

Comments by the Industrial Property Office of the Czech Republic

Grounds for Refusal of all Types of Marks

The following paper should be read in connection with the previous observation submitted by the Czech IPO.

Further, there are mentioned only those grounds not presented in the last submission and those discussed during the last SCT meeting.

As a preliminary remark, the Czech Republic states that examining the grounds for refusal, there is always assessed whether the mark applied for can serve as a trade mark, i.e. whether it complies with the definition on of a trade mark and its function.

descriptiveness & genericness

These above mentioned grounds for refusal are applied by the Czech Industrial Property Office as a part of “lack of distinctive character”. Particularly descriptiveness is a ground often invoked by the office within the examination part (the majority of refused trade marks are marks describing the typed of goods or services; examples can be found in the oficial database by indicating the respective box: <http://isdv.upv.cz/portal/pls/portal/portlets.oza.formular?lok=en>).

As expressed by the honourable delegation of UK, also the Czech Republic perceives these insufficiencies and the registrability of a trademark separately.

functionality

The functionality of a trade mark is not expressly stated in our legislation. The Czech Republic perceives this feature in terms of the definition of a trade mark, i.e. its function. Hence, there are no special cases devoted to this topic.

specially protected emblems and symbols

The protection of emblems and symbols which implies from international treaties and other legal provisions is covered by the provision of trade mark act (“a sign the use of which is contrary to provisions of other laws or which is contrary to the obligations of the Czech Republic ensuing from international treaties shall not be registered”), e.g. olympic symbols.

prior rights

Within the ex officio examination there are also prior rights assessed, i.e. trade marks applied for can be registered unless there are identical earlier marks or elements comprised both in trademark applications and prior marks provided that these elements could cause confusion and the goods and/or services comprised in the list of goods and services of the mark applied for and the prior mark are identical.

However, prior rights are primarily examined after publication of a contested trade mark application during opposition and invalidity proceedings. To form part of

examination procedure on relative grounds, they must be invoked by respective third parties. These prior rights are laid down taxatively in section 7, Act No 441/2003 Coll., on Trademarks (<http://www.upv.cz/en/legislation/national/codes.html>).