

## **OPPOSITION PROCEDURE**

### **LAW ON INDUSTRIAL PROPERTY of the Republic of Macedonia**

#### **BASIC FACTS**

- I. There is no ex officio examination on relative grounds (i.e. identity or similarity to earlier rights) for refusal of the registration of a trademark's application.
- II. Pre-registration opposition procedure is based on the articles 142,143 and 144 of the Law on industrial property and on the articles 16 and 17 of the Book of Regulation on Trademark.
- III. The administrative procedure of second instance is provided in article 14 of the Law on industrial property where *"The applicant shall have the right to appeal to a first instance decision issued by the Office, to a Commission of the Government of the Republic of Macedonia"*. The decision of the Commission of the Government is final. According to the Law on General Administrative procedures in the country, a claimant may sue against this decision in front of the Supreme Court.

#### **OPPOSITION PROCEDURE**

- I. Time limit for filing an opposition:

-90 days after the publication of an application of a trademark in the official gazette of the SOIP (Industrial Property Gazette)

-There is no possibility for extension of the time limit for filing opposition

- II. Who can file an opposition:

1. the applicant of an earlier filed trademark application and owner of earlier registered trademark under Article 127 paragraphs (1) to (4) of this Law;
2. the owner of the trademark registered in a country member of the Paris Union or WTO, for which the representative in the Republic of Macedonia filed an application without the owner's consent;
3. the natural person whose name and surname or appearance are identical with or similar to the published sign;
4. the owner of an earlier protected industrial property right, if the subject matter of that right is identical with or similar to the published sign;
5. any person having copyright on the work, which is identical with or similar to the published sign.
6. the owner of a trademark that has expired due to the expiration of the term of protection, in the context of article 127, paragraph (6) from this law

7. the owner of the earlier application of the trademark or registered trademark, which is in the Republic of Macedonia well-known mark within the meaning of Article 6<sup>bis</sup> of the Paris Convention or Article 16(3) of the TRIPS Agreement, Macedonian Law, article 127, paragraph (3) 3.

### III. Bases for refusal:

Relative grounds for refusal are specified in Art. 127 of the Law on industrial property (see below).

Together with the opposition the opponent has to submit reasons of submitting the opposition and evidence for those reasons;

### IV. Procedure before the SOIP

1. examination on formalities: date of filing an opposition and whether the opposition is filed by a person entitled to file an opposition and If the requirements are not complied with, the Office shall issue a conclusion for rejection of the opposition.

2. notifying the trademark applicant about the grounds specified in the opposition (together with evidences), giving him the opportunity for submitting the arguments in favor of the registration of the applied trademark within prescribed period not longer than 60 days.

3. examination on substance on bases of grounds for opposition, evidences and counter-arguments; making decision on opposition; if the opposition is justified: refusal of registration of applied trademark for all (total) or some (partial) goods or services; if the opposition is not justified: refusal of opposition.

4. If the applicant does not make a declaration on the grounds specified in the opposition within the prescribed time limit, the Office shall decide within the boundaries of the grounds specified in the opposition.

5. the decisions of the SOIP can be appealed at Commission of the Government of the Republic of Macedonia. The decision of the Commission of the Government is final and according to the Law on General Administrative procedures in the country the claimant may sue against this decision at the Supreme Court.

## THE PROS AND CONS OF A PRE REGISTRATION OPPOSITION PROCEDURE

### 1. PROS:

- a simple and cheap way to prevent the registration of an “inappropriate” trademark

### 2. CONS:

- in case of opposition the whole registration procedure prolongs substantially;
- insufficient awareness of the applicants for the necessity of following the published applications for trademarks.

**Law on Industrial Property of the Republic of Macedonia  
(Opposition Procedure - relevant articles):**

**Relative grounds for refusal**

Article 127

- (1) Trademark may not protect a sign:
1. which is identical with an earlier trademark filed or registered by another person designating the identical kind of goods or services;
  2. which is identical with or similar to an earlier trademark, filed or registered by another person designating the same or similar kind of goods or services which would mislead the average consumer, including the possibility of association to earlier filed for or registered trademark.
- (2) Trademark, earlier filed for protection shall be a reason for refusal within the meaning of paragraph (1) of this Article only if it was registered.
- (3) The term "earlier filed or registered trademark" shall comprise:
1. trademark enjoying priority right under the provisions of this Law;
  2. earlier internationally registered trademark with effect in the Republic of Macedonia;
  3. trademarks which at the time of filing the trademark application for the sign referred to in paragraph (1) of this Article are well-known in the Republic of Macedonia within the meaning of Article 6-bis of the Paris Convention or Article 16(3) from the TRIPs Agreement.
- (4) Well-known trademark referred to in paragraph (3) item 3 of this Article shall be in particular trademark known to the relevant sector of the public and trademark which is well-known as a result of representation, publication and advertising in the public.
- (5) A trademark shall not protect a sign which infringes earlier acquired rights of:
1. The owner of a trademark registered in a country member of the Paris union or WTO, for which the representative in the Republic of Macedonia filed an application without the owners' consent;
  2. a natural person whose name and surname or appearance are identical with or similar to the published sign;
  3. the owner of an earlier industrial property right, if the subject matter of such right is identical with or similar to the published sign;
  4. the person having copyright on the work which is identical with or similar to the published sign.
- (6) A trademark shall not protect a sign which is identical with or similar to a trademark the validity of which has expired on the ground of expiring of term of protection and if the right-holder failed to file a request for renewal of validity and pay the prescribed fees in the prescribed time limit, when a trademark application was filed before the expiration of the period of nine months, counting from the expiration date of the trademark validity, unless the protection of such a sign is required by the owner in whose name the trademark has been protected, or by his successor in title.
- (7) Grounds for exclusion from trademark protection under this Article may be invoked only by the applicant of the earlier application or the owner of the earlier right.

## **Opposition**

### **Article 142**

(1) Opposition to a published trademark application may, within 90 days from the publication date, be filed with the Office by:

1. applicant of an earlier filed trademark application and owner of earlier registered trademark under Article 127 paragraphs (1) to (4) of this Law;
2. the owner of the trademark registered in a country member of the Paris Union or WTO, for which the representative in the Republic of Macedonia filed an application without the owner's consent;
3. natural person whose name and surname or appearance are identical with or similar to the published sign;
4. owner of an earlier protected industrial property right, if the subject matter of that right is identical with or similar to the published sign;
8. any person having copyright on the work which is identical with or similar to the published sign.
9. The owner of a trademark that has expired due to the expiration of the term of protection, in the context of article 127, paragraph (6) from this law.

(2) The time limit for filing opposition referred to in paragraph (1) of this Article shall not be extended.

(3) A separate opposition shall be submitted for each published Trademark Application.

(4) The contents of the opposition, as well as the manner of submission shall be prescribed by the regulation issued by the Director of the Office.

### **Examination of opposition**

#### **Article 143**

(1) The Office shall examine whether the opposition is filed by a person entitled to file an opposition within the meaning of Article 142 paragraph (1) of this Law and whether the opposition is filed in the prescribed time limit.

(2) If the requirements referred to in paragraph (1) of this Article are not complied with, the Office shall issue a conclusion for rejection of the opposition.

(3) If the requirements referred to in paragraph (1) of this Article are complied with, the Office shall notify the trademark applicant about the grounds specified in the opposition and invite him to make a declaration thereon within prescribed period that cannot be longer than 60 days.

(4) If the applicant does not make a declaration on the grounds specified in the opposition within the time limit referred to in paragraph (3) of this Article, the Office shall decide within the boundaries of the grounds specified in the opposition.

### **Deciding on opposition**

#### **Article 144**

(1) If the applicant makes a declaration on the grounds specified in the opposition, the Office shall examine the justification of the opposition within the boundaries of the specified grounds, taking into consideration the declaration thereon.

(2) If the Office establishes that the opposition is unjustified, it shall be refused with decision.

(3) The decision under paragraph (2) of this Article shall be sent to the applicant and to the person who filed the opposition.

(4) If, in the examination procedure on the opposition, the Office establishes that the opposition is justified, it shall refuse the trademark application and submit a written decision to that effect to the applicant and to the person who filed the opposition.

**Book of Regulation on Trademark  
(Opposition Procedure - relevant articles):**

**Contents of the opposition**

**Article 16**

(1) *The opposition against the published application shall include:*

1. *data on the submitter of the opposition: name and address of the physical entity, i.e. firm and registered seat of the legal entity;*
2. *data on the representative, in case the opposition is submitted through a representative: name and address of the physical entity, i.e. firm and registered seat of the legal entity;*
3. *data on the submitter of the published application: name and address of the physical entity, i.e. firm and registered seat of the legal entity;*
4. *TM-number and date of the publication;*
5. *number of classes according to the International Classification, i.e. a list or a part of the list of products and services, related to the submission of the opposition;*
6. *reasons for submitting the opposition and evidence for those reasons;*
7. *evidence of the payment of the fee for the opposition.*

**Conditions for submitting an opposition**

**Article 17**

- (1) *The submitter of the opposition must explain the reasons for submitting the opposition, by delivering a relevant documentation to the Bureau.*
- (2) *In case the opposition is submitted due to the identicality or similarity of the sign from the published application with previously registered trade mark, i.e. well known trade mark, the submitter of the opposition must prove that his/her trade mark is protected, i.e. that is made known on the territory of the Republic of Macedonia, prior to the priority right of the published application.*
- (3) *If the opposition is submitted due to breach of the right to the trade mark by the representative, i.e. the representative of the right holder, the submitter of the opposition must prove that his/her trade mark is protected in some Member-State of the Paris Union or the World Trade Organization, and that his/her representative, i.e. proxy is authorized merely for representation, i.e. presentation.*
- (4) *In case the opposition is submitted due to sameness or similarity of the sign from the published application with name and surname or an image of the physical entity, the submitter of the opposition must prove, by presenting relevant documentation, that those rights existed prior to the priority right of the published application.*
- (5) *In case the opposition is submitted due to breach of other rights to industrial property, the submitter of the opposition must submit evidence for the protected right, related to the breach, as well as proof, from which the breach of some former right to industrial property with the recognition of the sign from the published application is evident.*
- (6) *In case the opposition is submitted due to a breach of copyright, the submitter of the opposition must prove to be the author, i.e. copyright holder and to state the authorship, subject to the breach, as well as to enclose the evidence from which the*

*breach of the authorship with the recognition of the sign from the published application is evident.*