

Intellectual Asset Management



Recent developments in IP legislation

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Croatian IP legislation is in line with all the major legal systems worldwide and the government makes changes as necessary to provide a well-rounded and efficient system of IP protection.

Croatia is taking part in negotiations to join the European Union. Within that process, the government must harmonise its legislative framework with that of the European Union.

The negotiations over Chapter VII, which deals with IP protection, have now been completed and the recent changes to Croatian legislation were made as a direct consequence of these negotiations.

Changes to the Trademarks Act

The changes have added new grounds for absolute refusal of a trademark - protection will be denied to a trademark or a mark of geographical origin that is valid in Croatia if the request was filed after the request for another trademark or mark of geographical origin for the same type of goods or services.

The biggest amendment to the Trademark Act and the Industrial Design Act is the new section "Continuation of the proceedings", which enables applicants which have failed to carry out a required action within the prescribed timeframe, and have thereby suffered a loss of rights in their trademark application or in the trademark itself, to apply for continuation of the proceedings.

The deadline for filing such a request expires two months after the applicant or rights holder becomes aware of the loss of rights in the trademark application or the trademark itself. However, there are some exceptions where there is no possibility of resuming the proceedings:

- A request to resume the proceedings cannot be filed if the applicant missed the deadline set out in Articles 18 and 19 of the Trademark Act regarding the Paris Convention priority right and the exhibition priority right. The articles allow applicants six months to file the trademark application in Croatia in order to benefit from the prior date on which they filed for protection in another convention member state or from the date of exposition of the product or service.
- No request to resume can be filed where a trademark owner fails to renew trademark protection within the deadline following the original 10-year protection period, although there is already an option to file a renewal request during the six-month period after the lapse of the 10-year period for twice the official fee.
- Missing the deadline for filing an appeal against the first instance State Intellectual Property Office (SIPO) decision is also excluded from the protection provided by the new provisions allowing the resumption of proceedings.
- A request to resume proceedings cannot be filed in proceedings where other parties are involved.

A new provision has been added in the nullification procedures section of the Trademarks Act whereby a party can request the nullification of a trademark if the owner acted in bad faith at the time of filing the request for trademark protection.

Another new provision concerns the modification of the guarantee trademark. The act now clearly states that the guarantee trademark holder is not entitled to autonomous use of the guarantee trademark, but is authorised to supervise and authorise its use with respect to entrepreneurs which are authorised to use the trademark.

The next new section introduced into the act comes under the title "Transformation of an internationally registered trademark into a national application for trademark protection". New Article 63a provides that if all the prerequisites are fulfilled for the transformation of an internationally valid trademark in Croatia into a national one before or on the day when the trademark is removed from the international trademarks register, the trademark will be registered at the SIPO, provided that the official fees for the 10-year protection period and the publication of the trademark have been paid.

The registration date for the transformed trademark will be the international filing date.

In regard to international trademarks not valid in Croatia on or before the day of removal from the international trademarks register, proceedings started on or before the day of filing the request for the transformation are considered to be an integral part of the national request for trademark protection. As with the transformed trademark mentioned before, the priority date will be that of the international registration of the trademark.

In addition, the "proof of use" provision has been amended. Article 66 now provides that in proceedings following filed opposition or nullification proceedings, the date of the international trademark registration is considered to be the date when the one-year term has lapsed from the notification of the international office regarding the request to extend protection to Croatia.

If the proceedings following the request for the extension of trademark protection to Croatia are not concluded within the one-year term, the date of international registration is considered to be the date when the SIPO notified the international office of its final decision.

Article 67e, regulating the conversion of the Community trademark and the inclusion of a Community trademark in a national trademark application, has also been modified. It now covers the Community trademark and provides that such a mark can be converted into a national trademark application and that the procedure is the same as for a national trademark application.

Changes to the Patent Act

Amendments have been made to Articles 57(5) and 57a(4), which prescribe that, in addition to other exclusions, a request for reversion to the previous condition or for the continuation of proceedings cannot be filed because of a missed deadline for filing an appeal.

In the section dealing with the limitation of effects regarding patents in the field of biotechnology, exclusive rights regarding biological material are to be excluded in relation to such material being put on the market not only in Croatia, but also, once Croatia has become an EU member state, in EU member states and countries which are party to the European Economic Area Agreement.

In Article 69a the description of a pharmaceutical product has been amended regarding the application of such products - the part of the definition stating that it "causes pharmacological, immunological or metabolic actions" has been removed.

In the section on additional protection certificates in regard to medicines for human or animal use, the act now provides that such certificates can be issued in cases where the base patent is granted for a product which is part of a drug intended for humans or animals or for the protection of plants, where the drug requires a marketing authorisation from a competent government body.

The rights obtained under this certificate can be awarded for the period from the first application of the base patent to the date of issuance of the marketing authorisation for the product protected by that patent, minus a five-year period.

The certificate is issued at the request of the holder of the base patent, provided that on the day of filing of such a request:

- the product is protected by a valid base patent;
- an appropriate marketing authorisation has been issued and is still valid;
- the product has not already been the subject of a certificate; and
- the authorisation is the first marketing authorisation.

The request for issuance of the certificate must be filed within six months of the issuance of the marketing authorisation and, if such an authorisation was issued before the base patent was granted, within six months of the date of publication of data on the decision to grant the patent.

The protection awarded by the certificate will pertain only to the product covered by the authorisation for marketing the drug and for any use of the product which was authorised before the expiry of the certificate.

The holder of the base patent can request the issue of the certificate for Croatia within six months of the date of Croatia's accession to the European Union if on that day the holder holds a marketing authorisation granted after 1st January 2003 in any EU member state or Croatia.

The London Agreement applies to all EU patents, as well as extended EU patents, regardless of whether they were granted after the first instance proceedings or after an appeal, and on whose granting or change the European Patent Office has published information.

Changes to the Industrial Design Act

Article 32 of the Industrial Design Act, which deals with the formal examination of the application, has been supplemented with two additional sub-paragraphs stating that an application with an established filing date cannot be altered by widening the subject to be protected. The only changes allowed are corrections of the applicants' names and addresses and corrections of obvious mistakes in the text or another obvious mistake, provided that they do not widen the subject.

Article 44c dealing with Community designs has been amended so that Community design applications, as well as granted Community designs, are now regarded as earlier designs in relation to national design applications.

Article 44e(2), which dealt with the possibility of filing a lawsuit by claiming that a design is null and void because of the existence of absolute grounds relating to Community designs, has been removed.

The time limit for responding to the provisional refusal of protection in regard to the extension of effects of an international registration to Croatia, in line with Article 8 of the Hague Act and Article 12 of the Geneva Act of 1999, has been amended and is now four months from the day following the date of receipt of the provisional refusal.

In addition, the option to continue proceedings has been added in a similar manner to that in the Trademarks Act.

Changes to the Act on the Protection of Topographies of Semi-conductor Products

The Act on the Protection of Topographies of Semi-conductor Products has undergone minor amendments with respect to the exhaustion of rights. The concept of EU exhaustion has been implemented, but will enter into force only upon Croatia entering the European Union.

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