

Croatia – the 28th Member State of the European Union

By Katarina Kompari, LL.M., Živko Mijatović & Partners (ZMP), Croatia

On 1st of July 2013, Croatia joined the European Union, becoming thus the 28th Member State. The IP legislation was fully drafted and prepared to take effect well before, and therefore all the clauses referring to Community Trademark (CTM) have taken effect as of July 1st, 2013. The CTM system does not mean that the national system is being abolished, but rather that the Trademark Holders have parallels systems to choose from. The decision which route to take will, as in any other Member State, highly depend on the scope of the activities of the Trademark Holder, as well as the importance of EU vs Croatian market for their brands/products/services. Though at first it may seem that a national system may become superfluous when compared to the CTM system, the experience of the other Member States has shown that it is not the case, mostly due to reasons such as obstacle to register in one Member State would prove detrimental to the unitary character of the CTM. Furthermore, the Trademark Holders still feel more confident, in some cases due to various reasons, if they hold and/or take the national route while considering the strategy on the wider scale.

As with previous enlargements, the effects of applications for a Community trade mark filed and Community trade marks acquired before the day of the acceptance of the Republic of Croatia into the full membership of the European Union shall extend to the territory of the Republic of Croatia. For Croatia this means that over 850.000 trademarks and 520.000 registered designs have gained protection for the territory of the Republic of Croatia as of July 1st, 2013.

According to the Trademark Act, a Community trade mark shall be an earlier trade mark in relation to national trademark applications which are filed, as well as national trademarks which are acquired on such applications after the day of the acceptance of the Republic of Croatia into the full membership of the European Union.

A national trademark may not be declared to be invalid for the reason of being in conflict with an earlier Community trade mark, if such earlier Community trade mark fails to fulfill the conditions of use provided for in Article 15 of the Regulation on the Community trade mark.

CTM CLEREANCE SEARCHES

Now the searches will have to include Croatia, as the CTMs will be examined on absolute grounds in reference to Croatian language as well, and, furthermore, any prior right, thus including Croatia as well, will pose an obstacle to registration of the CTM. Therefore, the CTM Applicants will have to make sure that none of the above exists in Croatia.

PROHIBITION OF USE OF A COMMUNITY TRADE MARK

If the use of a Community trade mark conflicts with the use of a national trademark acquired before the day of the acceptance of the Republic of Croatia into the full membership of the European Union, or acquired on a national application, filed before the day of the acceptance of the Republic of Croatia into the full membership of the European Union, the holder of such national trademark may institute a legal action, claiming prohibition of the use in the Republic of Croatia of the Community trade mark. The plaintiff shall prove that the Community trade mark conflicts with his/her national trademark. The prior national right must be acquired (applied for and/or registered) in good faith for it to be a valid ground for this particular action.

PROTECTION OF A COMMUNITY TRADE MARK AGAINST INFRINGEMENT

The provisions on the protection a national trademark in the case of infringement shall apply *mutatis mutandis* to the protection of a Community trade mark in the case of infringement.

Therefore, all the usual remedies available, filing actions before the 4 Commercial Courts in the Republic of Croatia.

THE COURT COMPETENT FOR A COMMUNITY TRADE MARK

In the Republic of Croatia, the Commercial Court in Zagreb shall be the Community Trade Mark Court competent for the first instance decisions, within the meaning of the Regulation on the Community trade mark, while the High Commercial Court shall be the Community competent for the second instance decisions.

Useful information:

STATE INTELLECTUAL PROPERTY OFFICE (SIPO, at www.dziv.hr/en/)

« SIPO has been integrated in the Common Harmonized Database by which its practice as the national trademark office of the Republic of Croatia has been harmonized with the practice of the OHIM and other offices participating in the project as regards the classification of goods and services for the purposes of the registration of marks. Furthermore, the Croatian version of the Common Harmonized Database on Classification of Goods and Services is now accessible to the users through the Euroclass application. » (more at <http://www.dziv.hr/en/news/harmonization-of-classification-of-goods-and-services,171.html>)

TMVIEW (www.tmview.europe.eu)

« On 1 July 2013, the State Intellectual Property Office (SIPO) joined the *TMview* system, as a tool and a database for searching trademarks registered with the trademark offices of the European Union and other offices participating in the system. Thus, from 1 July, the possibility of searching trademarks registered with SIPO will also be available. By the inclusion of SIPO, as the Croatian national office for trademarks, in the *TMview* system together with other three offices, the total number of national offices from the European Union participating in this project will rise to 25, and the total number of offices participating in the project will rise to 29. » (more at <http://www.dziv.hr/en/news/the-office-in-the-tmview-system---croatian-trademarks-in-the-common-database-of-trademarks-of-the-european-union-and-other-countries,181.html>)

For more information, please contact:



Katarina Kompari, LL.M.
Patent and Trademark Attorney
Živko Mijatović & Partners (ZMP)
www.zm-p.com

Katarina joined Živko Mijatović & Partners (ZMP) in 2010.

Born in Koprivnica in 1978. In 2002 graduated from the Faculty of Law, University of Zagreb, same year awarded a scholarship of the British Government (the Chevening Scholarship) for a postgraduate studies in London, at the University College London, and was awarded the LL.M. (Master of Laws) in 2003. Experience gained in various fields, from working for the Government of the Republic of Croatia, to Permanent Court of Arbitration, and working for Bird&Bird in London.

2004 – 2010 was Head of the Intellectual Property Department at Podravka d.d., Koprivnica, Croatia, www.podravka.hr.

Member of the Croatian Licensing Executives Society, and EU Accession Working Group on Chapter 24 (Justice, Freedom and Security). In 2006 was appointed as a working member of the Business Counseling Committee on the project HITROREZ (an instrument to optimise thousands of regulations at the state level, as to make ground changes needed for better performance of economic environment and future economic development).

Speaker on IP issues at several conferences, last in 2013.