

# Trademarks

*Contributing editors*

**Claus Eckhartt and Christine Fluhme**



2018



GETTING THE  
DEAL THROUGH 

# Trademarks 2018

*Contributing editors*

**Claus Eckhardt and Christine Fluhme**  
**Bardehle Pagenberg Partnerschaft mbB**

Publisher  
Gideon Robertson  
gideon.roberton@lbresearch.com

Subscriptions  
Sophie Pallier  
subscriptions@gettingthedealthrough.com

Senior business development managers  
Alan Lee  
alan.lee@gettingthedealthrough.com

Adam Sargent  
adam.sargent@gettingthedealthrough.com

Dan White  
dan.white@gettingthedealthrough.com



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## CONTENTS

<b>Angola</b>	<b>7</b>	<b>Korea</b>	<b>93</b>
Márcia Gonçalves Raul César Ferreira (Herd) SA		Yoon Bae Kim Kims and Lees	
<b>Australia</b>	<b>11</b>	<b>Kyrgyzstan</b>	<b>98</b>
Marie Wong Wrays		Omurgul Balpanova and Aisulu Chubarova ARTE Law Firm	
<b>Austria</b>	<b>19</b>	<b>Macao</b>	<b>102</b>
Peter Israiloff Barger, Piso & Partner		Márcia Gonçalves Raul César Ferreira (Herd) SA	
<b>Brazil</b>	<b>25</b>	<b>Malaysia</b>	<b>106</b>
Philippe Bhering and Jiuliano Maurer Bhering Advogados		Jin Nee Wong Wong Jin Nee & Teo	
<b>Cape Verde</b>	<b>32</b>	<b>Malta</b>	<b>111</b>
Márcia Gonçalves Raul César Ferreira (Herd) SA		Henri Mizzi, Sharon Xuereb and Terence Cassar Camilleri Preziosi Advocates	
<b>Chile</b>	<b>36</b>	<b>Mexico</b>	<b>116</b>
Francisco Silva and Luis Felipe Opazo Silva		Marcela Bolland Uhthoff, Gomez Vega & Uhthoff SC	
<b>Colombia</b>	<b>41</b>	<b>Mozambique</b>	<b>121</b>
Juan Guillermo Moure, Juan Felipe Acosta, Isabella Herrera, Maria Alejandra Pava and Bibiana Agudelo OlarteMoure		Márcia Gonçalves Raul César Ferreira (Herd) SA	
<b>Ecuador</b>	<b>46</b>	<b>Nigeria</b>	<b>125</b>
María Rosa Fabara Vera Fabara & Compañía Abogados		Fred Onuobia, Solomon Ezike and Blessing Akunebu G Elias & Co	
<b>France</b>	<b>52</b>	<b>Pakistan</b>	<b>129</b>
Catherine Mateu Armengaud Guerlain		Ali Kabir Shah and Hanya Haroon Ali & Associates	
<b>Germany</b>	<b>58</b>	<b>Peru</b>	<b>135</b>
Claus Eckhardt and Christine Fluhme Bardehle Pagenberg Partnerschaft mbB		María del Carmen Arana Courrejolles Estudio Colmenares & Asociados	
<b>Guatemala</b>	<b>64</b>	<b>Portugal</b>	<b>142</b>
Marco Antonio Palacios and Hilda Monterroso Palacios & Asociados/Sercomi		Patricia Rodrigues Raul César Ferreira (Herd) SA	
<b>Honduras</b>	<b>70</b>	<b>Russia</b>	<b>146</b>
Ricardo Anibal Mejía Bufete Mejía & Asociados		Vladimir Trey and Evgeny Alexandrov Goroditsky & Partners	
<b>India</b>	<b>76</b>	<b>São Tomé and Príncipe</b>	<b>153</b>
Swati Sharma and Safir R Anand Anand and Anand		Márcia Gonçalves Raul César Ferreira (Herd) SA	
<b>Italy</b>	<b>82</b>	<b>Saudi Arabia</b>	<b>157</b>
Adriano Vanzetti and Giulio E Sironi Vanzetti e Associati		Mohammad Jomoa and Asif Iqbal Kadasa & Partners	
<b>Japan</b>	<b>88</b>	<b>Serbia</b>	<b>163</b>
Masayuki Yamanouchi, Ai Nagaoka and Satoko Yokogawa Anderson Mōri & Tomotsune		Bogdan Ivanišević and Marko Popović BDK Advokati	
		<b>Singapore</b>	<b>168</b>
		Kiran Dharsan Seiter Seiter IP Consultants LLP	

<b>South Africa</b>	<b>175</b>	<b>Turkey</b>	<b>195</b>
Debbie Marriott, Eugene Honey and Reinhardt Biermann Adams & Adams		Ahmet Akguloglu ATG Law Firm	
<b>Switzerland</b>	<b>181</b>	<b>United Kingdom</b>	<b>201</b>
Jürg Simon and the Lenz & Staehelin IP team Lenz & Staehelin		Robert Guthrie and Becky Crawford Osborne Clarke LLP	
<b>Taiwan</b>	<b>186</b>	<b>United States</b>	<b>207</b>
Victor SC Lee, Crystal J Chen, Nick JC Lan, Yiling Liu and Iris LC Lin Tsai, Lee & Chen		Anthony F Lo Cicero and Max Vern Amster, Rothstein & Ebenstein LLP	
<b>Tanzania</b>	<b>191</b>	<b>Venezuela</b>	<b>213</b>
Patrick Sanga and Haika-Belinda John Macha Vemma Consult Attorneys		María Milagros Nebreda Hoet Peláez Castillo & Duque	

# Serbia

**Bogdan Ivanišević and Marko Popović**

**BDK Advokati**

## 1 Ownership of marks

### Who may apply?

Natural persons and legal entities, Serbian or foreign, may apply for registration of a trademark in Serbia. If the applicant is a foreign natural person or foreign legal entity, with no residency or registered seat in Serbia, he or she must be represented by a Serbian lawyer or by a person registered with the Serbian Intellectual Property Office (the IP Office) as a trademark representative.

## 2 Scope of trademark

### What may and may not be protected and registered as a trademark?

According to the Trademark Act (2010, amended in 2013), different types of signs can be registered as a trademark. Examples include signs consisting of words, slogans, letters, numerals, images, colour combinations, three-dimensional shapes, and sounds (if represented by musical notation).

A provision in the Trade Act (2010, amended in 2013) serves as a statutory basis for protection of unregistered marks, apart from well-known marks, which are regulated by the Trademark Act. The Trade Act identifies as a mode of unfair competition the sale of goods with a mark, information or shape that reasonably create confusion among consumers as to the origin, quality and other features of the goods.

## 3 Common law trademarks

### Can trademark rights be established without registration?

With the exception of well-known marks (within the meaning of article 6-bis of the Paris Convention), trademark rights can be established only with application (ie, registration). Unregistered marks can be protected under distinct legislation that prohibits unfair competition. The Trade Act (2010) considers it a form of unfair competition to sell goods with marks, information or shape that reasonably create confusion among consumers as to the origin, quality and other features of the goods.

## 4 Registration time frame and cost

### How long does it typically take, and how much does it typically cost, to obtain a trademark registration? What circumstances would increase the estimated time and cost of filing a trademark application and receiving a registration?

### What additional documentation is needed to file a trademark application?

The average time frame for smooth trademark registration at the IP Office has risen to nine months, from six months in preceding years. The duration of the proceedings increases if the applicant must submit evidence for acquired distinctiveness or otherwise respond to provisional refusal by the IP Office.

The official fee for obtaining a trademark registration for a word mark in up to three classes is approximately €380. The attorney fees for registration of the mark vary from €200 to €400.

If a legal representative files the application on behalf of the client, the representative must enclose a power of attorney with the application.

## 5 Classification system

### What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed? Are multi-class applications available and what are the estimated cost savings?

The IP Office follows the Nice Classification System. Applicants can request registration of a trademark in up to three classes of goods and services for a fee payable to application for registration in one class (approximately €125). In a multi-class application for registration in four or more classes, the application fee for each additional class after the third class is approximately €25.

## 6 Examination procedure

### What procedure does the trademark office follow when determining whether to grant a registration? Are applications examined for potential conflicts with other trademarks? May applicants respond to rejections by the trademark office?

The IP Office first checks whether the trademark application meets the formal requirements and then moves to the stage of substantive examination. Serbia does not use opposition proceedings, so the IP Office conducts examination on both relative and absolute grounds for refusal of registration. However, an interested party may file an observation that will be taken into consideration by the IP Office.

A mark cannot enjoy trademark protection if it is identical to an earlier registered trademark (or applied-for mark) or a well-known mark for identical goods and services, or if owing to the similarity of the marks and goods or services there exists a likelihood of confusion, including the likelihood of association with the earlier trademark (or applied-for mark) on the part of the relevant public.

Marks with reputation, if registered, are protected regardless of the goods or services if the use of the later mark would result in taking unfair advantage from the reputation of the earlier trademark with reputation, or be detrimental to its distinctive character or the repute.

If the IP Office initially determines that there are grounds for refusal of registration, it notifies the applicant of the provisional refusal. The applicant may then submit counter-arguments to the IP Office in writing.

If the IP Office finds that the application meets the requirements for registration, the IP Office requests from the applicant to pay a fee for the initial 10-year period as well as the costs of publication of the trademark in the IP Office's Gazette. Following the receipt of a proof of the payment from the applicant, the IP Office enters the trademark in the Trademark Registry and issues a registration certificate to the trademark owner.

## 7 Use of a trademark and registration

**Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? Are foreign registrations granted any rights of priority? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a third-party challenge on grounds of non-use?**

It is not necessary to use a mark in commerce in order to obtain trademark registration. After the registration, and before the expiry of a five-year period, the trademark owner must put the trademark to genuine use in relation to the goods or services for which the mark is registered. If not, any interested party may obtain revocation of the registration from the IP Office.

Application for a registration in a member state of the Paris Union or the World Trade Organization may be granted the right of priority in Serbia if the applicant files an application within six months for an identical mark for identical goods or services. The applicant must submit a certificate of priority in the foreign country within three months of filing the request for national registration in Serbia.

## 8 Appealing a denied application

**Is there an appeal process if the application is denied?**

If the IP Office refuses the registration by a final decision, the applicant may submit an appeal to the Government of the Republic of Serbia, within 15 days from the receipt of the decision by the IP Office. If the Administrative Commission rules against the applicant, the latter may initiate judicial proceedings before the Administrative Court within 30 days from the receipt of the decision of the government.

## 9 Third-party opposition

**Are applications published for opposition? May a third party oppose an application prior to registration, or seek cancellation of a trademark or service mark after registration? What are the primary bases of such challenges, and what are the procedures? May a brand owner oppose a bad-faith application for its mark in a jurisdiction in which it does not have protection? What is the typical range of costs associated with a third-party opposition or cancellation proceeding?**

There is no opposition procedure under the framework of the Trademark Act. Instead, the IP Office examines ex officio both the relative and the absolute grounds for refusal of the trademark protection. The owner of the earlier trademark application or registration, and any interested party, may, however, submit written observations in order to alert the IP Office that the trademark applied-for does not meet requirements for registration.

A brand owner who does not have registration of the mark in Serbia may prevent registration of a trademark applied-for in bad faith, by filing a lawsuit before a competent court. The owner may request the court to declare him or her as the applicant.

After the trademark has been registered, a third party may obtain cancellation (invalidity or revocation) in administrative proceedings before the IP Office.

In proceedings for invalidity, the third party must prove that at the time of the registration the requirements for registration had not been met. This means that the trademark may be declared invalid if:

- it is contrary to public policy or to accepted principles of morality;
- it is not distinctive;
- it is functional (ie, represents a shape determined exclusively by the nature of the product or a shape indispensable to obtain a given technical result);
- it is descriptive (ie, it designates exclusively the type, purpose, time or method of production, quality, price, quantity, weight or geographical origin of the goods or services);
- it is generic (ie, it is customary for designating a given type of goods or service);
- it is misleading with regard to the geographical origin, type, quality, or other features of the goods or services;

- it contains or imitates official marks or hallmarks of quality control or warranty;
- it conflicts with prior industrial property rights (including registered trademark right as well as a well-known mark not registered in Serbia), copyright or the right in a personal name;
- it comprises of state or other public coat of arms, flag or other emblem, name or abbreviation of the name of a country or of an international organisation, unless the competent authority of the country or organisation has given its authorisation for such use; or
- it represents or imitates a national or religious symbol.

A trademark registration may be revoked and removed from the Trademark Registry for any of the following reasons:

- if the trademark owner (or a person authorised by him or her) did not use the trademark for five years from the date of trademark registration or for any uninterrupted period of five years from the date of the last use;
- the trademark has become a common name for the product or service for which it is registered;
- the trademark is of such a nature that it may deceive the public as to the nature, quality, geographical origin, or other characteristics of the goods or services; or
- the trademark has become contrary to public policy or to accepted principles of morality.

Where grounds for revocation or declaration of invalidity exist in respect of only some of the goods or services, the trademark is to be revoked or declared invalid only in part.

The fee for initiating cancellation proceedings is approximately €250.

## 10 Duration and maintenance of registration

**How long does a registration remain in effect and what is required to maintain a registration? Is use of the trademark required for its maintenance? If so, what proof of use is required?**

The term of protection is 10 years from the date of filing the application. Trademark registration can be renewed for an unlimited number of successive 10-year periods. In order to renew the registration, the trademark owner has to pay an office fee.

The owner does not need to present any proof of use to the IP Office in order to obtain renewal of a registration. However, the IP Office can revoke the trademark at the request of an interested party if the owner, or a person authorised by him or her, has not put the trademark to genuine use within a period of five years following registration or for any uninterrupted period of five years from the date of its last use. Exceptionally, non-use does not lead to revocation if there have been proper reasons for non-use. Such proper reasons, according to the Trademark Act, include a decision by government authority, an import ban, or any other prohibition affecting goods or services or both protected by the mark.

Only genuine, commercial use qualifies as the use for the purpose of maintaining trademark rights. The quantity of goods or services for which the mark is used must be such to indicate a serious rather than fictitious economic activity. The payment of registration renewal fees, or mere advertising of a trademark without the possibility of buying advertised goods or services, do not amount to genuine use.

## 11 The benefits of registration

**What are the benefits of registration?**

Registration enables the trademark owner to obtain protection from courts or customs and market authorities from unauthorised third-party use of identical or similar mark used in connection with similar or identical goods or services. Compared with the protection granted under unfair competition law, registration offers a broader scope of remedies for infringement and leaves the trademark owner with a longer statute of limitations for bringing the lawsuit. Registration also entitles the trademark owner to prevent others from registering a confusingly similar mark and to seek cancellation of such subsequent registration. Trademark registration also provides a defence to infringement.

**12 Licences**

**May a licence be recorded against a mark in the jurisdiction? Are there any benefits to doing so or detriments to not doing so?**

If a licence is not recorded, it is nonetheless effective between the parties to the licence agreement. However, an exclusive licensee may not oppose a licence subsequently granted by the licensor to an unwitting third party. Also, in the absence of recordation, the licensee may not make use of the Trademark Act's provision authorising a trademark licensee to launch court proceedings against a third-party infringer.

**13 Assignment**

**What can be assigned?**

Trademark can be assigned both with and without goodwill. The assignment may be for some or all of the goods (ie, services) encompassed by the registration. Trademarks can be transferred separately and independently from other business assets.

**14 Assignment documentation**

**What documents are required for assignment and what form must they take?**

Assignment of a trademark or a trademark application can be based on an assignment agreement, a change of the legal status of the trademark owner (if a legal entity), or on a court or administrative decision. An assignment agreement has to be in writing. It need not be notarised. The agreement has to include the following information:

- the date of the execution;
- the names or business names of the parties;
- the domicile or residence or the registered seat, of the parties;
- the trademark registration number or the number of the trademark application; and
- the fee.

**15 Validity of assignment**

**Must the assignment be recorded for purposes of its validity?**

For assignment to be enforceable as between the parties, no approval from the IP Office is necessary. However, recordation of the trademark assignment in the Trademark Registry is necessary for the assignment to have effect against third parties. Without a recordation, the assignee may not bring proceedings for infringement of the trademark against a third party, and ask for protection from the customs authority or market inspectorate.

**16 Security interests**

**Are security interests recognised and what form must they take? Must the security interest be recorded for purposes of its validity or enforceability?**

A trademark owner may create a pledge on the trademark in order to secure the rights of his creditor. The pledge is valid and enforceable only upon the recordation in the Trademark Registry. The pledge agreement does not have to be notarised.

**17 Markings**

**What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?**

A trademark owner may use symbols such as <sup>TM</sup> or <sup>®</sup> to indicate trademark use or registration. The benefit of using such symbols would be raising awareness of consumers and competitors that the sign enjoys trademark protection. The risks of not using such words or symbols are small, because the use is not mandatory and third parties using an identical or confusingly similar mark could not rely on the absence of such sign as a defence against trademark infringement.

**18 Trademark enforcement proceedings**

**What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer or dilutive use of a mark, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?**

The owner of a registered trademark and trademark applicant may file a lawsuit against the alleged infringing party, within three years of learning about the infringement and the infringer, but not after the expiration of a five-year period after the first occurrence of infringement.

The plaintiff may request the court to declare that the defendant was responsible for trademark infringement and to order cessation of the infringing activities. In addition, the lawsuit may include the requests for seizure, definitive removal or destruction or alteration of the infringing goods, destruction or alteration of the tools and equipment used to manufacture the infringing goods, compensation of damages and reimbursement of costs and publication of the judgment at the expense of the defendant. Finally, the plaintiff may request via the lawsuit that the defendant furnish information about third parties involved in the infringement.

The holder of an unregistered trademark can launch court proceedings pursuant to the unfair competition provision in the Trade Act. The statute of limitations is six months after learning about the infringement and the infringer, but in no event longer than three years after the unlawful activity has ended. The plaintiff may request a declaration of unfair competition, an injunctive relief, rectification of the consequences of the unfair competition, compensation of damages, and publication of the judgment at the expense of the defendant.

The trademark owner may submit a request to the Customs Authority for implementation of protective measures against counterfeited goods. The request may refer to a single shipment or the shipments in general. The Customs Authority may grant the request for an initial period of one year. When the Customs Authority suspects that the goods held at the customs might infringe intellectual property rights, the Authority suspends the release of the goods and notifies the trademark owner. The trademark owner may request destruction of the goods at his or her expense or commence infringement proceedings before the competent court.

In addition, the trademark holder is entitled to file an application to protect his or her rights to the Market Inspectorate. This tool is similar and complementary to the customs application.

Jurisdiction of a particular type of court in a trademark case depends on the legal nature of the parties to the proceedings. The Organisation of Courts Act (2008, last amended in 2016) provides that the Commercial Court in Belgrade decides in trademark cases if both parties are commercial entities. If one or both parties are natural persons, the jurisdiction belongs to the High Court in Belgrade. There are no specialised courts or other tribunals dealing with trademarks. This relates to the judges deciding in first-instance proceedings, too. However, the Appellate Commercial Court has specialised chambers with judges whose primary field of expertise is trademark law.

Trademark infringement may be prosecuted as a criminal offence if the defendant, acting with the intent to deceive, used the mark or included elements of the mark in its own trade name, designation of geographical origin, trademark or other sign. Criminal prosecution may also encompass those who acquire, manufacture, process, place into commerce, lease or store the counterfeited goods with intent to sell such goods in substantial quantities or value.

**19 Procedural format and timing**

**What is the format of the infringement proceeding?**

The trademark owner or the licensee initiates infringement proceedings by filing a lawsuit with the competent court. If a commercial court has the jurisdiction to hear a trademark case, the jurisdiction to try the case in the first instance belongs to the Commercial Court in Belgrade. If, exceptionally, a court of general jurisdiction decides in the trademark case, the High Court in Belgrade hears the case in the first instance. The plaintiff often accompanies the lawsuit with a motion for a preliminary injunction.

Serbian civil procedure does not provide for discovery as a pretrial procedure enabling each party to obtain evidence from the other party. However, the parties may make use during the trial of various disclosure devices for obtaining evidence from the adverse party or from third parties (see question 23).

At the trial stage, the court regularly hears witnesses and examines documentary evidence received from the parties. The courts do not look favourably on the use of expert opinions in the infringement proceedings, because the likelihood of confusion and other issues central to an infringement case require legal or factual determinations which the courts are qualified to make by taking into consideration the viewpoint and experience of the average consumer of the goods or services. The use of surveys is permitted, but occurs extremely rarely owing to the high costs involved.

## 20 Burden of proof

### What is the burden of proof to establish infringement or dilution?

The trademark owner has to prove that the defendant has carried out unlawful activities which amount to infringement or dilution of the owner's right. In the preliminary injunction proceedings, the trademark proprietor needs only to prove that infringement probably occurred (ie, in a dilution case, that the court will probably find a likelihood of dilution at the end of the trial).

## 21 Standing

### Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?

Apart from the trademark owner, the trademark licensee may also file an action for infringement or bring a criminal complaint, irrespective of whether the licence is exclusive or non-exclusive. The parties to the licence agreement may stipulate in the agreement that only the trademark owner may initiate court proceedings.

An applicant for trademark registration is also authorised to lodge an action for infringement.

## 22 Foreign activities

### Can activities that take place outside the country of registration support a charge of infringement or dilution?

As trademark is a territorial right, only the activities carried out in the country of registration are generally relevant for the assessment of an infringement or dilution. However, the trademark owner may submit a request for implementation of protective measures against counterfeited goods to the Customs Authority. The proceedings before the customs authority may result in the filing of a lawsuit by the trademark owner against the importer or freight-forwarder.

There is still no significant body of jurisprudence from which one might infer the criteria the courts use in order to determine whether an online infringement of trademark occurred in Serbia or abroad.

## 23 Discovery

### What discovery or disclosure devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?

According to the Civil Procedure Act, a party to the proceedings may request and obtain the inspection of premises, vehicles, books and documents, as well as the seizure of items.

Under the Trademark Act, the court may secure the evidence by issuing a preliminary injunction at the request of the plaintiff whose trademark has likely been infringed or is likely to be infringed. If there is a risk that the plaintiff will suffer non-repairable damage, the court may issue the injunction without hearing the defendant.

In criminal cases, the trial court may order the seizure of infringing goods where there is a risk that evidence might be destroyed.

## 24 Timing

### What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?

It typically takes up to one month to decide on a motion for the preliminary injunction.

Depending on the complexity of the case and the expediency of the parties to the proceedings, the trial at the first instance may take any time between six months and one year, and in exceptional cases even two years or more. The procedure before the appellate court is shorter, so the Appellate Commercial Court tends to issue its decision within a few months after the losing party lodged an appeal. When the Appellate Commercial Court sets aside the first-instance judgment, it sends the case to retrial, so the proceedings overall may take two or more years.

## 25 Litigation costs

### What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?

The costs for bringing an infringement to conclusion in the first instance, including the attorney fees, in a case of standard complexity and duration range from €1000 to €3,000.

The losing party is required, under the general rules of the Civil Procedure Act governing adversary proceedings, to reimburse the prevailing party for the costs of litigation, including court fees and minimum attorney fees.

## 26 Appeals

### What avenues of appeal are available?

The Appellate Commercial Court, located in the capital Belgrade, decides on the appeals against the first-instance judgment rendered by a commercial court. If, exceptionally, a court of general jurisdiction decides in the trademark case, the appeals are heard by the Appellate Court in Belgrade. The Supreme Court of Cassation may hear a trademark case if the party that lost on the appeal proves that conditions are in place for filing an extraordinary legal remedy (revision, application for review of the final and binding judgment, or application for reopening of the proceedings).

## 27 Defences

### What defences are available to a charge of infringement or dilution, or any related action?

The alleged infringer may, apart from denying a likelihood of confusion or dilution, rely on several defences against the infringement claim. If the allegedly infringing sign is a prior trademark, this fact would negate an infringement. Also, the alleged infringer may object that the plaintiff has abandoned the trademark by not using it for five years from the date of registration or for any uninterrupted period of five years from the date of its last use.

Furthermore, the Trademark Act provides for a number of limitations which the alleged infringer may use as the defence. Thus, the trademark owner cannot prevent a third party from placing in the line of commerce the goods or services under a sign identical or similar to the trademark, if that sign represents the third party's company name or a designation acquired in good faith before the priority date of the trademark. Also, the trademark holder cannot prohibit a third party from using in the course of trade and in accordance with honest business practices his or her own name or address, or indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production or other characteristics of the goods or services. Finally, the trademark holder cannot prevent a third party from using the trademark when it is necessary to indicate the intended purpose of a product or services, in particular as accessories or spare parts.



**28 Remedies**

**What remedies are available to a successful party in an action for infringement or dilution, etc? What criminal remedies exist?**

The remedies available to the trademark owner include declaration of infringement, cessation of infringing activities, seizure, definitive removal or destruction or alteration of the infringing goods and the means for manufacturing such goods, compensation of damages and reimbursement of costs, publication of the judgment at the expense of the defendant, and provision of information on the other who took part in the infringement.

In the case of wilful infringement or infringement caused by gross negligence the trademark owner may claim damages in the amount three times that of the licence fee the trademark owner would reasonably obtain.

Both preliminary and interim injunctions are available to the plaintiff. An injunction in a trademark case is easier to obtain than in other types of cases. Under the Trademark Act, it suffices for the plaintiff to show that infringement has likely occurred or is likely to occur. In other types of disputes the identity in kind between the injunctive relief and the final relief sought is an obstacle to obtaining the injunction. Also, the party seeking the injunction in a non-trademark case has to demonstrate the risk that, absent an injunction, the other party is likely to frustrate or substantially hamper recovery of damages.

The Criminal Code provides for the criminal offence of non-authorised use of another's business name or of other indication of goods or services. The penalty is a monetary fine or up to three years' imprisonment.

**29 ADR**

**Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?**

Alternative dispute resolution is not a common way of settling a trademark case in Serbia. By far the largest number of trademark cases are resolved by the courts.

**30 Famous foreign trademarks**

**Is a famous foreign trademark afforded protection even if not used domestically? If so, must the foreign trademark be famous domestically? What proof is required? What protection is provided?**

The IP Office has taken a position that a foreign trademark with reputation (famous trademark) may enjoy protection in Serbia even if it is not used in the country. The methodology of the IP Office specifies that the use of the mark in Serbia is not a condition for determining that the sign is famous. According to the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks adopted in 1999 by the World Intellectual Property Organization, member states should not require as a condition for determining whether a mark is famous that the mark has been used in the member state (article 2(3)(i)).

**BDK**

Advokati  
Belgrade • Podgorica • Banja Luka

**Bogdan Ivanišević**  
**Marko Popović**

**bogdan.ivanisevic@bdkadvokati.com**  
**marko.popovic@bdkadvokati.com**

Majke Jevrosime 23  
11000 Belgrade  
Serbia

Tel: +381 11 3284 212  
Fax: +381 11 3284 213  
www.bdkadvokati.com

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Air Transport	Fintech	Private Banking & Wealth Management
Anti-Corruption Regulation	Foreign Investment Review	Private Client
Anti-Money Laundering	Franchise	Private Equity
Arbitration	Fund Management	Product Liability
Asset Recovery	Gas Regulation	Product Recall
Automotive	Government Investigations	Project Finance
Aviation Finance & Leasing	Healthcare Enforcement & Litigation	Public-Private Partnerships
Banking Regulation	High-Yield Debt	Public Procurement
Cartel Regulation	Initial Public Offerings	Real Estate
Class Actions	Insurance & Reinsurance	Renewable Energy
Commercial Contracts	Insurance Litigation	Restructuring & Insolvency
Construction	Intellectual Property & Antitrust	Right of Publicity
Copyright	Investment Treaty Arbitration	Securities Finance
Corporate Governance	Islamic Finance & Markets	Securities Litigation
Corporate Immigration	Labour & Employment	Shareholder Activism & Engagement
Cybersecurity	Legal Privilege & Professional Secrecy	Ship Finance
Data Protection & Privacy	Licensing	Shipbuilding
Debt Capital Markets	Life Sciences	Shipping
Dispute Resolution	Loans & Secured Financing	State Aid
Distribution & Agency	Mediation	Structured Finance & Securitisation
Domains & Domain Names	Merger Control	Tax Controversy
Dominance	Mergers & Acquisitions	Tax on Inbound Investment
e-Commerce	Mining	Telecoms & Media
Electricity Regulation	Oil Regulation	Trade & Customs
Energy Disputes	Outsourcing	Trademarks
Enforcement of Foreign Judgments	Patents	Transfer Pricing
Environment & Climate Regulation	Pensions & Retirement Plans	Vertical Agreements

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