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## Trademark Directive

### CZECH REPUBLIC IMPLEMENTS EU TRADEMARK DIRECTIVE – WHAT DOES THIS MEAN FOR MY BUSINESS?

The Czech Republic has implemented EU Trademark Directive No. 2015/2436 by way of amending the Czech Trademark Act No. 441/2003, effective as of 1 January 2019. The most important changes can be summarized as follows:

- 1) Trademarks do not need to be capable of graphic representation in the trademark register.
- 2) The Czech Industrial Property Office no longer *ex officio* refuses to register a later application for an identical trademark covering identical goods/services, or a trademark constituting part of an earlier trademark if such may lead to confusion with the earlier one.
- 3) It is no longer possible to register a trademark for goods/services as a Nice class heading or any other general term if it lacks clarity and precision.
- 4) An applicant may require proof of use of an opposing trademark in the course of opposition proceedings; the same applies for a defendant in infringement proceedings.
- 5) Additional rights for trademark owners shall raise protection against counterfeiting and prevent relevant imported goods from being released for free circulation in the Czech Republic.
- 6) Any entitled person may apply for a certification trademark which guarantees a certain characteristic of goods or services (e.g. quality or production process).

The most important change for a trademark application is no requirement for a graphic representation in the trademark register. However, a trademark must still be represented in the register in a manner which allows both public authorities and the general public to clearly recognise what is protected by the trademark. This move forward means, among others, that sound marks, movement trademarks and multimedia trademarks (combination of sound and video) may be registered. The limitation is basically just the technology. Once there is a device enabling an electronic transfer of smell, smell marks are much more likely to be registered than under current regulations. As a result,

overcoming the requirement of graphic representation may prove to be less burdensome for successful registration of smell marks.

The change of law is driven by a general principle of responsibility for exercising your own rights. Therefore, the Czech Industrial Property Office will no longer refuse to register a trademark which is identical to an earlier trademark registered for identical goods/services and it is up to the owner of the earlier trademark to lodge an opposition within a three-month period in such a case. If the owners of earlier trademarks do not track new trademark applications on a regular basis, it does not mean that they cannot protect their earlier trademark rights once the opposition period lapses. They may still initiate invalidity proceeding or file a motion for infringement of their trademark rights.

Another change to note concerns goods/services your trademark may be registered for. This is important as, in general, you have to use a trademark within five years in relation to the goods/services for which it is registered, otherwise you may lose your rights. The Czech Industrial Property Office will no longer allow the registration of a trademark for a Nice class heading or general term which lacks clarity and precision. Even if a Nice class heading or general term is found to be sufficiently clear and precise, the extent of protection shall be restricted to its literal meaning. The choice of goods/services to be protected is a key point that should not be underestimated.

As already stated above, each trademark owner has to use its trademarks in relation to the goods/services for which the trademark is registered. If an opposition or invalidity proceeding is based on a trademark registered for over five years, the applicant or defendant may require the other party to prove that the earlier trademark has been used. However, the period for such a demand is limited to two months, and once it lapses, the defence concerning non-use is lost.

Trademark owners have further rights to ensure better protection against counterfeiting and to prevent goods unlawfully bearing the same trademark from being released for free circulation in the Czech Republic. With regard to more anti-counterfeiting measures available, a trademark owner is entitled to prevent attachment of packaging, label or any device bearing a trademark to goods in the course of trade where such attachment would amount to trademark infringement. Such right may be triggered in a situation in which just a risk of trademark infringement exists. The second case concerns the right to prevent the import of goods which resemble an earlier trademark in its fundamental features before such goods are released for free circulation in the Czech Republic.

Last but not least, a special type of collective trademark may now be registered. The so-called 'certification trademark' distinguishes goods/services which are certified for a certain characteristic (e.g. material, production process, quality or accuracy). Only persons qualified for the certification of the goods/services concerned may file such an application and only if the person does not operate a business including the goods/services for which the certification is sought.

Any further questions to the new developments of the Czech trademark law? We would be pleased to provide you with tailored advice on trademark matters both on the Czech and European level.

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