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HANDBOOK ON TRADEMARKS



IPRproject
Intellectual Property Rights Project

A project implemented by:



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Objective of this Handbook:

The overall objective of this Handbook is to raise awareness of right holders and population at large about the importance of trademarks for the development and growth of their business.

Part I

Key Concepts

What is a trademark?

In very simple terms, trademarks are the names or symbols that you give to your products and/services.

In reality, the official definition of trademarks can be found in art 5 of Kosovo Trade-mark Law (No. 04/L-026) and it is a bit more complex than that. Trademarks are in fact defined as “sign which could be represented graphically, particularly words, including personal names, designs, letters, numbers, the shape of goods or their packaging, colors as well as combinations of all above under a condition that goods or services of one enterprise can be distinguished from the other enterprises”.

Anyway, the substance does not change: trademarks are the name that you use and protect to distinguish your products and services from those of your competitors. They are also the name by which consumers refer to your products and services.

In this context, individuals and companies may own several trademarks: every time they come up with a new product or a new service, a name is created to distinguish it. Such name is a potential trademark which, therefore, should comply with all legal requirements in order to be registrable.

Examples of trademarks

There are different types of marks. Often marks consist of words, and they are known as “word marks”. E.g.:

- Please add 1-2 memorable local examples
- SAMSUNG®
- MERCEDES®
- COCA-COLA®
- ROLES®

However, frequently trademarks consist of logos, or symbols. By way of example:



Other times, trademarks contain both words and logos. These are known as “complex marks”. E.g.:



Sometimes also particular shapes may be protected as trademarks. These are the so-called “3-D marks”. E.g.:



Why are trademarks useful?

As mentioned, the main function of trademarks is to distinguish the products and/or services of one undertaking (physical person or a company) from those of other undertakings. In addition, trademarks also help consumers identify the source of the products and/or services.

In short, trademarks enable customers to select the products or services that they wish to buy.

The main advantage of trademarks is that, once registered, they provide exclusive rights to their owners. In practice, this means that:

- The names of your products/services will be protected from other competitors in the market;
- They will remain yours and nobody can copy them;
- If they do, you will be able to enforce your trademark rights by bringing them to court and obtain compensation;
- On the other hand, if anybody wishes to use your trademark, they will have to obtain your prior authorization (and of course you will be able to charge for it).

However, it should be recalled that trademark rights are territorial in nature. The principle of territoriality implies that in each country, your mark will be protected by the national law and treated, for all intents and purposes, as national right (in other words, no discriminations are possible only because you are a foreigner).

On the other hand, the principle of territoriality means that, if you plan to export to a new country, make sure to protect your trademark beforehand and comply with all requirements provided by the law of the country concerned. In other words, trademarks registered in Kosovo, will not enjoy protection in other countries, unless duly registered there.

Duration of trademark rights

As stipulated in Art. 40.1 of the Kosovar TM law, registered trademarks are protected for a period of 10 years from the filing date. At the end of this 10-year period, they may be renewed for additional periods of 10 years (potentially forever).

Part II

Legal Requirements

In order to be protected in Kosovo, proposed marks must be registered with the Industrial Property Agency of Kosovo (IPA). Marks will be registrable only if they comply with the legal requirements described below.

Absolute Requirements for the Validity of a Mark in Kosovo

A mark must comply with a series of legal requirements provided by the Kosovar TM law (and in particular by Art. 6). The good news is that these requirements are rather harmonized around the world (though they may be interpreted in a slightly different manner in the various countries). These legal requirements include:

- **Distinctive Character**

As stated in Art. 6.1.2 of the Kosovar TM Act, in order to be valid, a trademark should be capable of distinguishing the goods and/or services of a person/company from those of other persons/companies.

The concept of distinctiveness is easier to understand through practical examples: in this context is important to remember the difference between “distinctive marks” (which are valid, strong marks) and “descriptive marks” (which are non-valid or at least weak marks). Marks are considered distinctive or descriptive depending on the specific goods/services for protection is sought.

Example 1:

The mark APPLE® would be descriptive if it was used to sell apple juice (i.e. descriptive of the products sold under the mark) and thus not registrable. Instead, if adopted for products other than apples and fruits (e.g. computers or telephones), the mark is distinctive, and therefore valid and registrable.

Is this mark distinctive



YES for computer



NO for juices

Camel



Example 2:

similar considerations may apply to the mark CAMEL® which would be considered descriptive and thus not registrable for camel-related products (e.g. camel milk), while when protected for cigarettes, the mark is clearly distinctive and registrable.

On the other hand, trademarks that have no meaning, like KODAK®, cannot be descriptive.

That there are techniques that may make a partly descriptive mark more distinctive. These include:

- adding a non-descriptive logo (i.e.: an image that does not describe the goods/services covered by the mark)
- filing the mark in a special color (and avoid filing it in black and white)
- filing the mark in a special script (and not in standard capital letters)



For instance:

the trademark ECONOPHONE would probably be too descriptive for telephone services, but with the addition of the non-descriptive logo, the special script and color, the mark may become sufficiently distinctive and therefore registrable.

- **Not Exclusively Descriptive**

As already mentioned above, and as expressly stated in Art. 6.1.3 of the Kosovar TM Law, a proposed mark should not be exclusively descriptive of the type, quality, quantity, intention, value, geographical origin, time of production of goods or conducting services or showing other features of goods and services for which it is intended to be registered and used. This means that that marks may be partly descriptive or allusive. However, they cannot be exclusively descriptive. In other words, it is a question of degrees.

In simpler terms, when choosing a new name for a product or services, users should therefore be careful about utilizing certain terms in their proposed marks, such as:

- Certain nouns relating to their products or services (e.g. “bank” in the banking sector, “bread” in the bakery sector, “cosmetic” in the cosmetic sector, “mobile” in the telecom sector, etc.);
- Adjectives (e.g.: good, economic, fast, cheap, etc.);
- Laudatory expressions (e.g.: the best, better, number one, super, etc.);

However, not all these terms would automatically render your mark unlawful. If coupled with other highly distinctive terms or logos, the proposed mark may become registrable.

- **Not Generic**

Trademarks cannot consist in the ordinary term used by the relevant consumers to indicate a particular product. For example, the term “Shoes” could not be monopolized as a trademark by a producer of shoes. Under Art. 31.2 of the Kosovar TM Law, generic terms should be disclaimed in trademark application.

- **Not Deceptive**

As stated in Art. 6.1.7 of the Kosovar TM law, marks should not deceive or mislead consumers and customers. This in practice means that they cannot carry a message that is not true.

By way of example, the mark “Milan” for shoes produced in Prishtina would be misleading as to the origin of the products covered by the mark. Similarly, the mark “30% Guaranteed Return” for a new banking product that, in reality, cannot guarantee such return on investment, would be deceptive for the public.

- **Not Contrary to Public Order and Morality**

As stated in Art. 6.1.6 of the Kosovar TM Law, trademarks cannot be contrary to public order and morality. In other words, marks should not offend the sensitivity of people, their values, their morality, etc. Users should try to avoid them.

By way of example, the following terms should be avoided:

- The names of drugs, e.g.: COCAINE
- The names of weapons, e.g.: KALASHNICOV
- Names linked to terrorism, e.g.: ISIS, MAFIA
- Names or images that are sexually explicit or simply too provocative (... no examples needed)
- Names or symbols linked to religion

- **NOT consisting of shapes described below**

As indicated in Art. 6.1.5 of the Kosovar TM Law, trademarks cannot exclusively consist of shapes that:

- Depend on the nature of the goods; or
- Are necessary to obtain a technical result; or
- Give substantial value to the product.

- **NOT Identical to a National Flag and other State Emblems**

As stated in Art. 6.1.8 and 10 of the Kosovar TM Law, nobody can use as a trademark (i.e. for commercial purposes), symbols, emblems and state blazons as provided by Article 6 of the Paris Convention or which are of general interest of Kosovo. By way of example, the flag of a country, its emblems, etc. cannot be monopolized as trademark. Only the relevant institutions of the State can decide who is entitled to use such symbols and in what context. Users should try to avoid them.

- **NOT consisting or containing of a Geographical Indication**

As indicated in Art. 6.1.11 and 12 of the Kosovar TM Law, trademarks cannot contain or consist of a geographical indication which identifies wines or alcohol beverages, or a denomination of origin or a geographical indication with effect in the territory of Kosovo.

Relative Requirements for the Validity of a Mark in Kosovo

As provided by Art. 7 of the Kosovar TM Law, a proposed mark should not be in conflict with prior rights. In other words, a mark should not hinder the exclusive rights of owners of prior marks (or other IP rights). This is the so-called “relative grounds” for the refusal of a mark (as opposed to the legal requirements that are referred to as “absolute requirements” and covered in the previous section).

In order to find out if a proposed mark you plan to adopt is available, or, instead, it conflicts with earlier rights, an availability search have to conducted (also known as “trade-mark search”) in one of the following databases:

- <http://213.163.122.85/wopublish-search/public/home?1&lang=en> to verify if the mark is registrable in Kosovo.
- WIPO Global Brand Database and TMView (tmdn.org) to check if the proposed mark is registrable in other countries.

It should be noted that a mark may be considered as new/available in Kosovo if:

- There are no prior identical or similar signs registered or applied for in Kosovo,
- For identical or similar goods and/or services.

By way of example, if the mark MAURO for shoes is registered in Kosovo, nobody else would be entitled to adopt as a mark:

- MAURO for shoes, as the signs are identical and the products are identical.
- MAURO for sandals or socks, as the signs are still identical and the products are clearly similar.
- MAURA, MAURETTO, etc. for shoes, sandals or socks, as the signs are similar and the products are identical or similar.

The situation is relatively straightforward when the signs are “identical”. However, when signs are “similar”, the situation becomes more complex as the similarity has to be demonstrated, based on one of the following criteria:

- **VISUAL** similarity: when the two marks look similar, because of a number of visual elements, such as colours, shapes, letters, etc.;
- **PHONETIC** similarity: when the two marks sound similar when pronounced;
- **CONCEPTUAL** similarity: when the meaning of the two marks is the same or similar (e.g. the English word “shoes” and “këpucë”, which is the equivalent term in Albanian).

However, the similarity between a proposed sign with a prior mark is not sufficient to determine its unlawfulness. This will be the case only if the goods and/or services of the two marks in question are identical or similar. By way of example: trademark MAURO for garments cannot prevent the registration of trademark MAURO (or MAURA) for travel agencies, airplanes, construction services, etc.

Products / services are considered similar if they have the same or similar purpose, public (consumers), channels of distribution, or if the products/services are inherently linked, complementary or replaceable.

Last but not least, as provided by Art 7.3 and 3 of the Kosovar TM Law, proposed marks should be quite different from well-known marks. Such marks in fact, if registered in

Kosovo, enjoy protection not only for identical or similar goods and services, but also for dissimilar ones. In addition, if a well-known mark is not registered in Kosovo, it would automatically enjoy protection for identical and similar goods and services.

Best practices to use trademarks

There are a number of best practices that users should bear in mind in terms of usage of trademarks. These include:

1. Use your registered mark, otherwise you risk losing it. Art. 14.4 of the Kosovar TM law stipulates that trademark owners have five years from the registration date to start using their mark, failing which the mark may be cancelled from the registry.
2. Systematically use the symbols “TM” or ® on all its registered marks. This is a good warning message to potential infringers.
3. The level of distinctiveness of a mark may change with the time. Extensive use over the years may increase its distinctiveness, through the so-called “secondary meaning”. This means that, for example, a rather descriptive mark may, with the time and usage, become stronger and more distinctive. This phenomenon can be very advantageous for trademark owners.
4. On the other hand, distinctiveness of a mark may also decrease over the years and disappear. This is the so-called “vulgarization” which occurs when the average consumer uses a certain trademark not only to refer to its specific products/services, but as a general term to indicate any product/service of the same category. Users should avoid vulgarization at all costs, by remembering that:
 - i. A mark should always be used as a mark and not as a verb, noun, or as an adjective (eg: “to Google®”; “to Xerox®”)
 - ii. A mark should be used consistently, without major variations as compared to the originally filed version.
5. Users should constantly ensure that nobody copies or misuses their marks. This requires monitoring the market to identify and pursue possible infringements.

Part III

Getting Protected

As mentioned in Part I, Sect. 3 of this Handbook, users should protect their marks in all the countries where they do or intend to do business. This is because Intellectual Property rights, including trademarks, are territorial in nature (on the basis of the famous principle of TERRITORIALITY). This means that entering a new country without having duly filed their mark can be potentially be very dangerous: marks may be copied, and their legitimate owners may not be able to do much to protect their rights.

Protecting trademarks in Kosovo

In order to obtain protection for a trademark in Kosovo, an application must be filed with the national IP office, named Kosovo Industrial Property Agency (KIPA). Please visit the following website to obtain information about the form to use, the fees to pay and the procedure to follow: KIPA (rks-gov.net).

In order to file a mark in Kosovo, a standard application form (provided in the above website) must be used, accompanied by a representation of the mark (8 cm by 8 cm), the payment of the relevant filing fees and the indication of the goods or services for which the mark will be used, classified in accordance with the Nice Classification of goods and services, consisting in total of 45 classes: 34 for products and 9 for services. One application may cover several classes of goods or services.

The filing procedure is governed by Administrative Instruction on trademark registration. It is a simple mechanism, and it is not expensive. In case of doubts, applicants are advised to contact KIPA for information and guidance on how to file a mark in Kosovo.

Protecting trademarks abroad

If a trademark holder from Kosovo or a local businessman wishes to protect a mark in a number of countries, the only available solution at the moment, is to file individual trademark applications in all countries of interest. This implies filing different applications, in all relevant languages with the domestic IP offices, complying with the domestic normative frameworks and, unfortunately, recruiting a local lawyer or trademark agent in each country to file the mark on their behalf. This is because the various national IP offices only accept to liaise with local people and representatives.

The approach is a bit cumbersome and, at times, it can be expensive. However, it is the only solution to avoid running the risk of having competitors copying your mark.

On the other hand, there are two other solutions that may prove useful and cheaper. However, there are some limitations in their use.

A. The Madrid system for the international registration of marks.

The Madrid system is a simple, cheaper, effective centralized procedure, a one-stop shop for trademark owners to obtain and maintain trademark protection in numerous export markets. The Madrid system allows trademark holders to obtain protection by filing one single application, in one language (including English), with fees in one currency (Swiss francs) in up to 124 countries, without having to appoint a local IP agent in all countries.

Unfortunately, Madrid system is a “close” system: it can be used only by people and companies that:

1. Are nationals of one of the countries of the Madrid Union; or
2. Have residency in one of those countries; or
3. Possess a real and effective commercial or industrial establishment in one of the countries members to the Madrid Union.

This means that, unfortunately, so far the Madrid system can only be used by Kosovar people and enterprises that comply with one of the above requirements.

The procedure to file an international application is rather simple. More information may be found at:

http://www.wipo.int/treaties/en/registration/madrid_protocol/

- E-mail: intreg.mail@wipo.int
- Tel: +41 22 338 86 86

Finally, it is also important to remember that the Madrid system is merely a procedural treaty, and the IP offices of the designated countries are in charge of verifying compliance with the domestic substantive requirements.

B. The Regional EU Trademark system

Through this regional route, you will be able to protect your mark in the 27 countries of the European Union, at once, with one single filing. The EU trademark system is administered by the European Union IP Office (EUIPO), in Alicante.

The good news is that basically anybody (natural or legal person) can file marks through such system. However, a Kosovar citizen or company will have to appoint a representative in the EU to file the application.

The procedure is very fast and simple (please see Application and Registration Procedure (europa.eu)). In particular:

- Trademark applications can be filed online at the following web address: EUIPO - Route to registration (europa.eu).
- The form is extremely simple: you have to provide all relevant information relating to the trademark owner, a sample of the mark and the goods and/or services covered by your mark classified in accordance with the “Nice Classification”.
- To classify the goods/services of your mark, you can use a very useful tool named TMC-lass available at: Classification Assistance - TMclass (tmdn.org).
- To verify if your proposed mark is available in the EU and not in conflict with prior identical or similar marks for identical or similar goods/services, please check on the following database: TM View: (available at: TMView (tmdn.org)).
- The cost of the above procedure are very moderate, and a very convenient fee calculator is available on the site.

You can also contact EUIPO at the following address:

Avenida de Europa, 4, E-03008 Alicante, Spain

Information center: tel.: +34 965 139 100

Part IV

Legislative Framework

1. Law:
 - Law on Trademarks, 04/L-026
 - Law on amending and supplementing law 04/L-026 on trademarks, 05/L-040
2. Selected secondary legislation:
 - Administrative Instruction on trademark registration, MTI-14/2016
 - Administrative Instruction for administrative fees for industrial property facilities, MTI-10/2016
 - Administrative Instruction on authorized representatives in the field of industrial property, MTI-6/2018

Part V

Commercialization and Enforcement of marks

Commercialization of Trademarks

Commercialization of trademark rights could potentially become a lucrative business initiative for trademark owner. The significant advantage of trademarks, like any other IPRs, is that they are intangible and, as such, they may be licensed-out numerous times, simultaneously, through a variety of contractual arrangements to maximize profits.

For example, a trademark owner may decide to authorize another player on the market (e.g.: another company, perhaps abroad, or a non-competing business at home) to use its mark, through a licensing agreement, in exchange for the payment of royalties.

This model could be replicated in many countries, with obvious positive consequences in terms of economic return.

However, a prerequisite for the successful exploitation and commercialisation of marks is a well drafted licensing contract. Trademark licensing is a process whereby a company, as holder of a mark, grants permission to third parties to utilize its IP asset/s for a specified duration, for a specific objective, on a particular country or region, and under agreed upon conditions. These terms are agreed upon between both the parties and are stated in the licensing agreement.

Licensing would entail significant advantages for a trademark owner:

- It will receive income in the form of licensing fees and royalties.
- It will be able to capitalize on the local knowledge, network and expertise of the various licensees, and their capacity to introduce the necessary adaptations that may facilitate penetration of their local markets, and perhaps even improve its products.

Any trademark license should ensure that the original trademark owner maintains close oversight over the way in which its marks are used, in order to ensure that its good-will and reputation are not tarnished.

Conversely, business people in Kosovo may wish to avoid the often expensive R&D process to develop new products and new trademarks, and simply enter into a licensing agreement (as licensees) with a third party that has already developed and protected such marks.

In all cases, commercialization of trademarks requires the drafting of rather complex licensing contracts that should be handled by experienced lawyers.

Infringements of Trademarks and Remedies

This section contains practical suggestions in case trademarks are copied, violated, infringed by third parties, at home or abroad, whether in good or in bad faith.

First of all, trademark owners should act as “watch dogs” and monitor possible violations of their marks. In their daily job, they are often aware of what the competitors are doing and of any infringement of IPRs.

Litigation should be kept as a last resort, as it may take long time and at time its outcome is unpredictable. A simple “cease and desist” letter maybe enough to end an infringement. Should this not lead to a resolution of the infringing activity, trademark owners may attempt to reach an out-of-court settlement, through negotiation. Should also this effort fail, they may revert to the services of a professional mediator, who could facilitate the achievement of a satisfactory agreement for both parties. Finally, in some cases, court litigation remains the only viable option to obtain justice.

A particularly suitable and tailor-made ADR system for IP is administered by WIPO. For more information, please refer to the following web site: <http://www.wipo.int/amc/en/>.

Evidently, only experienced lawyers should carry out the above steps.

In terms of remedies, the Kosovo legislative framework (art ...) provides for the following possibilities to enforce one’s trademark rights:

1. Administrative remedies (mostly referring to the services provided by KIPA, particularly in the context of the possible oppositions filed by third parties against the registration on proposed marks – see art. 34-35 of the TM law).
2. Civil remedies (mostly in the form of fines).
 - i. Injunctions (excellent measures to speed up the process and prevent continuation of the infringing activity. In some cases, injunctions could be granted by the judges without having previously informed the infringer).
 - ii. Damages (to compensate the trademark owner for the negative consequences suffered because of the infringement of its marks).
 - iii. Delivery up, search & seizure (a defendant may be ordered to deliver up the infringing materials and/or any material used to make them. An order permitting search and seizure may be granted where the plaintiff fears the defendant may abscond or destroy the evidence of the trademark infringement).
3. Criminal sanctions (in the form of penalties and imprisonment. Criminal measures are normally rare in the field of IP. They are applied only in case of large violations of trademarks committed willfully by the infringers).
4. Custom measures: whereby Customs may check suspected infringing goods crossing the border and detain them at the custom offices instead of releasing them in free circulation in the local market.

Part VI

Final tools

Getting help / contacts

Ministry of Industry, Entrepreneurship and Trade
“Arbënor e Astrit Dehari” Street, no: 21, Hospital Neighborhood, 10000 Pristina, Kosovo
Telefon: +381 38 200 36554

For a list of professionals that could help you in the field of patents, please see the following: <https://kipa.rks-gov.net/desk/inc/media/82A702F3-9598-4AF3-8C5D-38908D27604D.pdf>

Useful websites

- Kosovo IP Agency: kipa.rks-gov.net
- EUIPO: EUIPO - Home (europa.eu)
- WIPO: www.wipo.int
- WIPO SME Division: www.wipo.int/sme
- WIPO Arbitration and Mediation Center: <http://arbitrator.wipo.int>
- TMClass: <http://tmclass.tmdn.org/ec2/>
- TM View: <https://www.tmdn.org/tmview/welcome>
- WTO: <http://www.wto.org>
- Directory of IP Offices worldwide: <http://www.wipo.int/directory/en/urls.jsp>
- International Trademark Association (INTA): <http://www.inta.org>
- IP Panorama: <https://www.wipo.int/sme/en/multimedia/>

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