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HANDBOOK ON INDUSTRIAL DESIGN

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 Industrial Designs for the development and growth of their business.

Part I

Key Concepts

What is an Industrial Design?

Art. 3.1.4 of the Kosovo Law on Industrial Design (Law No 05/L-058) defines “design” as “the outer appearance of the whole or of a part of product resulting from features of, shape, form, colour, lines, contours, texture or materials of the product itself”. In simpler terms, an Industrial Design may be understood as the ornamental shape (or visual appearance) of utilitarian products.

In nowadays business environment, characterized by fierce worldwide competition, one of the key elements that might help your products stand up in the marketplace and be noticed and purchased by customers, is to invest time and resource to make them ... more beautiful. The result of these efforts to make your products more aesthetically appealing can effectively be protected by industrial designs.

The difficulty that businesspeople might encounter in making their products and their packaging more beautiful is that ... as a famous old proverb says: “beauty is in the eye of the beholder”. This means that the perception of what is beautiful (or not) changes from country to country, from culture to culture and with the time. Fashions go in trends: what is appealing today may be outdated tomorrow. The most challenging task for businesspeople is indeed to anticipate trends and understand what will be considered beautiful by a large portion of the relevant public in the home market and abroad in the coming years. This requires investment to foresee the tastes of current and future customers, abundant creativity and ... the support of experts with specific expertise in this area.

Examples of bi-dimensional industrial designs:



Like all other IP rights, also Industrial Designs are governed by the “principle of territoriality”. This means that they enjoy protection in a given country only if they are duly filed and registered there. Should this not be the case, the shape or form will be considered in the public domain, and as such, it could be adopted or copied by anybody.

Innovative and creative individuals and companies may own several Industrial Designs, on the various forms that they have created. The great news is that each deposit of Industrial Design may cover up to 100 designs or models, provided that they all fall in the same class of the Locarno Classification.

In order to file and protect an Industrial Design is advisable to rely on the help of an expert (an IP expert or agent). This handbook is not aimed at transforming you into an IP agent or attorney, but simply at providing you with sufficient knowledge to take the necessary steps to decide if, when and how to protect your creative shapes and forms, and to avoid major problems (such as, using somebody’s protected Industrial Design without authorization).

It is important to remember that, as mentioned above, industrial design protects only the ornamental appearance of a product and not:

- its name: this should be separately protected as a trademark (see Handbook on Trademarks).
- its technical features: which would have to be protected, if anything, through patents (see Handbook on Patents).

Why are Industrial Designs useful for your business?

The most important advantage of an Industrial Design is, evidently, its capacity to catch consumers' eyes and gain their heart, making your products standing out among the many available on the market and belonging to your competitors. Industrial Design is therefore another key tool of any branding strategy, by enhancing the commercial value of your products and promoting their commercialization. In this case, the distinguishing factor of your products is their ... beauty (in terms of forms, shape, colours), or that of their packaging.

Nowadays, competing only technical features and price is not enough. The visual appearance of products pays a crucial role in determining consumers' choices.

Protecting your innovative shapes, forms and designs for your products or their packaging through industrial design brings a fundamental advantage to your business: Industrial designs, if filed and protected, provide exclusive rights over that particular shape of the products. As stated in art 17 of the Industrial Design Law, this means, in practice, that:

- you will be the only one in your country (or in any country where you file your design) that will be able to use that specific shape of products.
- You will have the right to prevent third parties, not having your authorization, from manufacturing or selling goods that incorporate your protected industrial design.
- You will be able to obtain great returns on your investment to develop and protect that particular appealing shape/form, by licensing out your design against payment of royalties.



Like other IP rights, Industrial Design rights are territorial by nature. This implies that, if you plan to export to a new country your products encompassing your valuable shapes and appearances, make sure to protect your Industrial Design beforehand and comply with all requirements provided by the law of the country concerned. In other words, Industrial Designs registered in Kosovo, will not enjoy protection in other countries, unless duly registered there. This is the so-called “principle of territoriality”.

- In each country, your industrial designs 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).

Finally, exactly all other IPRs, Industrial Designs represent a formidable business asset that:

- Increases the overall value of your company;
- Allows you to use them as collateral to borrow money from a bank; and it can be used as a pledge (see art. 23);
- Increase your revenues by licensing your design to third parties in other countries.

- Conversely, if you want to use a shape, form, design or that is protected by an Industrial Design in your country, make sure that you only do it if you have the authorization of the legitimate Industrial Design owner. Otherwise, you will be in violation of its exclusive Industrial Design rights and you might be brought to court and sanctioned accordingly: careful!

INDUSTRIAL DESIGNS are very useful for you and your business: you have exclusive rights over that particular design (shape, form).

CAREFUL not to violate Industrial Designs of your competitors!



Duration of Industrial Design rights

As stipulated in Art. 48 of the Kosovar Industrial Design law, Industrial Designs are protected for a period of 5 years from the filing date. This duration can be renewed for four times, up to a maximum of 25 years in total. At the end of this 25-year period, the designs fall into public domain and they cannot be renewed.

Should the renewal fees not be paid at the end of each 5-year period, the Industrial Design will fall in the public domain at the end of the last period for which it was protected.

Part II

Validity of Industrial Designs

In order to be protected in Kosovo, an Industrial Design must be filed and registered with the Industrial Property Agency of Kosovo (IPA). Industrial Designs will be registrable only if they comply with the legal requirements provided by the Industrial Design law (and especially by art. 5 to 10) and described below.

Legal Requirements for the Validity of an Industrial Design in Kosovo

In order to be able to obtain Industrial Design protection in Kosovo, a shape, form or design must:

1. **New:** a particular shape is new if it has not been disclosed to the public, anywhere around the world, by publication, display or simply used in any other way, before the filing date. If you want to find out if a particular design is new or not, you have to carry out a novelty search. As stipulated by art. 39 of the Law, at the request of an interested party and following the payment of the required fee, IPA can carry out a novelty search among industrial designs registered in the Republic of Kosovo. In addition, the EUIPO has developed a very comprehensive database to find out if a

proposed design is new, not only in the 27 countries of the European Union, but also in many other participating countries: DSView, available at: [DSView \(tmdn.org\)](http://DSView(tmdn.org)). Novelty searches can also be carried out on the web sites of the mayor IP offices, such as those of the USA, Japan, Canada, etc. Art 6 of the Kosovo Law provides that a design is considered new if no identical design was made available to the public before the date of filing of the application. In addition, designs must be considered as identical if their features differ only in immaterial details.

2. have Individual Character: this means that the design must produce, on an informed consumer, a unique overall impression which is different from the overall impression produced by other prior designs, available to the public before the date of the submission of application. Art. 7 of the Law explains that in assessing the individual character of a design, the degree of the freedom of designer in developing the design must be taken into account.
3. Not dictated essentially by technical or functional considerations: functional or technical shapes should not be protected as industrial designs, but if anything, as patents (see art. 9).
4. Not contrary to public interest or moral principles: in other words, a design cannot offend people, values and beliefs. The design which is contrary to public interest and moral principles cannot be protected (see art 10).

If the proposed design complies with all the above requirements, it will be registered and granted a certificate. Congratulations!

However, while the above legal requirements may seem easy to understand, it is nonetheless advisable to seek advice and support from an IP expert with knowledge of industrial designs. In other words, the DIY (Do-It-Yourself) approach is NOT advisable.



Best practices relating to Industrial Designs

There are a number of best practices that users should bear in mind in the area of inventions and Industrial Designs. These include:

1. Before filing an Industrial Design, designs should not be disclosed to anybody. This is because shapes and forms already in the public domain cannot be protected under Industrial Designs, that instead require absolute and world-wide novelty.
2. However, art. 6 of the Kosovar Law provides for a 12-month grace period for the creator of the design to file his/her application with IPA from the date in which he/she has put the design on the market.
3. In addition, disclosures by third parties that took place because of abuses (such as violations of confidentiality agreements) should not be taken into consideration and therefore they will not disqualify the design from being protected as a new shape/form.
4. In any event, when entering into discussions with potential business partners, developers or potential investors the signing of Non-Disclosure Agreements (NDA) is warmly recommended.
5. If possible, design owners should use the symbols “R” or the wording “INDUSTRIAL DESIGN” on the the products encompassing their Industrial Designed. This is a good warning message to potential infringers.
6. Industrial Design owners should constantly monitor the market to ensure that nobody copies or misuses their protected designs.

Industrial Design in the Fashion Industry

The fashion sector presents two important characteristics:

1. There are very high risks that the shape of products may be copied by competitors. This reinforces the importance of protecting each and every design produced.
2. The main outputs of this sector (i.e.: fabrics, clothing, fashion collections, shoes, etc.) have an extremely short life cycle (that often last six months and in rare occasion to extend to a few years).

This means that in practice the normal registration procedure for industrial designs may be too long and potentially not be suitable for the fashion industry and its frequent new models and designs. For this reason, the TRIPS Agreement provides that the requirements for securing protection of such type of designs should not unreasonably impair the opportunity to effectively protect them. Several countries have therefore established the possibility to protect models in the fashion industry through copyright or, as in the case of the EU, through unregistered designs, with zero costs and no procedures associated. For more information on unregistered designs in the EU, please see: Part III, at the end of section 2, and the following website: Unregistered community design (europa.eu).

This type of protection is applicable also to products beyond the fashion industry.



Part III

Getting Protected

As mentioned in Part I, Sect. 1 of this Handbook, users should protect their designs in all the countries where they do or intend to do business. This is because Intellectual Property rights, including Industrial Designs, are territorial in nature (on the basis of the principle of TERRITORIALITY). This means that entering a new country without having duly filed their Industrial Designs can potentially be very dangerous: their shapes, forms and packaging may be copied, and their legitimate owners may not be able to do much to enforce their rights.



There are three potential routes to obtain protection for an Industrial Design: the national route, the regional route and the international route. You should consider protecting your design first of all at home.

Protecting Industrial Designs in Kosovo

In order to obtain protection for an Industrial Design in Kosovo, an application must be filed with the national IP office, named Kosovo Industrial Property Agency (IPA). 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 particular, a standard application form (provided in the above website) must be used. As indicated in art. 28 of the Industrial Design law, the application must contain a request for the grant of an Industrial Design, information to identify and contact the applicant, a representation of the design suitable for reproduction, etc. The relevant filing fees must be paid. The Industrial Design application must be submitted in writing, in three copies, directly at the Industrial Property Agency.

The filing procedure is governed by Administrative Instruction (MTI) NO. 12/2016 on Registration of the Industrial Design. Such legislative text contains, in art. 1 and 2, more detailed information about what the Industrial Design application should contain (e.g.: the indication of the products in which the design is intended to be incorporated or to which is intended to be applied; the specification of the designer or of the team of designers; a single description per design not exceeding 100 words explaining the representation of the design, etc.).

In addition, if the applicant is foreigner, the application has to be filed by a local representative, with a Power of Attorney.

It should be recalled that an Industrial Design application in Kosovo may claim the priority of an earlier application filed in another country. Art 32 of the Industrial Design law provides that any legal or natural person who has a duly filed Industrial Design application in one of the Member States party to the Paris Convention or to the WTO, enjoys a right of priority for a period of six months from the date of first filing, to file an application for the same design in the Republic of Kosovo. If this is the case, the date of filing in Kosovo will retroact to the date of the earlier application that is used as a basis for the priority claim.

Similar to the Nice Classification of goods and services for the purposes of trademark registration, the utilitarian products embodying industrial designs are classified in accordance with another international classification: the Locarno Classification. In the application, the applicants should indicate the relevant class/es of the Locarno Classification to which their products belong. In this context, there is a very useful online tool that will enable applicants to easily identify the relevant class/es of the Locarno Classification: the EUROLOCARNO, available at: [DesignClass \(europa.eu\)](http://DesignClass.europa.eu).

Once an application is filed with IPA, the examiners will check compliance with all formal requirements and notify the applicant should irregularities be identified. Examiners will also carry out a partial substantive examination focusing only on whether the proposed shape/form:

- can be qualified as “design” (i.e.: the appearance of the whole or part of a product), and
- can be considered as contrary to public interest or moral principles.

In other words, IPA will not check if the proposed design is new or if it possesses individual character.

The filing process is a relatively easy mechanism, and not too expensive. However, it is always advisable to contact a trained Industrial Design attorney to draft and file an Industrial Design application. In case of doubts, information and guidance on how to file an Industrial Design in Kosovo may be obtained by contacting IPA.

Protecting Industrial Designs abroad

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

The approach is a bit cumbersome and, at times, expensive. However, it is needed to avoid running the risk of having competitors copying the form of your products or your packaging.

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 Hague system for the International Registration of Industrial Designs.

The Hague system is a simple, cheaper, effective centralized procedure administered by WIPO; a one-stop shop for Industrial Design owners to file for protection in numerous export markets. The Hague system allows Industrial Design holders to obtain protection by filing one single application, in one language (including English), with fees in one currency (Swiss francs) in up to 74 countries, without having to appoint a local IP agent in all countries.

Unfortunately, the Hague 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 Hague Union; or
2. Have domicile or habitual 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 Hague Union.



Kosovo, so far, is not a member of the Hague system. This means that, unfortunately, for the time being, such system can only be used by Kosovar people and enterprises that comply with one of the above requirements (as, for example, have a domicile or a branch office in a country member to the Hague, such as Albania that is member since 2007).

Information on the Hague, as well as the forms and procedures to file an international application may be found at: Hague - The International Design System (wipo.int)

The Hague procedure works as follows:

- a.** An application may be filed either at a national IP office (see contact details below under “Contacts”), or directly with WIPO (34 Chemin des Colombettes, CH 1211 Geneva 20, Switzerland, see following site: <http://www.wipo.int/hague/en/>).
- b.** In other words, an international application does not require an earlier national filing and it is often made directly with WIPO.
- c.** The working languages of the Hague system are English, French and Spanish.
- d.** An application may cover up to a maximum of 100 designs (if they fall in the same class of the Locarno Classification).
- e.** Once WIPO receives the international application, it carries out an examination of the formalities (e.g.: the requirements relating to the photographs or graphic representations, and the required fees). This means that WIPO does not examine the substantive requirements for the validity of designs (e.g.: novelty, etc.). These issues are left to the IP offices of the designated countries.
- f.** Where the international application complies with the relevant formal requirements, it will be recorded in the International Register, and transmitted to the designated countries.
- g.** The IP offices of such countries may examine the international application for compliance with the substantive provisions of their domestic legislation. If some requirements are not complied with, they have a period of normally 12 months to refuse protection of the proposed design in their territory.
- h.** If this is the case, the applicant will have the same remedies as he/she would have if the design had been deposited directly with the national Office that issued the refusal.
- i.** The following site may be extremely useful to calculate for you all the fees relating to your application: Hague System Fee Calculator (wipo.int).

More information may be found at: Hague Services – Filing Applications & Renewing Registrations (wipo.int)

B. The EU Industrial Design system

Through this regional route, Kosovar business people will be able to protect their designs 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: Forms and Filings (europa.eu)). In particular:

- Industrial Design applications can be filed online at the above web address.
- The form is rather simple: you have to provide all relevant information relating to the design owner, visual representations of the designs, the indication of the product/s that will incorporate the design, classified in accordance with the Locarno Classification, etc.
- To classify products for industrial design registration purposes, please use the following online tool: DesignClass (europa.eu).
- To verify if your proposed shape, form or design is available in the EU and not in conflict with prior designs, please check on the following database: DSView: (available at: DSView (tmdn.org)).
- The cost of the above procedure is rather 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

The procedure at the EUIPO is as follows:

- Once EUIPO receives the application, the examiner checks compliance with formal requirements. If there is a problem or an irregularity, the examiner informs the representative of the applicant accordingly and provides a period of two months to remedy (an extension of additional two months may be requested).

- If irregularities are remedied, or if there were no irregularities, the application is examined from a substantive point of view. The substantive examination focuses only on whether the proposed shape/form is in fact a design (i.e.: the appearance of the whole or part of a product), and if it contains elements that can be considered as contrary public policy and morality. In other words, EUIPO will not check if the proposed design is new or if it possesses individual character.
- In case the examiner identifies irregularities or problems, will inform the applicant through its representative.
- Decisions of the examiner may be appealed.
- If everything goes well with the procedure, the design is registered and published in the Community Designs Bulletin.

UNREGISTERED DESIGNS IN THE EU

As mentioned above, the EU also provides for the protection of unregistered designs. This is especially useful for those products that have a short life cycle (such as, for example, the fashion industry where designs and models often last one season only).

As suggested by the name, there is no registration procedure, no formalities to comply with and zero costs. This means that business people can simply put their products (encompassing their precious design) on the market, and rely on their unregistered Community Design (UCD) rights.

However, the protection offered by unregistered Community designs is more limited in scope and duration:

- Duration: the protection only lasts three years from the date in which the design was first made available to the public within the territory of the European Union. The duration of protection cannot be renewed or extended.
- Scope: owners of unregistered designs are only protected against the bad faith copying and use in commerce of their design by a third party, if that design is an intentional copy of the unregistered design. This means that they can attack a competitor that is using their design only if they can prove that he/she knew of the existence of earlier (unregistered) design.

To sum up, the legal protection afforded by registered designs is definitely stronger, longer, more transparent, and easier to enforce.

Part IV

Legislative Framework

1. Law:

- Law on Industrial Designs, 05/L-058

2. Selected secondary legislation:

- Administrative Instruction (MTI) NO. 12/2016 on Registration of the Industrial Design
- 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 Industrial Designs

Commercialization of Industrial Designs

Having a registered Industrial Design and not exploiting it commercially would be a very bad commercial decision: it is like having a treasure and not taking advantage of it. Indeed, commercialization of Industrial Design rights could potentially become a very lucrative business model for Industrial Design owners. The significant advantage of Industrial Designs, 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, an Industrial Design owner may decide to authorize other actors on the market (e.g.: another company, perhaps abroad, or a non-competing business at home)

to use its design, through a licensing agreement in exchange for the payment of royalties. This model could potentially be replicated numerous times, in different countries, with obvious positive consequences in terms of economic returns.

However, a prerequisite for the successful exploitation and commercialization of Industrial Designs is a well drafted licensing contract. Under this type of contracts, the owner of an Industrial Design grants permission to third parties to utilize its form, shape, product appearance or packaging for a specified duration, for a specific objective, for a particular country or region, and under agreed upon conditions.

Licensing entails significant advantages for the Industrial Design owner (i.e.: the Licensor):

- 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 innovative products.

Conversely, if businesspeople in Kosovo do not wish or cannot develop their own creative and innovative shapes, but rather wish to utilize those created by other players, may simply enter into a licensing agreement (as Licensees) with the owners of such registered designs to be authorized to use them.

In any case, commercialization of Industrial Designs requires the drafting of rather complex licensing contracts and agreements that should be handled by experienced lawyers.

Infringements of Industrial Designs and Remedies

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

First of all, Industrial Design owners should act as “watch dogs” and constantly monitor possible violations of their designs, shapes, forms, packaging, by third parties. In their daily job, they are often aware of what the competitors are doing and of any possible infringement of their 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, Industrial Design 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. 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/>.

Finally, in some cases, court litigation remains the only viable option to obtain justice. Article 64 of the Kosovar Law establishes that the competent court for industrial design enforcement is the Basic Court in Prishtina.

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

In terms of remedies, the Kosovo legislative framework (Chapter XVII of the Industrial Design law) provides for the following civil remedies to enforce Industrial Design rights:

1. Requesting declaration of infringement and the termination of the infringement of the design (art. 66).
2. Requesting for seizure and destruction of products (art. 67).
3. Requesting damage compensation, ordinary compensation and unfair enrichment (art. 68).
4. Publication of the verdict of the court confirming violation of Industrial Design rights in public media, at the expense of the offender (art. 69).

5. Requesting information on the origin and distribution network of products that infringe the Industrial Design to be provided (art. 70).
6. Requesting the transfer of the design rights through the Court (art. 71).
7. Requesting Interim actions/Preliminary measures in order to stop or prevent violations, to order the seizure or removal of the products from the market, which are contrary to the law, or in order to preserve evidence (art. 72 and 73).
8. Punitive measures, in the form of fines (art. 83).

On the other hand, as already mentioned, Kosovar businesspeople should be extremely careful not to violate Industrial Designs that are registered and protected in Kosovo (and in any other country where they do business), otherwise all the above measures and sanctions may be adopted against them. In other words, if they wish to use a design that is protected by an Industrial Design belonging to another person, they should make sure that they have the authorization of the legitimate Industrial Design owner: careful!

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

Useful websites

- Kosovo IP Agency: kipa.rks-gov.net
- EUIPO: EUIPO - Home (europa.eu)
- EPO: <http://www.epo.org/>
- FAO: www.fao.org
- WIPO: www.wipo.int
- WIPO SME Division: www.wipo.int/sme
- WIPO Arbitration and Mediation Center: <http://arbitr.wipo.int>
- WTO: <http://www.wto.org>
- EU: Geographical indications - Trade - European Commission (europa.eu)
- OriGIn - Home - oriGIn | Organization for an International Geographical Indications Network (origin-gi.com)
- Directory of IP Offices worldwide: <http://www.wipo.int/directory/en/urls.jsp>
- International Geographical Indication Association (INTA): <http://www.inta.org>
- IP Panorama: <https://www.wipo.int/sme/en/multimedia/>

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