use of a sign shall include, but not be limited to:

- a. affixing the sign to goods or the packaging thereof;
- b. offering or exposing goods for sale, putting them on the market or stocking them for those purposes under the sign, or offering or supplying services under the sign;
- c. importing or exporting goods under the sign; or
- d. using the sign on business papers or in advertising.

14.5. A person or undertaking that applies a registered trademark to material intended to be used for labeling or packaging goods, as a business paper, or for advertising goods or services, shall be treated as a party to any use that violates the registered trademark if, when that person or undertaking applied the trademark, that person or undertaking knew or had reason to believe that the application of the trademark was not duly authorized by the proprietor or a licensee of the registered trademark.

14.6. Article 14.5 shall not prevent the use of a registered trademark by any person or undertaking for the purpose of identifying goods or services as those of the proprietor or licensee of the registered trademark; such use may nevertheless be prohibited if, without due cause, it takes unfair advantage of, or is detrimental to, the distinctive character or reputation of the trademark, unless such use is made in good faith and in accordance with honest practices in industrial or commercial matters.

Article 15  
Limits on Effect of Registered Trademark

15.1. The use of a registered trademark shall not be considered violating the rights of another registered trademark, unless such trademark is later deemed invalid, as per Article 48.6.

15.2. The following shall not be considered a violation of a registered trademark:

- a. the use by a person of his own name or address;

- b. the use of indications the purpose of which is to describe the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods, the time of the rendering of services, or other characteristics of goods or services; or
- c. the use of the trademark where it is necessary to indicate the intended purpose of a product or service, in particular, as accessories or spare parts, unless such use is not made in good faith or is not in accordance with honest practices in industrial and commercial matters.

15.3. The use of an earlier unregistered right within the area where it has been previously used shall not be considered as violating a registered trademark.

15.4. For the purpose of Article 15.3 an “earlier unregistered right” means an unregistered trademark or other sign continuously used in relation to goods or services by a person or undertaking from a date prior to the earlier of:

- a. the use of the registered trademark in relation to those goods or services by the proprietor or the proprietor’s predecessor in title; or
- b. the registration date of the registered trademark for the goods or services by the proprietor or the proprietor’s predecessor in title.

#### Article 16

##### Exhaustion of Rights Conferred by Registered Trademark

16.1. It shall not be considered a violation of a registered trademark to use that trademark in relation to goods that have been put on the market in Kosovo or the European Union under that trademark by, or with the consent of, the proprietor of the trademark, subject to Article 16.2.

16.2. Notwithstanding Article 16.1, the proprietor of a registered trademark may oppose the further use of the trademark where the proprietor has legitimate reason to believe that the condition of the marked good has changed or been impaired after being placed on the market.

#### Article 17

##### Registration Subject to disclaimer or Limitation

17.1. An applicant for, or proprietor of, a registered trademark may:

- a. disclaim any right to the exclusive use of any specified element of the trademark, or
- b. agree that the rights granted by the registration will be subject to some specified limitation.

17.2. The Patent Office may make the grant of a trademark registration contingent upon the applicant’s acceptance of specified disclaimers or limitations, as referred to in Article 17.1 where:

- a. a particular element of the trademark is not distinctive, or
- b. the inclusion of the particular element may cause uncertainty as to the scope of trademark protection.

17.3. Where, as in Article 17.1, the trademark registration is subject to a disclaimer or limitation, the rights granted by Article 13 shall also be restricted accordingly.

17.4. Any disclaimer or limitation of rights granted by the trademark registration must be recorded in the Trademark Register.

## Chapter 4 Violation Proceedings

### Article 18 Action for violation

18.1. The proprietor of a registered trademark may take legal action where the trademark is violated.

18.2. Any judicial remedy that is available to the proprietors of other types of property rights shall also be available to proprietors of a registered trademark.

### Article 19 Order for erasure/removal of violating trade label

19.1. The Court may, by order, require a person or undertaking that the Court determines to have violated a trademark to:

- a. destroy, erase, or otherwise remove, the offending sign from the concerned goods, materials or articles.
- b. destroy the concerned goods, materials or articles if it is not reasonably feasible to destroy, erase, or otherwise remove the offending sign.

19.2. If the Court determines that a party has not complied, or likely will not comply, in a complete and timely manner with an order issued pursuant to Article 19.1, the Court may order that the concerned goods, materials or articles be seized a law enforcement agency and transferred to a person or undertaking designated by the Court who will then be responsible for carrying out the order of the Court. The violating party shall be liable to reimburse all expenses incurred in connection with such action.

### Article 20 Order for Surrender of violating goods, materials or articles

20.1. A trademark proprietor may apply for a Court order to require a violating party to surrender any violating goods, materials or articles in the violating party's possession, custody or control. The Court may order the violating party to surrender such goods, materials or articles to the trademark proprietor or any other person or undertaking designated by the Court for such purpose.

20.2. An application for a Court order requiring the surrender of violating goods, materials or articles shall not be granted unless the requirements specified in Articles 22 and 23 are satisfied, or it appears to the Courts satisfaction that sufficient grounds exist that such requirements will be satisfied.

20.3. If an order under Article 23 is not made, a person designated by the Court to receive and dispose of the surrendered violating goods, materials or articles shall retain them until it is determined whether such an order will be made.

20.4. Nothing in this Article 20 shall affect any other power of the Court.

#### Article 21 Meaning of “Violating goods, materials or articles”

21.1. The terms “violating goods,” “violating materials” and “violating articles” shall be interpreted in accordance with the provisions of this Article 21.

21.2. The term “violating goods” shall refer to goods, or packaging for goods, that bear a sign identical or substantially similar to a registered trademark, and:

- a. such use violates the registered trademark;
- b. such goods have been, or are proposed to be, imported into Kosovo, and the use of the sign on the imported good in Kosovo constitutes, except as provided for in Article 21.3, a violation of the registered trademark; or
- c. the sign has otherwise been used in relation to the goods in such a way as to violate the registered trademark.

21.3. Item “b” of Article 21.2 shall not apply to goods that are lawfully imported into Kosovo through a right created or arising from treaties or agreements with or governing the European Union.

21.4. The term “violating materials” shall refer to materials that bear a sign identical or substantially similar to a registered trademark and:

- a. it is used to label or package goods, as business paper, or for advertising goods or services, in such a way as to violate the registered trademark; or
- b. it is intended to used to label or package goods, as business paper, or for advertising goods or services, in such a way as to violate the registered trademark.

21.5. The term “violating articles” shall refer to articles:

- a. that are specifically designed or adapted for making or producing copies of, or goods or materials bearing, a sign identical or substantially similar to the registered trademark; and
- b. that are in the possession, custody, or control, of a person or undertaking who knows or has reason to believe that they have been or will be used to produce violating goods or material.

## Article 22

### Period after which an Application for a surrender order may not be filed

22.1. Subject to the other provisions of this Article 22, an application for a surrender order under Article 20 may not be filed with the Court after the expiration of the six year period beginning:

- a. in the case of violating goods, the date on which the trademark was applied to the goods or their packaging;
- b. in the case of violating material, the date on which the trademark was applied to the material; or
- c. in the case of violating articles, the date on which they were made.

22.2. Article 22.1 notwithstanding, an application for a surrender order may be made at any time within the six year period beginning on the date of the entry into force of the present law.

22.3. The six year period referred to in Article 22.1 shall be extended to the extent necessary to compensate for any period of time during which the proprietor did not have actual knowledge of the violation.

22.4. In the event that the other party challenges the legitimacy of the proprietor's invocation of Article 22.3, the burden of proving that the proprietor did have actual knowledge of the violation shall be on the other party. The other party shall also have the burden of proving the date on or by which the proprietor had acquired such actual knowledge.

## Article 23

### Order as to disposal of violating goods, material, or articles

23.1. If violating goods, materials or articles have been surrendered in fulfillment of a Court order issued under Article 20, either party may apply for the Court to:

- a. issue an order that the violating goods, materials, or articles, be destroyed;
- b. issue an order that the violating goods, materials, or articles, be forfeited to the person or undertaking that the Court finds fit for their possession;
- c. issue a statement declaring that the order will not be given according to the article 23.4 of the present law.

23.2. In deciding whether or not to issue an order applied for under Article 23.1, the Court shall consider whether any other judicial remedy that is available to compensate for the violation of a trademark would adequately compensate and protect the interests of the trademark proprietor.

23.3. The Court may establish provisions in its rules of Court governing the time and manner of service of notice on any person or undertaking having an interest in the goods, materials, or articles. Such a person or undertaking shall have the right:

- a. to participate in the Court proceedings held to consider the issuance of an order under Article 23.1, whether or not such person or undertaking was served with notice; and

- b. to appeal against any such order issued, whether or not such person or undertaking actually participated in the concerned Court proceedings.

23.4. If the Court decides not to issue an order under Article 23.1 item “c” of the present law, the surrendered goods will be given back to the person from whom they were taken.

#### Article 24

##### Remedy for groundless threats of violation proceedings

24.1. A person or undertaking threatened with proceedings for the violation of registered trade marks may apply to the Court for relief under this Article 24 if the proceedings are not related to:

- a. the application of the mark to goods;
- b. the importation of goods to which the mark has been applied; or
- c. the supply of services under the mark.

24.2. A person or undertaking applying for judicial relief under Article 24.1 may seek from the Court any of the following:

- a. a declaration that the threats are unjustifiable;
- b. an injunction against the continuance of the threats; or
- c. damages for losses of any loss sustained by the threats.

24.3. A plaintiff shall be entitled to such relief as is referred to in Article 24.2 unless the defendant shows that the subject of litigation involves the actual or anticipated violation of a trademark.

24.4. Notwithstanding the provisions of Article 24.3, the plaintiff shall be entitled to the relief described in Article 24.2 if the plaintiff shows that the trademark is invalid or is liable to be revoked in a relevant respect.

24.5. Notification that a trademark is registered or that an application for registration has been made shall not in itself constitute a threat of proceedings for the purposes of this Article 24.

#### Article 25

##### Violating goods, material, or articles: Powers of search and seizure

25.1. The Court may issue an order authorizing a law enforcement agency to seize any goods, materials, or articles for which the Court has found reasonable evidence to conclude that:

- a. such goods, materials or articles violate a registered trademark, and
- b. are at or in a specific location or piece of movable property where in the course of business, or otherwise for the purpose of dealing.

25.2. The Court may issue an order authorizing a law enforcement agency to enter a movable or immovable property, by force if necessary, and to seize goods, materials and/or articles that the Court, after consideration of testimony given under oath, determines that reasonable grounds exist to suspect that such goods, materials and/or articles:

- a. violate a registered trade mark; and

- b. are in the possession, custody or control of a person or undertaking for the purpose of selling, distributing, trading, dealing or otherwise using such goods, materials or articles in connection with a business or trading activity.

25.3. If the Court is provided with proof that any goods, materials, or articles brought before the Court under Article 25.1 or 25.2 violate a registered trademark, the Court may:

- a. order such goods to be surrendered to the proprietor of the registered trademark concerned;
- b. order such goods to be destroyed or forfeited to such person as the Court thinks fit; or
- c. order such goods to be dealt with in such other way as the Court thinks fit.

#### Article 26 Nature of Registered Trademark

A registered trademark is personal property.

#### Article 27 Transfer of a Registered Trademark

27.1. The proprietorship interest in a registered trademark may be transferred by an assignment, the laws of inheritance, or operation of law in the same way as other personal property. The proprietorship interest of a registered trademark may also be transmitted either in connection with the goodwill of a business or independently.

27.2. An assignment or other transfer of a registered trademark may be either partial or in whole. A transfer may be partial if it transfers the right:

- a. to some, but not all, of the goods or services for which the trademark is registered;
- b. to use the trademark only in a particular manner, or
- c. to use the trademark only in a particular locality.

27.3. An assignment or transfer of registered trademark right must be in writing and signed by, or on behalf of, the proprietor of the registered trademark right.

27.4. A registered trademark may be the subject of legal proceedings in the same way as other personal property.

27.5. Nothing in the present law shall be construed as affecting the assignment or other transfer of an unregistered trademark.

#### Article 28 Registration of Transactions affecting registered Trademarks

28.1. The transfer or assignment of the registered trademark right shall be recorded in the Trademark Register when:

- a. one of the parties to the transaction applies to record the transfer, and
- b. proof of the transfer or assignment is provided to the Patent Office.

28.2. For purposes of the present law, the following transactions may be registered:

- a. an assignment of a right to a registered trademark;
- b. the grant or assignment of a license under a registered trademark;
- c. the granting of any security interest over a right to a registered trademark; and
- d. an order of a Court or other competent authority transferring a right to a registered trademark.

28.3. Until an application has been made under Article 28.1,

- a. the transaction shall be ineffective as against a third party acquiring a conflicting interest under the trademark in ignorance of the unrecorded transaction, and
- b. a licensee shall not receive the rights provided under Article 30 and 31 unless the granting transaction is recorded.

28.4. A person acquiring a proprietorship right or license in a registered trademark through a transaction capable of recordation shall not be entitled to compensation for the violation of the acquired trademark unless:

- a. an application registering the trademark transferring transaction according to Article 28.1 is made within six months of the transferring transaction; or
- b. the Court is satisfied that such an application was not reasonably feasible, but that such an application was made as soon as it became reasonably feasible.

28.5. Provisions may be made by rules regarding the alteration or deletion of particulars of transactions capable of registration entered in the Trademark Register by virtue of this Article 28.

#### Article 29

##### Application for registration of Trademark as an object of property

29.1. The application for registration of a trademark shall also be treated as a property interest capable of transfer.

29.2. The provisions of Articles 26 to 28 shall accordingly apply to applications for trademark registration in the same way as they apply to a registered trademark. The documentation of transactions transferring applications for registration shall be made by giving notice to the Patent Office.

#### Chapter 5

##### Licensing

#### Article 30

##### Licensing of Registered Trademark

30.1. A license to use a registered trademark may be general or limited.

30.2. A limited license may, in particular, apply:

- a. in relation to only some of the goods or services for which the trademark is registered;
- b. in relation to the use of the trademark in only a particular manner; or
- c. in relation to the use of the trademark only in a particular locality.

30.3. A license must be in writing signed by, or on behalf of the grantor of the license.

30.4. Where the license so provides, a sub-license may be granted by the licensee. References in this law to a license or licensee include a sub-license or sub-licensee.

### Article 31 Rights of Licensee and Licensor

31.1. The licensee may bring lawsuit concerning the violation of a trademark only if the proprietor of the trademark consents thereto.

31.2. The proprietor of the trademark may bring legal proceedings against a licensee who contravenes any provision in his licensing contract with regards to:

- a. the duration of the license;
- b. the form covered by the registration in which the trademark may be used;
- c. the kind of goods or services for which the license has been granted;
- d. the territory in which the trademark may be affixed; or
- e. the quality of the goods manufactured or services provided by the licensee.

31.3. A licensee shall be entitled to intervene in violation actions brought by the proprietor of the trademark for the purpose of obtaining compensation for damages suffered by him as a result of the violation.

31.4. The transfer pursuant to Article 27 or a grant of a license pursuant to Article 30 will not affect licenses previously granted to third parties

### Article 32 Exclusive License

In the present law, the term "exclusive license" shall refer to a license (whether general or limited) authorizing the licensee, to the exclusion of all other persons, including the grantor of the license, to use a registered trademark in the manner authorized by the license.

## Chapter 6 Application for Registered Trademarks

### Article 33 Requirements of the Application for a Registered Trademark

33.1. An application to for registration of a trademark in the Trademark Register shall be filed at the Patent Office.

33.2. The application shall contain

- a. information identifying the applicant;
- b. a representation of the trademark;
- c. a list of the goods or services for which the registration is requested; and
- d. a statement that the trademark is being used in relation to goods or services specified in the application, or that the applicant has a bona fide intention to so use it.

33.3. The application must also comply with any other requirements listed by the Patent Office.

33.4. A fee as prescribed by the Patent Office shall be paid with the application.

#### Article 34 Date of Filing

34.1. The “date of filing” of a trademark application shall be the date in which the prescribed documents are received by the Patent Office. If those if multiple documents are submitted on different days, the date of filing is the day the last of those documents are received.

34.2. References in the present law to the “date of application for registration” refer to the date of filing of the application.

34.3. A trademark application shall be granted unless the application requirements are not complied with or the registration is barred by absolute grounds for refusal, as defined in this chapter.

34.4. A trademark application received the Patent Office shall be published together with information identifying the applicant and the date of filing in the Official Bulletin.

#### Article 35 Classification of Goods and Services

35.1. Goods and services shall be classified for the purposes of the registration of trademarks according to a prescribed system of classification.

35.2. Questions regarding the placement of the registered trademark of the goods or services within the classification system shall be determined by the Patent Office, whose decision shall be final.

#### Chapter 7 Priority

#### Article 36 Priority Rights of Convention Applications

36.1. A person or undertaking that has correctly filed an application for trademark protection in a Convention country (hereinafter, "Convention application"), has a right to priority, for the purpose of registering the same trademark under this law for the same goods or services, for a period of six months from the date of filing of the first Convention application.

36.2. If the application for registration under present law is made within the period specified in Article 36.1:

- a. the relevant date for the purposes of establishing priority of rights shall be the date of filing of the first completed Convention application, and
- b. whether or not a trademark may be registered under this Article 40 shall not be effected by the use of the mark in Kosovo in the period between the convention application and the application under this law.

36.3. Any filing that is the equivalent to a “regular national filing” in a Convention country shall be sufficient to give rise to a right of priority. The term “regular national filing,” as used in this Article, shall refer to a filing that is sufficient to establish which date the application was filed in that country.

36.4. Where multiple applications are filed on the same subject in the same convention country the date from which priority will run shall be the date of the last application if:

- a. the previous application has been withdrawn, abandoned, or refused; and
- b. it has not yet served as a basis for claiming a right of priority.

36.5. The Patent Office may prescribe rules regarding the manner of claiming a priority right on the basis of a Convention application.

36.6. A right to priority arising as a result of a Convention application may be assigned or otherwise transferred, either with the application or independently.

#### Article 37

##### Priority Rights from Other Relevant Foreign Applications

37.1. This Article 37.1 applies to any country or territory that has entered into a treaty, convention, or other arrangement for the reciprocal protection of trademarks with Kosovo.

37.2. The Government may, by an order, grant applicants from countries/territories described in Article 37.1 the priority right for trademark registration under the present law, so long as the application for registration:

- a. covers the same goods or services; and
- b. is for a specified time period from the date of filing of that application.

37.3. The Government shall make, as necessary, provisions corresponding to those regarding Convention countries, under Article 36 for countries/territories described in Article 37.1.

#### Chapter 8

##### Registration Procedure

#### Article 38

##### Examination of Application

38.1. The Patent Office shall be responsible for examining whether an application for registration meets the requirements for registration.

38.2. The Patent Office shall inform the applicant if the submitted application fails to satisfy the registration requirements and prescribe a period of time during which the applicant may seek to remedy the applications failings.

38.3. The Patent Office shall refuse the application if:

- a. the applicant fails to satisfy the registration requirements;
- b. the applicant fails to amend the application as instructed by the Patent Office; or
- c. the applicant fails to file the amendment to the rejected application within the period of time prescribed by the Patent Office.

38.4. The Patent Office shall approve the application for trademark registration if the Patent Office determines to its satisfaction that the registration requirements are met.

#### Article 39 Publication and Opposition Proceeding

39.1. The Patent Office shall publish successful applications for trademark registration in the Official Bulletin.

39.2. Any person or undertaking may oppose an application by giving written notice of such opposition to the Patent Office within three months time from the publication in the Official Bulletin. The written notice of opposition must include a statement of the grounds of opposition.

#### Article 40 Withdrawal or Amendment of Application

40.1. Applicants may withdraw or amend their application at any time by giving written notice of such intent to the Patent Office, subject to the restrictions enumerated in the following Articles.

40.2. If an application has been published in the Official Bulletin, any withdrawal or amendment of the application shall also be published in the Official Bulletin.

40.3. The withdrawal of a trademark application shall be revocable for three months following the Patent Office's receipt of the written notice described in Article 40.1.

40.4. An applicant may amend the application so the proposed amendment does not substantially affect the identity of the trademark or extend the goods or services covered by the trademark application. Examples of amendments include:

- a. requests to correct the name or address of the applicant;
- b. requests to correct errors of wording or of copying; or
- c. requests to correct obvious mistakes.

#### Article 41 Registration

41.1. The Patent Office shall register the trademark after the application has been accepted unless:

- a. a notice of opposition has been given and is pending resolution;
- b. an opposition proceeding is decided against the applicant;
- c. information becomes available to the Patent Office that shows that the application was accepted in error, or
- d. registration fees have not been paid.

41.2. Where a trademark has not been paid within the prescribed period of time, the application shall be considered withdrawn.

41.3. The term "date of registration" as used in the present law shall refer to the date of filing of the application for registration.

41.4. When the registration is complete, the Patent Office shall:

- a. publish the registration in the Official Bulletin, and
- b. issue a certificate of registration to the applicant.

41.5. The registration procedure shall be regarded as completed on the date of publication under Article 41.4; and that date shall be entered in the Trademark Register.

#### Article 42 Supplementary Registration Provisions

42.1. The Patent Office shall provide necessary rules regarding:

- a. the division of an application for the registration of a trademark into several applications, allowing all the same filing date as the original application;
- b. merging of separate applications or registrations; and
- c. the registration of a series of trademarks in one registration.

42.2. A "series of trademarks" means a number of trademarks that resemble each in their material particulars, but differ in some non-distinctive manner that does not substantially affect the identity of the trademark.

#### Chapter 9 Duration, Renewal, and Alteration of Registered Trademarks

##### Article 43 Duration of Registration

43.1. A trademark shall be registered for a period of ten years from the date of registration.

43.2. Registration may be renewed in accordance with Article 44 for further periods of ten years.

##### Article 44 Renewal of Registration

44.1. The registration of a trademark shall be renewed if:

- a. the trademark proprietor requests such a renewal, and
- b. the prescribed renewal fee are paid.

44.2. Before the expiration date of the registered trademark, the Patent Office shall inform the trademark proprietor of the impending date of expiration for the registered trademark and the manner in which the registration may be renewed.

44.3. A request to renew the trademark registration must be filed and the renewal fee must be paid before the expiration of the trademark registration, subject to Article 44.4.

44.4. The Patent Office may, at its discretion, allow for an extended period of time for renewal, conditioned on the payment of an additional late filing fee.

44.5. A term of renewal shall take effect from the expiration of the previous registration.

44.6. If the registration is not properly renewed, the Patent Office shall remove the trademark from the register; provision may, however, be made for the restoration of the registration in situations such as those described in Article 44.4.

44.7. The renewal, removal or restoration of the registration of a trademark shall be published in the Official Bulletin.

#### Article 45 Alteration of Registered Trademark

45.1. The trademark proprietor may apply to the Patent Office for permission to alter the trademark in any manner if such a change will not substantially affect its identity. The Patent Office shall refuse or grant the proposed alteration on such terms and subject to such limitations as it thinks fit.

45.2. The Patent Office shall advertise proposed alterations to the application under Article 45.1.

45.3. Any person or undertaking may give a written notice of opposition that must include a statement of the grounds of opposition, within three months from the date of the advertisement under Article 45.2. If any such opposition is filed the Patent Office shall decide the matter after hearing both parties.

45.4. A trademark that has been successfully altered under Article 45.1 shall be published in the Official Bulletin, unless the alteration has already been advertised in the Official Bulletin, as per Article 45.2.

#### Chapter 10 Cancellation, Revocation and Invalidity

##### Article 46 Cancellation of Registered Trademark

46.1. A trademark proprietor may voluntarily cancel the trademark registration, in part or in whole.

46.2. Upon cancellation, a trademark proprietor shall,

- a. cease to have the exclusive right to use, or authorize the use of, the trademark; and
- b. no longer have the right to seek a judicial remedy under this law if the trademark is later violated.

Article 47  
Revocation of Registration

47.1. The trademark registration may be revoked on any of the following grounds:

- a. that the trademark has not been genuinely used by, or on behalf of, the proprietor in Kosovo within five years from the date the registration was published in the Official Bulletin; and there is no proper excuse for the non-use.
- b. that the registered trademark has not been so used for any uninterrupted period of five years, and there is no proper excuse for the non-use;
- c. that the trademark has become a common name in the trade for a product or service for which it is registered as a result of inactivity by the trademark proprietor; or
- d. that the trademark is liable to mislead consumers, particularly in regards to the nature, quality, or the geographic origin of those goods or services, as a result of the use by, or with the consent of the trademark proprietor.

47.2. For the purposes of Article 47.1, use of a trademark shall include a use that differs in form, but does not alter the distinctive character of the trademark in its registered form. "Use in Kosovo" includes affixing the trademark to goods in Kosovo solely for export purposes.

47.3. Trademarks that have fallen in to non-use, as described in Article 47.1, items "a" and "b" shall not be revoked if the use of the trademark is use is resumed or commenced after a five year period, but three months before an application for revocation has been made.

47.4. Any person or undertaking may make an application for revocation to either the Patent Office or to the Court, except that:

- a. if proceedings concerning the trademark are pending in the Court, the application must be made to the Court; and
- b. an application made to the Patent Office, may be referred to the Court at any stage of the proceedings, at the discretion of the Patent Office.

47.5. Revocation proceedings may be brought against some or all of the goods or services for which the trademark is registered; revocation shall accordingly relate only to those goods or services specified in the application.

47.6. Where the registration of a trademark is revoked, the proprietor's rights shall be deemed to have ceased from:

- a. the date of the application for revocation; or
- b. some earlier date if the Patent Office or the Court is satisfied that the grounds for revocation existed on that earlier date.

47.7. Revocation of a trademark shall be entered in the Trademark Register and the Patent Office, and published in the Official Bulletin

47.8. Application for Revocation must be presented according to the conditions assigned with other by-laws.

Article 48  
Grounds for Invalidity of Registration

48.1. A registered trademark shall be declared invalid if it is found in breach of Article 9; where, however, a trademark was registered in breach of Article 9.1, item “b,” “c,” or “d,” it shall not be declared invalid if it has acquired a distinctive character after registration, as a result of the manner in which it has been used.

48.2. The registration of a trademark may be declared invalid on the grounds:

- a. that there is an earlier trademark satisfying the conditions set out in Articles 10.1 to 10.3; or
- b. that there is an earlier right that satisfies the conditions set out in Article 10.4, item “a” or “b” unless the proprietor of that earlier trademark or earlier right has consented to the registration.

48.3. Any person or undertaking may make an application for a declaration of invalidity to either the Patent Office or to the Court, except that:

- a. if proceedings concerning the trademark are pending in the Court, the application must be made to the Court; and
- b. an application made to the Patent Office, may be referred to the Court at any stage of the proceedings, at the discretion of the Patent Office.

48.4. The Patent Office shall apply to the Court for a declaration of invalidity where it appears a trademark has been registered in bad faith.

48.5. Invalidity proceedings may be brought against some or all of the goods or services for which the trademark is registered; invalidity shall accordingly relate only to those goods or services specified in the application.

48.6. The registration of a trademark shall be declared to have never been made to the extent that it has been declared invalid; provided, however, that this shall not affect past transactions that have already been closed.

Article 49  
Effect of Acquiescence

The proprietor of an earlier trademark right who has knowingly acquiesced to the use of a registered trademark in Kosovo for a continuous period of five years shall no longer be entitled to:

- a. apply for a declaration of invalidity for the earlier protected right, or
- b. to oppose the use of the later trademark in relation to the goods or services unless the registration of the later trademark was applied for in bad faith.

Chapter 11  
Collective Marks

Article 50  
Collective Marks

50.1. A collective mark is a mark distinguishing the goods or services of members of the association that is the proprietor of the mark from those of other undertakings.

50.2. The provisions of the present law apply to collective marks subject to the provisions of the Annex A.

Chapter 12  
Certification Marks

Article 51  
Certification Marks

51.1. A certification mark is a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of the mark regarding the origin, material, mode of manufacture of goods or performance of services, quality, accuracy, or other characteristics.

51.2. The provisions of the present law apply to certification marks subject to the provisions of the Annex B

Chapter 13  
The Madrid Protocol: International Registration

Article 52  
Power to make provisions giving effect to Madrid Protocol

52.1. By the proposal of the Patent office the Minister may issue the by laws which he considers appropriate for giving effect in Kosovo to the provisions of the Madrid Protocol.

52.2. Provision may, in particular, be made for:

- a. the filing of applications for international registrations through the Patents Office as office of origin;
- b. the procedures to be followed where the basic application or registration in Kosovo fails or ceases to be in force;
- c. the procedures to be followed where the Patents Office receives a request for extension of protection to Kosovo from the International Bureau;
- d. the effects of a successful request for extension of protection to Kosovo;
- e. the transformation of an international registration or an application for an international registration into an application for registration in Kosovo;
- f. the communication of information to the International Bureau;
- e. the payment of fees and amounts prescribed for applications for international registrations, extensions of protection and renewals.

52.3. Article 24 (Remedy for Groundless Threats of Violation Proceedings); and Part VI (Offenses) shall apply in relation to an international trademark as they apply in relation to a registered trademark.

## Chapter 14 The Paris Convention: Supplementary Provisions

### Article 53 Protection of Well-Known Trademark

53.1. References in the present law to a trademark which is entitled to protection under the Paris Convention as a well-known trademark are to a mark that is well known in Kosovo as being the mark of:

- a. a national of a Convention country, or
- b. a person or undertaking that is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country, whether or not that person or undertaking carries on business, or has any goodwill, in Kosovo; and references to the proprietor of such a mark shall be construed accordingly.

53.2. Subject to Article 49, the proprietor of a trademark that is entitled to protection under the Paris Convention as a well-known trademark shall be entitled to restrain by injunction the use in Kosovo of a trademark which, or the essential part of which, is identical or similar to the proprietor's mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.

53.3. Nothing in Article 54.2 shall affect the continuation of any bona fide use of a trademark begun before the commencement of this law.

### Article 54 National Emblems of Convention Countries

54.1. A trademark which consists of or contains the flag of a Convention country shall not be registered without the authorization of the competent authorities of that country, unless it appears to the Patent Office that use of the flag in the manner proposed is permitted without such authorization.

54.2. A trademark which consists of or contains the armorial bearings or any other state emblem of a Convention country which is protected under the Paris Convention shall not be registered without the authorization of the competent authorities of that country.

54.3. A trademark which consists of or contains an official sign or hallmark adopted by a Convention country and indicating control and warranty shall not, where the sign or hallmark is protected under the Paris Convention, be registered in relation to goods or services of the same or a similar kind as those in relation to which it indicates control and warranty, without the authorization of the competent authorities of the country concerned.

54.4. The provisions of this Article 54 as to national flags and other state emblems and official signs or hallmarks apply equally to anything which imitates any such flag or other emblem, sign or hallmark.

54.5. Nothing in this Article 54 prevents the registration of a trademark on the application of a national of a country who is authorized to make use of a state emblem or official sign or hallmark of that country, notwithstanding that it is similar to that of another country.

54.6. Where, by virtue of this Article 54, the authorization of the competent authorities of a Convention country is or would be required for the registration of a trademark, those authorities shall be entitled to restrain by injunction any use of the mark in Kosovo without their authorization.

#### Article 55 Emblems of Certain International Organizations

55.1. This Article 55 applies to:

- a. the armorial bearings, flags, or other emblems, and
- b. the abbreviations and names, of international intergovernmental organizations of which one or more Convention countries are members.

55.2. A trademark that consists of or contains any such emblem, abbreviation, or name that is protected under the Paris Convention shall not be registered without the authorization of the international organization concerned, unless it appears to the Patent Office that the use of the emblem, abbreviation, or name in the manner proposed:

- a. is not such as to suggest to the public that a connection exists between the organization and the trademark; or
- b. is not likely to mislead the public as to the existence of a connection between the user and the organization.

55.3. The provisions of this Article 55 apply equally to anything which imitates any emblems of an international organization.

55.4. Where, by virtue of this Article, the authorization of an international organization is or would be required for the registration of a trademark that organization shall be entitled to restrain by injunction any use of the mark in Kosovo without its authorization.

55.5. Nothing in this Article 55 affects the right of a person or undertaking whose bona fide use of the trademark in question began before the adoption of this law.

#### Article 56 Notification under Article 6ter of the Convention

56.1. For the purposes of Article 54, state emblems of a Convention country (other than the national flag) and official signs or hallmarks shall be regarded as protected under the Paris Convention only if, or to the extent that:

- a. the country in question has notified the Government of Kosovo in accordance with Article 6ter (3) of the Convention that it desires to protect the emblem, sign, or hallmark;
- b. the notification remains in force; and
- c. The Government of Kosovo has not objected to it in accordance with Article 6ter (4) or any such objection has been withdrawn.

56.2. For the purposes of Article 55, the emblems, abbreviations and names of an international organization shall be regarded as protected under the Paris Convention only if, or to the extent that

- a. the organization in question has notified the Kosovo in accordance with Article 6ter (3) of the Convention that it desires to protect that emblem, abbreviation or name;
- b. the notification remains in force; and
- c. the Government of Kosovo has not objected to it in accordance with Article 6ter (4) or any such objection has been withdrawn.

56.3. Notification under Article 6ter (3) of the Paris Convention shall have effect only in relation to applications for registration made more than two months after the receipt of the notification.

56.4. The Patent Office shall keep and make available for public inspection by any person or undertaking, at all reasonable hours, and free of charge, a list of:

- a. the state emblems and official signs or hallmarks, and
- b. the emblems, abbreviations, and names of international organizations, which are for the time being protected under the Paris Convention by virtue of notification under Article 6ter (3).

#### Article 57 Acts of Agents or Representatives

57.1. The following provisions apply where an application for registration of a trademark is made by a person or undertaking that is an agent or representative of a proprietor of a trademark (“proprietor” or “trademark proprietor”) in a Convention country and the application is made without the proprietor's authorization.

57.2. Where the proprietor opposes the application, registration shall be refused.

57.3. Where the application (not being so opposed) is granted, the proprietor may:

- a. apply for a declaration of the invalidity of the registration; or
- b. apply for the rectification of the register so as to substitute the proprietor's name as the proprietor of the registered trademark.

57.4. The proprietor notwithstanding the rights conferred by the present law in relation to a registered trademark may apply to the Court to restrain by injunction any use of the trademark in the State which is not authorized by the proprietor.

57.5. An application under Article 57.3 item “a” or “b” must be made within three years of the proprietor becoming aware of the registration. No injunction shall be granted under Article 57.4 regarding a use in which the proprietor has acquiesced for a continuous period of three years or more.

PART IV  
ADMINISTRATIVE PROVISIONS

Article 58  
The Trademark Register

58.1. The Patent Office shall keep a Register of Trademarks (“Trademark Register” or “Register”); and references in the present law to registration (in particular, in the expression "registered trademark") are, unless the context otherwise requires, to registration in the register.

58.2. There shall be entered in the Trademark Register in accordance with the present law:

- a. registered trademarks;
- b. particulars of registrable transactions affecting a registered trademark; and
- c. such other matters as may be prescribed.

58.3. The Trademark Register shall be kept in such form as may be prescribed, and shall make possible:

- a. public inspection of the register; and
- b. the supply of certified or uncertified copies of, or extracts from, entries in the Trademark Register.

Article 59  
Rectification or Correction of the Register

59.1. Any person or undertaking having a sufficient interest may apply for the rectification of an error or omission in the register; provided, however, that an application for rectification may not be made regarding a matter affecting the validity of the registration of a trademark.

59.2. An application for rectification may be made either to the Patent Office or to the Court, except that:

- a. if proceedings concerning the trademark in question are pending in the Court, the application must be made to the Court; and
- b. if in any other case the application is made to the Patent Office, he may at any stage of the proceedings refer the application to the Court.

59.3. Unless the Patent Office or the Court otherwise directs, the effect of rectification of the register is that the error or omission in question shall be deemed never to have been made.

59.4. The Patent Office may correct any error made by him in any entry in the Trademark Register but, before doing so, he shall give notice of the proposed correction to any person or undertaking that appears to him to be concerned.

59.5. The Patent Office may, on request made in the prescribed manner by the proprietor of a registered trademark:

- a. enter any change in the proprietor's name or address as recorded in the Trademark Register;

- b. amend the specification of the goods for which a trademark is registered, provided that the amendment does not in any way extend the rights given by the existing registration of the trademark; or
- c. enter a disclaimer or memorandum relating to a trademark which does not in any way extend the rights given by the existing registration of the trademark.

59.6. The Patent Office may, on request made by the licensee of a registered trademark, enter any change in his/her name or address in the Trademark Register.

59.7. The Patent Office may remove from the Trademark Register matter that appears to have ceased to have effect.

## Article 60

### Adaptation of entries to new classification

60.1. Through by-laws may be provided for Patent Office to have necessary authorizations in order to act when it considers necessary to implement any amended or substituted classification of goods or services for the purposes of the registration of trademarks.

60.2. Provision may, in particular, be made for the amendment of existing entries on the register so as to accord with the new classification.

60.3. Any such power of amendment shall not be exercised so as to extend the rights conferred by the registration, except where it appears to the Patent Office that compliance with this requirement would involve undue complexity and that any extension would not be substantial and would not adversely affect the rights of any third party.

60.4. The rules may empower the Patent Office:

- a. to require the proprietor of a registered trademark, within such time as may be prescribed, to file a proposal for amendment of the Trademark Register; and
- b. to cancel or refuse to renew the registration of the trademark in the event of the proprietor failing to do so.

60.5. A proposal under Article 60.4 item “a” shall be advertised and may be opposed in such manner as may be prescribed.

## Chapter 15

### Powers and Duties of the Patent Office

## Article 61

### Power to Require Use of Forms

The Patent Office may require the use of forms for any purpose relating to the registration of a trademark or any other proceedings before the Patent Office under the present law.

Article 62  
Information about application and Registered Trademarks

62.1. After publication of an application for registration of a trademark, a person or undertaking may request that the Patent Office provide information relating to the application for a registered trademark; a person or undertaking may also request to inspect documents relating to the application or registration of a trademark.

62.2. The request described in Article 62.1 must be made in the prescribed manner and be accompanied by the appropriate fees.

62.3. The Patent Office shall not publish or communicate documents or information relating to an application for the registration of a trademark before the application for the trademark has been published in the Official Bulletin, unless:

- a. the Patent Office decides to release such information as it deems necessary; or
- b. the applicant consents to such a release of information.

62.4. A person or undertaking may make a request for information regarding an application for the registration of a trademark even before it has been published in the Official Bulletin, if the person or undertaking requesting the information has been notified that an application has been made and that the applicant plans to bring legal proceedings against the person or undertaking requesting the information.

Article 63  
Exercise of Discretionary Powers by Patent Office

Whenever the present law allows the Patent Office discretionary power, the Patent Office shall not exercise the discretionary power against the interests of an applicant, or a party to proceedings regarding the application, without allowing that party an opportunity to be heard. Execution of these duties must be in accordance with Law for Administrative Procedures.

Article 64  
Costs and Security for Costs

64.1. The Patent Office may order a party to pay the reasonable costs of another party, and direct the manner of such a payment, in any proceeding under the present law. The Court may, if called upon, direct the enforcement of these payments in the same manner as a judgment or order of the Court.

64.2. The Patent Office or Court, as appropriate, may require a party to give a security payment to cover the costs of proceedings where the party neither resides or carries on business in Kosovo, or is otherwise beyond the reach of the Court.

64.3. The Patent Office or the Court, as appropriate, may treat proceedings as abandoned if the requirements under Article 65.2 are not complied with.

Chapter 16  
Legal Proceedings and Appeals

Article 65  
Registration to be Prima Facie Evidence of Validity

In all legal proceedings relating to a registered trademark, including proceedings for rectification of the register, the registration of a person or undertaking as proprietor of a trademark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.

Article 66  
Certificate of Validity of Contested Registration

66.1. If, in proceedings before the Court, the validity of the registration of a trademark is contested and it is found by the Court that the trademark is validly registered, the Court may give a certificate to that effect.

66.2. Unless the Court directs otherwise, the trademark proprietor shall be entitled to legal costs if the Court gives a certificate as described in Article 66.1, and in subsequent proceedings:

- a. the validity of the registration is again questioned, and
- b. the trademark proprietor obtains a final order or judgment in their favor.

66.3. Article 66.2 does not extend to the costs of an appeal in any proceedings.

Article 67  
Patent Office's Appearance in Court Proceedings

67.1. The Patent Office shall be entitled to appear and be heard, or may be compelled by the Court to appear, in any proceedings before the Court which involve or relate to:

- a. the revocation of the registration of a trademark;
- b. a declaration of the invalidity of the registration of a trademark;
- c. the rectification of the Trademark Register; or
- d. any other matter in which the judicial remedy sought would affect the Trademark Register.

67.2. Unless otherwise directed by the Court, The Patent Office may submit a written and signed statement instead of appearing before the Court, giving particulars of:

- a. any proceedings before the Patent Office in relation to the matter in issue;
- b. the grounds of any decision given by the Patent Office affecting it;
- c. the practice of the Patents Office in like cases; or
- d. such matters relevant to the issues at hand within the Patent Office's knowledge as the Patent Office thinks fit.

67.3. A written statement of the Patent Office presented to the Court in accordance with Article 67.2 shall be considered evidence in the proceedings.

Article 68  
Appeals from the Patent Office

68.1. An appeal must be made within three months of the date the Patent Office decision was made under the present law, unless otherwise provided by the rules of the Court. The clamor has a suspensive effect.

68.2. On an appeal under this Article 68:

- a. the Patent Office shall be entitled to appear and be heard;
- b. the Court may compel the Patent Office to appear; and
- c. the Court may exercise any power which could have been exercised by the Patent Office in the proceedings from which the appeal is brought.

Article 69  
No award of costs to or against the Patent Office

The Patent Office shall not be awarded or be ordered to pay costs in any proceedings before the Courts under the present law.

Article 70  
Power of Minister to Make Rules

70.1. The Minister may issue bylaws with proposal of the Patent Office:

- a. for the purposes of any provision of the present law authorizing the making of rules with respect to any matter;
- b. for prescribing anything authorized or required by any provision of the present law to be prescribed, and
- c. generally for regulating practice and procedure under the present law.

70.2. Without prejudice to the generality of Article 70.1, provision may, in particular, be made by rules under this Article 70 as to:

- a. the manner of filing of applications and other documents;
- b. requiring and regulating the translation of documents and the filing and authentication of any translation;
- c. the service of documents;
- d. authorizing the rectification of irregularities of procedure; and
- e. prescribing time limits for anything required to be done in connection with any proceeding under the present law and providing for the extension of any such limit whether or not it has already expired.

Article 71  
Fees

71.1. The Patent Office shall charge fees relating to applications, registrations, and any other matters under the present law upon the proposal of the Patent Office signed for approval by the Minister for Finance.

71.2. Provision may be made to enable the payment of a single fee for of two or more matters.

71.3. All fees, charges, fines and other amounts determined and collected by the Patent Office or the Ministry of Trade and Industry are considered as public means that are to be treated in compliance with the Law on Public Financial Management.

PART V  
TRADEMARK AGENTS

Article 72  
Authorized Agent may act

72.1. Subject to rules made under Article 79, any act done by or to a person or undertaking in connection with the registration of a trademark or any procedure relating to a registered trademark, the act may be done by or to an agent:

- a. who is authorized by that person or undertaking in writing; and
- b. who is a registered trademark agent.

72.2. A person or undertaking may cease to act as a registered trademark agent by giving notice of such resignation to the Patent Office and the proprietor of the registered trademark, unless the parties have agreed to any other provision to the contrary.

Article 73  
Register of Trademark Agents

The Patent Office shall maintain a Register of Trademark Agents in addition to the maintenance of the Trademark Register.

Article 74  
Business to be carried on only by registered Trademark Agents

74.1. Subject to the provisions of this Article 74, a person or undertaking that is not a registered trademark agent shall not:

- a. carry on a business under any name or other description that contains the words "registered trademark agent," or
- b. describe, represent or permit themselves to be described or represented as a registered trademark agent.

74.2. An undertaking that is not a legal entity shall not:

- a. carry on a business under any name or other description that contains the words "registered trademark agent," or
- b. describe, represent or permit itself to be described or represented as a firm of registered trademark agents, unless all of the members of such undertaking are registered trademark agents or the undertaking satisfies such criteria as may be prescribed by the Patent Office, provided such criteria are consistent with the achieving the purpose of this Article 74.

74.3. An undertaking that is a legal entity shall not:

- a. carry on a business under any name or other description which contains the words "registered trademark agent," or
- b. in the course of a business otherwise describe or hold itself out, or permit itself to be described or held out, as a registered trademark agent, unless all of the members of such undertaking are registered trademark agents or the undertaking satisfies such criteria as may be prescribed by the Patent Office, provided such criteria are consistent with the achieving the purpose of this Article 74.

74.4. Upon the proposal of the Patent Offices, the Minister, in an effort to fulfill obligations under any agreements between Kosovo and another State, the Minister may permit a citizen of a state that is a party to that international agreement, upon application made by that person or undertaking, to act on behalf of others regarding trademarks, subject to any conditions and limitations that the Minister considers appropriate.

74.5. The legal personal representative of a deceased registered trademark agent may carry on the business or practice of the deceased agent for a period not exceeding three years from the agent's death, or for such further period as the Court allows if the personal representative:

- a. is authorized by the Court to manage the business or practice; or
- b. employs another person or undertaking that is so authorized to manage the business or practice on behalf of the personal representative.

74.6. Any person or undertaking that contravenes any provision of this Article shall be liable on summary conviction to a fine not exceeding €500 in the case of a first offense and, in the case of subsequent offenses, €3.000. Proceedings for an offense under this Article may be commenced at any time within twelve months from the date of the offense.

74.7. Nothing in the present law shall be construed as prohibiting attorneys from taking such part in proceedings under the present law.

74.8. A registered trademark agent shall be allowed to prepare,

- a. a deed assigning the property in a trademark application or trademark; or
- b. any other document for use in proceedings under the present law before the Patent Office or the Court.

Article 75  
Entitlement to be registered as Trademark Agent

75.1. A person shall be eligible to be a registered trademark agent if that person:

- a. resides in Kosovo
- b. has a place of business in Kosovo,
- c. possesses the professional qualifications prescribed by the Patent Office, and
- d. complies with the conditions prescribed by the Patent Office.

75.2. An undertaking that is not a legal entity shall be eligible as a registered trademark agent if:

- a. every partner is registered in accordance with the provisions of this Article 75.1.
- b. the undertaking that is not a legal entity has completed an application for such designation in compliance with the precise form and manner prescribed by the Patent Office,
- c. the undertaking that is not a legal entity has paid the fee associated with such an application as prescribed by the Patent Office.

Article 76  
Removal from register of Trade Mark Agents

The Patent Office may, upon the application of any person or undertaking that who is a registered trademark agent, remove that person or undertaking's name from the Register of Trademark Agent

Article 77  
Suspension and Erasure of Registration of Trademark Agent

77.1. The Patent Office may remove, or suspend for a specified period of time, a person or undertaking from the register of trademark agents if,

- a. the person or undertaking ceases to be eligible to be a registered trademark agent; or
- b. after allowing that person or undertaking an opportunity to be heard, the Patent Office finds that they were guilty of conduct unbecoming of a trademark agent.

77.2. The Patent Office shall send the person or undertaking affected by the decision made under Article 77.1 a written notice by mail of:

- a. the decision made under Article 77.1;
- b. the date of the decision made under Article 77.1; and
- c. the reasons for the decision made under Article 77.1.

77.3. A person or undertaking that receives notice of an adverse decision under Article 77.2 may apply for a cancellation of the Patent Office's decision made under Article 77.1 within 21 days from the date the affected party received notice of the decision. The Court, upon hearing the application, may either:

- a. cancel the decision, or
- b. affirm the decision of the Patent Office and direct, as the Court considers proper,
  - (i) the Patent Office to erase the name of the person or undertaking in default from the register of trademark agents; or
  - (ii) suspend the registration of the trademark agent for a specified period of time beginning not earlier than 7 days after the decision of the Court.

77.4. If at any time the Patent Office satisfies the Court that the person or undertaking has unduly delayed proceeding with an application under Article 77.3, the Court shall, at its discretion, unless it sees good reason to the contrary, declare that it was proper for the Patent Office to make a decision under Article 77.1.

77.5. Where the person or undertaking in default does not applied to the Court for cancellation of the decision, within 21 days of receiving notice of the decision, the Patent Office may apply ex parte to the Court for confirmation of the decision. If the Patent Office so applies, the Court on the hearing of the application shall, unless it sees good reason to the contrary, declare accordingly and either, as the Court may consider proper:

- a. direct the Patent Office to erase the name of the person or undertaking in default from the register of trademark agents; or
- b. direct the suspension of the trademark agent for a specified period of time, beginning not earlier than 7 days after the decision of the Court.

77.6. The decision of the Court on an application under Article 77.3 or Article 77.5 shall be final, save that, by leave of the Court or the Supreme Court, an appeal by the Patent Office or the person undertaking in default from the decision shall lie to the Supreme Court on a specified question of law.

## Article 78

### Notice of erasure or suspension: Subsequent Restoration

78.1. Upon the erasure of the name of a person or undertaking from the register of trademark agents, the Patent Office shall send by pre-paid post to that person or undertaking, at that person or undertaking's address as stated in the register of trademark agents, notice in writing of the erasure.

78.2. Where a decision is made under Article 77 to suspend a person or undertaking's registration as a trademark agent for a specified period of time, the Patent Office shall, before the commencement of that period, send by pre-paid post to that person or undertaking, at that person or undertaking's address as stated in the Trademark Register, notice in writing of the decision.

78.3. The name of any person or undertaking which has been erased from the Register may at any time be restored to the register of trademark agents, but only by direction of the Patent Office. When a person or undertaking's name is so restored to the register of trademark agents, the Patent Office may attach to the restoration such conditions, including the payment of a fee as the Patent Office thinks fit.

78.4. Where the period of time of a person or undertaking's suspension under Article 77 has elapsed, that person or undertaking may apply to the Patent Office to terminate the suspension.

Article 79  
Rules relating to Trademark Agents

79.1. On the proposal of the Patent Office the Minister may issue by-laws for the management of the register of trademark agents and may, by those rules, prescribe any matter or thing referred to in this Article 79 or Article 74 and, in particular, may

- a. so prescribe the educational and professional qualifications,
- b. the conditions for eligibility for registration, and
- c. the maximum fees which may be charged by any person or undertaking that is registered for such services in connection with trademarks as may be specified in the rules.

79.2. Rules under Article 79.1 may authorize the Patent Office to refuse to recognize as an agent under the present law, any person or undertaking that does not satisfy the requirements of Article 75.

79.3. Rules under this Article 79 may authorize the Patent Office to refuse to recognize as agent under the present law a company or firm of which any director, manager, or partner, as the case may be, is an individual whom the Patent Office could refuse to recognize as an agent.

Article 80  
Privileged Communications

80.1. This Article 80 applies to communications regarding any matter relating to the protection of a trademark.

80.2. Any communication to which Article 82 applies:

- a. between a trademark proprietor and their registered agent, or
- b. for the purposes of obtaining or in response to a request for information which a person or undertaking is seeking for the purpose of instructing his registered agent, is privileged from disclosure in legal proceedings in Kosovo in the same way as a communication between a person or undertaking and their attorney or, as the case may be, a communication for the purpose of obtaining or in response to a request for information which a person or undertaking seeks for the purpose of instructing their attorney.

80.3. In Article 80.2 "registered agent" means:

- a. a registered trademark agent;
- b. an undertaking that is not a legal entity but who is entitled to describe itself as a firm of registered trademark agent; or
- c. an undertaking that is a legal entity and is entitled to describe itself as a registered trademark agent.

PART VI  
OFFENSES

Article 81

Fraudulent application or use of Trademark in relation to goods

81.1. Subject to the provisions of Article 81.3, it shall be an offense for any person or undertaking besides the proprietor or a person or undertaking authorized by the proprietor:

- a. to apply a mark identical to or nearly resembling a registered trademark to goods or material, used or intended to be used, for labeling, packaging, or advertising goods;
- b. to sell, let for hire, expose for sale, or hire or distribute;
  - (i) goods bearing such a mark, or,
  - (ii) material bearing such a mark which is used or intended to be used for labeling, packaging, or advertising goods
- c. to use material bearing such a mark in the course of a business for labeling, packaging, or advertising goods; or
- d. to possess in the course of a business, goods or material bearing such a mark with a view to doing any of the things mentioned in Article 81.1, items “a” to “c.”

81.2. Subject to the provisions of Article 81.3, it shall be an offense for any person or undertaking to possess in the course of a business, goods or material bearing a mark identical or substantially similar to a registered trademark with a view to enabling or assisting another person or undertaking to do any of the things mentioned in Article 81.1 item “a,” “b,” or “c,” knowing or having reason to believe that the other person or undertaking is not entitled to use the mark in relation to the goods in question or authorized by a person or undertaking that is so entitled.

81.3. Any person or undertaking that contravenes the provisions of Article 81.1 or 81.2 shall be guilty of an offense if, but only if, that person or undertaking acts with a view to gain, for himself or another, or with the intent to cause a loss to another. It shall be a defense for a person or undertaking charged with an offense under Article 81.1 to show that he believed, on reasonable grounds, that he was entitled to use the trademark in relation to the goods in question.

81.4. A person undertaking that commits an offense under this Article 81 shall be liable:

- a. a fine from 1.000 € up to 5.000 € for enterprises,
- b. a fine from 500 € up to 1.000 € for physical persons.

Article 82

Falsification of Register

82.1. It shall be an offense for a person or undertaking to make, or cause to be made, an entry in the Trademark Register which that person or undertaking knows, or has reason to believe, is false.

82.2. It shall be an offense for a person or undertaking to knowingly:

- a. to make, or cause to be made, anything falsely purporting to be a copy of an entry in the register, or
- b. to produce, tender, or cause to be produced or tendered in evidence any such thing.

82.3. A person or undertaking who commits an offense under this Article 82 shall be liable:

- a. a fine from 1.000 € up to 5.000 € for enterprises, and
- b. a fine 500 € up to 1.000 €, for physical persons.

### Article 83 Falsely Representing Trademark as Registered

83.1. It shall be an offense for a person or undertaking:

- a. to falsely represent that a mark is a registered trademark, or
- b. to make a false representation as to the goods or services for which a trademark is registered, knowing or having reason to believe that the representation is false.

83.2. For the purposes of this Article 83, the use in Kosovo in relation to a trademark:

- a. of the word "registered," or
- b. of any other word or symbol importing an express or implied reference to "registration," shall be deemed to be a representation as to registration under the present law unless it is shown that the reference is to registration elsewhere than in Kosovo and that the trademark is in fact so registered for the goods or services in question.

83.3. A person or undertaking guilty of an offense under this Article 83 shall be liable on summary conviction to a fine from 1.000 € up to 5.000 € and, in the case of a continuing offense, to a further fine from 500 € up to 1.000 € for every day on which the offense continues.

### Article 84 Offenses Committed by Undertakings

84.1. Without prejudice to any liability of a partner under Article 84.3, proceedings for an offense under the present law alleged to have been committed by an undertaking that is not a legal entity shall be brought against the undertaking that is not a legal entity in the name of the firm and not in that of the partners.

84.2. A fine imposed on an undertaking that is not a legal entity on its conviction in proceedings brought in accordance with Article 84.1 shall be paid out of the assets of the undertaking that is not a legal entity.

84.3. Where an undertaking that is not a legal entity is guilty of an offense under the present law, every partner, other than a partner who is proved to have been ignorant of or to have attempted to prevent the commission of the offense shall also be guilty of the offense and liable to be proceeded against and punished accordingly.

84.4. Where an offense committed by an undertaking that is a legal entity is proved to have been committed with the consent of, participation of, or to be attributable to any neglect on the part of, any person or undertaking that, when the offense was committed, was a director, manager, secretary, or other similar officer of an undertaking that is a legal entity, or a person who was purporting to act in any such capacity; that person or undertaking, as well as the undertaking that is a legal entity, shall be guilty of an offense, liable to be proceeded against, and punished as if guilty of the offense committed by the undertaking that is a legal entity.

#### Article 85 Jurisdiction of the Court

Without prejudice to the powers conferred by the present law upon the Court, proceedings for an order under Article 20 or 23 may be brought in the Court in the location in which either:

- a. the violating goods, material, or articles, are situated; or
- b. where any person or undertaking resides that has goods, material, or articles, in his possession, custody, or control.

#### Article 86 Unauthorized Use of Emblems of Kosovo

86.1. A person or undertaking shall not use in connection with any business, without the authority of the Minister, the emblems of Kosovo or emblems so closely resembling the emblems of Kosovo that are calculated to deceive or lead to the belief that that person or undertaking is duly authorized to use the emblems of Kosovo.

86.2. A person or undertaking that contravenes the provisions of Article 86 shall be guilty of an offense and shall be liable on summary conviction to a fine from 1.000 € up to 5.000 €

86.3. With proposal of the Patent Office the Minister may apply to the Court for an injunction to restrain any person or undertaking from contravening the provisions of Article 86.1.

86.4. Nothing in this Article shall affect any right of the proprietor of a registered trademark containing any such emblem to use that trademark.

86.5. In any proceedings to restrain any action prohibited under Article 86.1 or any prosecution under Article 86.2, a certificate signed by the Patent Office stating that the emblem is an emblem of Kosovo shall be sufficient evidence of such unless the contrary is proved.

Article 87

Misuse of Trademarks Indicative of origin in Kosovo

The Minister may take, in any place outside Kosovo, such lawful steps, whether by way of action or prosecution at law or otherwise, as he shall think proper to prevent, restrain, or to secure punishment for, the registration, use, or application, in relation to or for goods not grown, produced, or manufactured in Kosovo, of any trademark or other mark or description indicating or suggesting, or likely to lead to the belief, that the goods for which or to which that trademark, mark or description is used or applied were grown, produced or manufactured in Kosovo.

Article 88

Products that convict particular rights of trade marks

Customs Actions against goods suspected of infringing certain trade mark rights and the measures to be taken against goods found to have infringed such rights is part of a special Law.

Article 89

Burden of proving use of Trademark

Where, in any civil proceedings under the present law, an issue arises as to the use made by any person or undertaking of any registered trademark, the burden of proving such use shall lie with the proprietor.

Article 90

Publication of forms

The Patent Office will publish into official bulletin all application form, and necessary instruction that have to do with application forms.

Transitional and final provisions

Article 91

In the purpose of the implementation of this law the Ministry of Trade and Industry will approve by-laws.

Article 92

The present law shall enter into force after adoption by the Assembly of Kosova on the date of its promulgation by the Special Representative of the Secretary-General.

**Law No. 02/L-54**  
**23 February 2006**

**President of the Assembly**  

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**Academic Nexhat Daci**

# ANNEX A

## COLLECTIVE MARKS

### Chapter A-1 General

#### Article A-1

The provisions of the present law shall apply to collective marks subject to the following provisions of this Annex.

### Chapter A-2 Signs of Which a Collective Mark May Consist

#### Article A-2

In relation to a collective mark, the reference in Article 3.1 to “distinguishing goods or services” shall be construed as a reference to distinguishing goods or services of members of the association which is the proprietor of the mark from those of other undertakings.

### Chapter A-3 Indication of Geographical Origin

#### Article A-3

A-3.1 Notwithstanding the provisions of Article 9.1 item “c,” a collective mark that consists of signs or indications which may serve in trade to designate the geographical origin of the goods or service may be registered.

A-3.2 The proprietor of a mark referred to in Article A-3.1 shall not, however, be entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters, in particular, in the case of a person or undertaking that is entitled to use a geographical name.

### Chapter A-4 Mark Not to be Misleading as to Character or Significance

#### Article A-4

A-4.1 A collective mark shall not be registered if there is a substantial likelihood that the public will be misled as to the character or significance of the mark, in particular, if it is likely to be taken to be something other than a collective mark.

A-4.2 The Patent Office may require that a collective mark shall contain some indication that it is a collective mark, and, notwithstanding Article 38.3, an application may be amended so as to comply with any such requirement.

Chapter A-5  
Terms Governing Use of a Collective Mark

Article A-5

A-5.1 An applicant for registration of a collective mark shall file terms governing the use of the mark with the Patent Office.

A-5.2 The terms shall specify the person or undertakings authorized to use the mark, the conditions of membership of the association and, where they exist, the conditions of use of the mark, including any sanctions against misuse of the mark.

A-5.3 Provision may be made by rules for further matters for which terms are required.

Chapter A-6  
Approval of Terms by Patent Office

Article A-6

A-6.1 A collective mark shall not be registered unless the terms governing the use of the mark:

- a. comply with Article A-5.2 and any further requirements imposed by rules; and
- b. are not contrary to public policy or to accepted principles of morality.

A-6.2 An application for a collective mark must be accompanied by the payment of the application fees and a statement of the terms; if the applicant does not do so, the application shall be deemed to be withdrawn.

Article A-7

A-7.1 If it appears to the Patent Office that the requirements for registration have been met, other than those specified in Article A-6, the Patent Office shall consider the matters specified in Article A-6.1 and may:

- a. accept the application;
- b. accept it subject to conditions, including amendment of the regulations or otherwise; or
- c. refuse to accept it.

A-7.2 Where the Patent Office accepts an application subject to specified conditions, and those conditions are complied with within the prescribed period, the Patent Office shall proceed with the publication in the Official Bulletin in accordance with Article 42.

A-7.3 Where the Patent Office accepts an application subject to specified conditions and those conditions are not complied with within the prescribed period, the application shall be deemed to be withdrawn.

Article A-8

A-8.1 The terms governing the use of the mark shall be open to public inspection and notice of opposition may be given, and observations may be made, relating to the matters specified in Article A-6.1.

A-8.2 The provisions of this paragraph are in addition to any other grounds on which an application may be opposed or observations made.

Chapter A-7  
Terms to be Open to Inspection

Article A-9

The terms governing the use of a registered collective mark shall, in like manner as the register, be open to public inspection.

Chapter A-8  
Amendment of Terms  
Article A-10

Where the terms governing the use of a registered collective mark are amended, the terms, as amended, shall not be effective unless and until the amended terms are filed with and accepted by the Patent Office.

Chapter A-9  
Violation Proceedings: Rights of Authorized Users

Article A-11

A-11.1 Subject to any agreement to the contrary between an authorized user and the proprietor, the provisions of this paragraph shall have effect in relation to the violation of a registered collective mark.

A-11.2 An authorized user shall be entitled to call on the proprietor to take violation proceedings regarding any matter which affects the authorized user's interests.

A-11.3 Where the proprietor refuses or fails to take violation proceedings in accordance with Article 11.2 within two months after being called upon to do so, the authorized user may bring the proceedings in the authorized user's name as if the authorized user were the proprietor.

A-11.4 Where the violation proceedings are brought by virtue of Article A-11.3:

- a. the authorized user may not, without the leave of the Court, proceed with the action unless the proprietor is either joined as a plaintiff or added as a defendant; and
- b. a proprietor who is so added as a defendant shall not be liable for any costs in the action unless he takes part in the proceedings.

A-11.5 Nothing in Article A-11.4 shall affect the granting of interlocutory relief on an application by an authorized user alone.

A-11.6 In the course of violation proceedings brought by the proprietor of a registered collective mark, any loss suffered or likely to be suffered by authorized users shall be taken into account by the Court. The Court may give such directions as it thinks fit regarding the extent to which the plaintiff shall hold the proceeds of any pecuniary remedy on behalf of such users.

Chapter A-10  
Grounds for Revocation of Registration

Article A-12

Apart from the grounds of revocation provided for in Article 50, the registration of a collective mark may be revoked on the ground that:

- a. the manner in which the mark has been used by the proprietor has made it misleading to the public in the manner referred to in Article A-4.1;
- b. the proprietor has failed to observe, or to secure the observance of the terms governing the use of the mark; or
- c. an amendment of the terms has been made so that the terms,
  - (i) no longer comply with Article A-5.2 and any further conditions imposed by rules; or
  - (ii) are contrary to public policy or to accepted principles of morality.

Chapter A-11  
Grounds for Invalidity of Registration

Article A-13

Apart from the grounds of invalidity provided for in Article 51, the registration of a collective mark may be declared invalid on the ground that the mark was registered contrary to the provisions of Article A-4.1 or A-6.1.

## **ANNEX B**

### **CERTIFICATION MARKS**

#### **Chapter B-1** **General**

##### **Article B-1**

The provisions of the present law shall apply to certification marks subject to the following provisions of this Annex.

#### **Chapter B-2** **Signs of Which a Certification Mark May Consist**

##### **Article B-2**

In relation to a certification mark, the reference in Article 3.1 to distinguishing goods or services shall be construed as a reference to distinguishing goods or services which are certified from those which are not certified.

#### **Chapter B-3** **Indication of Geographical Origin**

##### **Article B-3**

Notwithstanding the provisions of Article 9.1., item “c,” a certification mark may be registered which consists of signs or indications which may serve in trade to designate the geographical origin of the goods or services; provided, however, that the proprietor of such a mark shall not be entitled to restrain the use of the signs or indications in accordance with honest practices in industrial or commercial matters, in particular, by a person or undertaking that is entitled to use a geographical name.

#### **Chapter B-4** **Nature of Certification Mark Proprietor's Business**

##### **Article B-4**

A certification mark shall not be registered if the proprietor carries on a business involving the supply of goods or services of the kind certified.

#### **Chapter B-5** **Mark not to be Misleading as to Character or Significance**

##### **Article B-5**

B-5.1 A certification mark shall not be registered if the public is liable to be misled with regards to the character or significance of the mark, in particular, if it is likely to be taken to be something other than a certification mark.

B-5.2 The Patent Office may, accordingly, require that a certification mark shall contain some indication that it is a certification mark; and notwithstanding Article 43.3, an application may be amended so as to comply with any such requirement.

Chapter B-6  
Terms Governing Use of Certification Marks

Article B-6

B-6.1 An applicant for registration of a certification mark shall file with the Patent Office terms governing the use of the mark.

B-6.2 The terms shall indicate who is authorized to use the mark, the characteristics to be certified by the mark, how the certifying body is to test those characteristics and to supervise the use of the mark, any fees to be paid in connection with the operation of the mark and the procedures for resolving disputes.

B-6.3 Provision may be made by rules for further matters for which regulations are required.

Chapter B-7  
Approval of Terms by Patent Office  
Article B-7

B-7.1 A certification mark shall not be registered unless the Patent Office is satisfied that:

- a. the terms governing the use of the mark,
  - (i) comply with Article B-6.2 and any further requirements imposed by rules; and
  - (ii) are not contrary to public policy or to accepted principles of morality; and
- b. the applicant is competent to certify the goods or services for which the mark is to be registered.

B-7.2 If it appears to the Patent Office that the requirements for registration other than those in Article B-7.1 are met, the Patent Office shall authorize the applicant to proceed with the application.

B-7.3 An application for a certification mark must be accompanied by the payment of the application fees and a statement of the regulations; if the applicant does not do so, the application shall be deemed to be withdrawn.

Article B-8

B-8.1 The Patent Office shall consider the matters mentioned in Article B-7.1 and may direct:

- a. that the application for registration be accepted;
- b. that the application for registration be accepted subject to conditions; or
- c. that the application for registration not be accepted.

B-8.2 The Patent Office shall publish the mark in accordance with Article 43, when the Patent Office directs that the application be accepted, and any conditions are complied with within the prescribed period.

B-8.3 Where the Patent Office directs that an application be accepted subject to specified conditions and those conditions are not complied with within the prescribed period, the application shall be deemed to be withdrawn.

## Article B-9

The terms shall be published and notice of opposition may be given, and observations may be made, relating to the matters mentioned in Article B-7.1, in addition to any other grounds on which an application may be opposed or observations made.

## Chapter B-8

### Terms to be Open to Inspection

## Article B-10

The terms governing the use of a registered certification mark shall, in like manner as the register, be open to public inspection.

## Chapter B-9

### Amendment of Terms

## Article B-11

B-11.1 An amendment of the terms governing the use of a registered certification mark shall not be effective unless and until the Patent Office consents to the amendment and the amended terms are filed with the Patent Office.

B-11.2 The Patent Office may cause an application for consent under Article B-11.1 to be published in any case where it appears expedient to do so.

B-11.3 Any person or undertaking may, within the prescribed time from the date of the publication of the application, give notice to the Patent Office of opposition to the application. Any such notice shall be given in writing in the prescribed manner and shall include a statement of the grounds of opposition.

B-11.4 After the Patent Office has consented to such an amendment as is mentioned in Article B-11.1, the Patent Office shall publish notice in the Official Bulletin when the amended regulations are filed with it.

## Chapter B-10

### Consent to Assignment of Registered Certification Mark

## Article B-12

The assignment or other transmission of a registered certification mark shall not be effective without the consent of the Patent Office.

Chapter B-11  
Violation Proceedings: Rights of Authorized Users

Article B-13

B-13.1 Subject to any agreement to the contrary between an authorized user and the proprietor, the provisions of this paragraph shall have effect in relation to the violation of a registered certification mark.

B-13.2 An authorized user shall be entitled to call on the proprietor to take violation proceedings for any matter which affects the authorized user's interests.

B-13.3 Where the proprietor refuses or fails to take violation proceedings in accordance with Article B-13.2 within two months after being called upon to do so, the authorized user may bring the proceedings in the authorized user's own name as if the authorized user were the proprietor.

B-13.4 Where violation proceedings are brought by virtue of Article B-13.3:

- a. the authorized user may not, without the leave of the Court, proceed with the action unless the proprietor is either joined as a plaintiff or added as a defendant; and
- b. a proprietor who is so added as a defendant shall not be liable for any costs in the action unless the proprietor takes part in the proceedings.

B-13.5 Nothing in Article A-11.4 shall affect the granting of interlocutory relief on an application by an authorized user alone.

B-13.6 In the course of violation proceedings brought by the proprietor of a registered certification mark, any loss suffered or likely to be suffered by authorized users shall be taken into account by the Court. The Court may give such directions as it thinks fit regarding the extent to which the plaintiff shall hold the proceeds of any pecuniary remedy on behalf of such users.

Chapter B-12  
Grounds for Revocation of Registration

Article B-14

B-14.1 Apart from the grounds of revocation provided for in Article 50, the registration of a certification mark may be revoked on the ground that:

- a. the proprietor has begun to carry on such a business as is mentioned in Article B- 4;
- b. the manner in which the mark has been used by the proprietor has made it misleading to the public in the manner referred to in Article B-5.1,
- c. the proprietor has failed to observe, or to secure the observance of, the terms governing the use of the mark; or

- d. an amendment of the terms has been made so that the terms:
  - (i) no longer comply with Article A-5.2 and any further conditions imposed by rules; or
  - (ii) are contrary to public policy or to accepted principles of morality;
- e. the proprietor is no longer competent to certify the goods or services for which the mark is registered.

B-14.2 An application for revocation on the ground mentioned in Article B-14.1, item “c,” “d,” or “(i),” shall be made to the Patent Office.

### Chapter B-13 Grounds for Invalidity of Registration

#### Article B-15

B-15.1 Apart from the grounds of invalidity provided for in Article 51, the registration of a certification mark may be declared invalid on the ground that the mark was registered contrary to the provisions of Article B-4, or Article B-5.1 or B-7.1.

B-15.2 An application for a declaration of invalidity on the ground that the registration was made contrary to the provisions of Article 7.1 shall be made to the Patent Office.