

## **THE PARLIAMENTARY ASSEMBLY OF BOSNIA AND HERZEGOVINA**

Pursuant to Article IV.4.a) of the Constitution of Bosnia and Herzegovina, the Parliamentary Assembly of Bosnia and Herzegovina, at the 80<sup>th</sup> session of the House of Representatives, held on April 7, 2010, and at the 48<sup>th</sup> session of the House of Peoples, held on May 28, adopted the

### **LAW ON TRADEMARKS**

#### **PART ONE - GENERAL PROVISIONS**

##### Article 1 (Subject Matter of the Law)

- (1) This Law governs the manner of acquisition, maintenance, content, record of transfers, termination and protection of a trademark in the territory of Bosnia and Herzegovina (hereinafter referred to as BiH).
- (2) For the purposes of this Law, a trademark shall be the right that protects a sign used in the course of trade to distinguish goods and services of a natural or legal person from identical or similar goods and services of another natural or legal person.
- (3) An applied for and registered trademark constitutes an independent property that confers on its holder the exclusive rights provided by this Law.
- (4) This Law shall also apply to trademarks, which are internationally registered for the territory of Bosnia and Herzegovina.

##### Article 2 (Individual, Collective and Guarantee Trademark)

- (1) An individual trademark shall be the trademark of a natural or legal person, used to distinguish one or more kinds of the goods or services of such person from identical or similar goods or services of other participants in the course of trade.
- (2) A collective trademark shall be the trademark of a legal entity, representing a certain form of association of manufacturers or providers of services, whose members are entitled to use such a trademark under the conditions laid down in this Law.
- (3) The user of a collective trademark shall be entitled to use such a trademark only in the manner as provided by the general act on the collective trademark.
- (4) A guarantee trademark shall be a trademark used by several persons under the supervision of the holder of the trademark, and which serves as a guarantee of quality, geographical origin, manner of production or other common characteristics of the goods or services of such persons.
- (5) The holder of a guarantee trademark shall allow any person to use a guarantee trademark for the goods or services having common characteristics, under the conditions provided by the general act on the guarantee trademark.

Article 3  
(What Shall Not Be Considered as a Trademark)

For the purposes of this Law, a seal, a stamp and official signs for marking precious metals, measurements and the like shall not be considered as trademarks.

Article 4  
(Signs Which May be Protected by a Trademark)

- (1) A trademark may protect a sign, which is capable of distinguishing identical or similar goods or services in the course of trade and which may be represented graphically.
- (2) A sign may consist in particular of: words, including personal names, drawings, letters, numerals, images, the shape of products or of their packaging, arrangement of colors, three-dimensional forms or the combination of such elements.
- (3) When deciding whether a sign is capable of distinguishing goods or services in the course of trade, all the circumstances, and in particular, the time and extent of its use in Bosnia and Herzegovina thus far, shall be taken into account.
- (4) The nature itself of the goods or services designated by a trademark shall not be an obstacle to the grant of a trademark.

Article 5  
(National treatment)

- (1) A domestic or foreign natural or legal person may be the holder of a registered trademark or the applicant for the grant of a trademark under the conditions prescribed by this Law.
- (2) Foreign natural and legal persons shall enjoy the same rights with regard to the protection of a sign by a trademark in BiH as are enjoyed by domestic natural and legal persons if that arises from international treaties or conventions acceded to or ratified by BiH (hereinafter: international treaties and conventions) or from the principle of reciprocity.
- (3) The existence of reciprocity shall be presumed until proven otherwise.

Article 6  
(Absolute Grounds for Refusal of a Trademark Application)

- (1) A trademark shall not protect a sign:
  - a) which is contrary to public order or morality;
  - b) which cannot be represented graphically;
  - c) which is identical with an older trademark or an earlier applied for sign for identical goods or services;
  - d) which, by its overall appearance, is not capable of distinguishing goods or services in the course of trade, for those goods or services for which a trademark application has been filed;

e) which consists exclusively of signs or indications which serve, in the course of trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin of a product, the time or manner of production of the goods or of service providing or to designate other characteristics of the goods or services;

f) which consists exclusively of signs or indications which have become customary in the everyday or technical language, or in the *bona fide* and the established practices of trade for designating certain kinds of the goods or services;

g) which represents the shape determined exclusively by the nature of the product or the shape of product necessary to obtain a particular technical result or the shape which gives substantial value to the product;

h) which by its appearance or content may deceive the public, in particular, as to the geographical origin, kind, quality or other characteristics of the goods or services;

i) which contains official signs of quality control or warranty, or imitates them;

j) which contains a national or other coat of arms, flag or emblem, the name or abbreviated name of a country or an international organization, as well as the imitation thereof, unless authorized by the competent authority of the country or organization concerned;

k) which contains the name or abbreviated name, coat of arms, emblem, flag or another official sign of BiH, or of its entities, cantons or the District or imitates them, unless authorized by the competent authority;

l) which represents or imitates a national or a religious symbol;

m) which is a sign for wines and which contains or consists of a geographical indication identifying wines or which is a sign for spirits containing or consisting of a geographical indication identifying spirits, with respect to the wines or spirits not having that geographical origin;

n) which represents exclusively an appellation of origin, internationally registered to have effect in Bosnia and Herzegovina.

(2) The sign referred to in paragraph 1 items d), e) and f) of this Article may be protected by a trademark if the applicant proves that by the serious use of it, the sign has become capable of distinguishing in the course of trade the goods or services to which it relates.

## Article 7

### (Relative Grounds for Refusal of a Trademark Application)

1. On the grounds of an opposition filed, a trademark shall not protect a sign:

a) which is identical with an earlier protected sign of another person for similar goods or services or similar to an earlier protected sign of another person for the identical or similar kind of goods or services if, due to such identity or similarity, there exist a

likelihood of confusion in the course of trade, which includes the likelihood of association with an earlier protected trademark;

b) which is identical or similar to, for the identical or similar kind of goods or services, a sign of another person which is well-known in BiH, within the meaning of Article 6bis of the Paris Convention for the Protection of Industrial Property (hereinafter: a well-known sign);

c) which, in accordance with Article 16, paragraph 3 of the TRIPS Agreement (the Agreement on Trade-Related Aspects of Intellectual Property Rights), regardless of the goods or services to which it relates, constitutes a reproduction, an imitation or a transliteration of a protected sign of another person or the essential part thereof, which is known beyond any doubt by the participants in the course of trade in BiH as a sign of high reputation (hereinafter: a famous trademark) used by another person to designate his goods or services, if the use of such a sign would take unfair advantage of the reputation of a famous trademark or be detrimental to its distinctive character or reputation;

d) whose appearance or content infringes an older copyright or geographical indication or an earlier protected industrial design;

e) the use of which would infringe the right to the personal name of a renowned person or the personal portrayal of any person if the came into existence before the date of a trademark application or the date of the granted priority claimed in the trademark application;

f) which is identical with or similar to an earlier trademark which was registered for identical or similar goods or services and which has expired due to the failure to renew the registration if less than two years have elapsed from the expiry of the earlier trademark, unless the holder of the earlier trademark gave his consent for the grant of the later trademark or did not use his trademark.

g) which is filed contrary to the principle of good faith, conscientiousness and honesty.

(2) The protected sign referred to in paragraph 1 items a) and c) of this Article shall be considered to be a sign which is protected by a trademark for the territory of BiH, whereas the protected sign referred to in item a) of paragraph 1 of this Article shall be considered to be a sign which is the subject matter of the application for the grant of a trademark for the territory of BiH, provided that a trademark applied for in that application is granted.

## Article 8 (Determining Whether a Sign is Well-Known)

(1) In determining whether the sign referred to in paragraph 1 item b) of Article 7 of this Law is a well-known sign or whether the sign referred to in paragraph 1 item c) of Article 7 of this Law is a famous trademark, the knowledge of the sign in the relevant sector of the public, including the knowledge which has been obtained as a result of the promotion of the sign shall be taken into account.

(2) The relevant sector of the public shall be considered to be the actual and potential users of goods or services designated by such a sign, as well as persons involved in the distribution channels of such goods or services.

#### Article 9

(Protection of the Personal Name of a Renowned Person or the Portrayal of Any Person)

(1) The portrayal, personal name, nickname or the pseudonym of a renowned person may be protected by a trademark only with the consent of such a person.

(2) A sign which contains the portrayal of a person may be protected by a trademark only with the consent of such a person, whereas the portrayal of a deceased person may be protected by a trademark only with the consent of the spouse and children of the deceased, failing this, with the consent of parents, and in the absence of parents, with the consent of other heirs, unless otherwise provided by a will.

(3) The protection of a sign containing the portrayal, the personal name, the nickname, or the pseudonym of a historic or other deceased renowned person shall require the authorization given by the competent authority.

#### Article 10

(Competence for the Trademark Protection Procedure)

(1) The Institute for Intellectual Property of Bosnia and Herzegovina (hereinafter: the Institute) shall carry out the tasks relating to the trademark protection in the administrative procedure prescribed by this Law.

(2) Unless otherwise provided by this Law, the provisions of the Law on Administrative Procedure ("Official Gazette of Bosnia and Herzegovina", No. 29/02, 12/04, 88/07 and 93/09) shall be applied in the procedure before the Institute.

(3) A decision issued by the Institute in the procedure referred to in paragraph 1 of this Article may be appealed before the Board of Appeal of the Institute (hereinafter: the Board of Appeal) within the period of 15 days from the day of receipt of the decision.

(4) An administrative dispute may be instituted against a decision issued by the Board of Appeal before the Court of Bosnia and Herzegovina, within 30 days from the day of receipt of the decision.

#### Article 11

(Registers)

(1) The Institute shall maintain, in electronic form, the Register of Applications for the Grant of Trademark (hereinafter: the Register of Applications), the Register of Trademarks and the Register of Trademark Representatives (hereinafter: Register of Representatives).

(2) The Registers referred to in paragraph 1 of this Article shall form a single system of the registers of industrial property of Bosnia and Herzegovina in electronic form.

(3) The content of the Registers referred to in paragraph 1 of this Article shall be prescribed by a special regulation for the implementation of this Law, to be enacted by the Director of the Institute (hereinafter: the implementing regulation).

(4) The Registers referred to in paragraph 1 of this Article shall be considered as public books, and any interested person may inspect them, without payment of any special fees or reimbursement of expenses.

(5) At a written request of any interested person, and subject to the payment of the prescribed fee and reimbursement of expenses, the Institute shall issue the copies of documents and relevant attestations and certificates on the facts concerning which it maintains official records.

#### Article 12 (Representation)

(1) Natural and legal persons practicing representation in the trademark grant procedure before the Institute shall be entered in the Register of Representatives referred to in paragraph 1 of Article 11 of this Law.

(2) A foreign natural or legal person must be represented in the procedure carried out before the Institute by a representative entered in the Register of Representatives, whereas a domestic natural or legal person may also act before the Institute by himself.

(3) Natural and legal persons fulfilling the conditions specified in the implementing regulation shall be entered in the Register of Representatives.

#### Article 13 (Provision of Information)

(1) The Institute shall allow any person, at his written request, to inspect the documentation relating to a trademark.

(2) The content and a manner of inspection referred to in paragraph 1 of this Article shall be regulated by the implementing regulation.

(3) Search services of applied for and registered trademarks provided to foreign persons shall be carried out through a representative referred to in Article 12 paragraph 2 of this Law, whereas domestic persons may request the provision of search services by themselves.

#### Article 14 (Fees and Charges in the Procedures for the Acquisition and Maintenance of a Trademark and Information Service Providing)

(1) All the acts in the procedure for the acquisition, maintenance, transfer and termination of a trademark, and the information service providing shall be subject to the payment of fees, in accordance with the valid regulations governing national administrative fees (hereinafter: the fees) and special procedural charges (hereinafter: the procedural charges) in the amount specified by a special tariff, enacted by the Ministry of Foreign Trade and Economic Relations of Bosnia and Herzegovina, upon the motion of the Director of the Institute.

(2) Evidence of payment of the fees and procedural charges referred to in paragraph 1 of this Article shall be filed with the Institute, in the manner as defined by the implementing regulations.

## **PART TWO - PROTECTION PROCEDURE**

### Article 15

#### (Institution of the Procedure for the Grant of a Trademark)

(1) The procedure for the grant of a trademark shall be instituted by an application for the grant of a trademark (hereinafter: the application), filed with the Institute.

(2) The application shall contain a request for the grant of one trademark only which relates to one or more kinds of goods or services.

(3) The essential elements of the application shall be:

a) a request for the grant of a trademark;

b) a sign, which the applicant wishes to protect by a trademark;

c) a list of goods or services to which a sign relates in one of the official languages of BiH, which shall be drafted in accordance with the International Classification of Goods and Services, established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks.

(4) The content of the request for the grant of a trademark, a manner of its presentation and the number of copies of particular essential elements of the application, as well as the content of the attachments to be filed with the application shall be regulated by the implementing regulation.

### Article 16

#### (Applications for the Grant of a Collective Trademark and a Guarantee Trademark)

(1) In addition to the elements of the application referred to in paragraph (3) Article 15 of this Law, an application for the grant of a collective trademark shall be accompanied by the general act on the collective trademark, whereas an application for the grant of a guarantee trademark shall be accompanied by the general act on the guarantee trademark.

(2) The general act on a collective trademark shall contain: information on the applicant or a person authorized to represent him; the provisions relating to the appearance of the sign and the goods or services to which the sign relates; the provisions stipulating who is entitled to use the collective trademark and under what conditions; the provisions on the rights and obligations of the user of the collective trademark in the case of infringement of the trademark, and the provisions on the measures and consequences in the case of non-compliance with the provisions of the general act.

(3) The general act on the guarantee trademark shall contain, in addition to the provisions referred to in paragraph (2) of this Article, the provisions on the common characteristics of the goods or services as guaranteed by the guarantee trademark, and the provisions on the supervision of the use of the guarantee trademark by the holder thereof.

(4) The applicant or the holder of a collective trademark or a guarantee trademark shall file with the Institute, without delay, any amendments to the general act on a collective trademark or a guarantee trademark.

(5) Any person may inspect the general act on a collective trademark or a guarantee trademark.

Article 17  
(Register of Applications)

The data concerning essential elements of the application referred to in Articles 15 and 16 of this Law and other data prescribed by the implementing regulation shall be entered in the Register of Applications.

Article 18  
(Filing Date of an Application)

(1) The accordance of the filing date of an application shall require that the application filed with the Institute on such a date contains:

- a) an indication that the grant of a trademark is applied for;
- b) the name and surname or the trade name and address of the applicant;
- c) a sign which the applicant seeks to protect, and
- d) a list of the goods or services to which the sign relates.

(2) The Institute shall acknowledge the receipt of the application on the applicant's copy thereof.

(3) Upon receipt of the application, the Institute shall examine whether the application contains the elements referred to in paragraph (1) of this Article.

(4) If the application does not contain the elements referred to in paragraph (1) of this Article, the Institute shall invite the applicant to remove the deficiencies due to which the application could not be entered in the Register of Applications, within the period of 30 days, which may not be extended.

(5) If the applicant fails to remove the deficiencies within the period referred to in paragraph (4) of this Article, the Institute shall reject the application by a conclusion.

(6) If the applicant removes the deficiencies within the period referred to in paragraph (4) of this Article, the Institute shall accord the date on which the applicant removed the deficiencies as detected as the filing date of the application by a conclusion.

(7) The application to which the filing date has been accorded shall be entered in the Register of Applications.

Article 19  
(Right of Priority)



As of the filing date of the application, the applicant shall have the right of priority over any other person filing later the application for the identical or similar sign designating the identical or similar goods or services.

Article 20  
(Union Priority Right)

(1) Any natural or legal person who has filed a correct trademark application having effect in any of the Member States of the Paris Union or the World Trade Organization (hereinafter referred to as WTO) shall be granted the right of priority in BiH as of the date of filing such an application, if he files an application for the identical sign and the identical goods or services in BiH within the period of six months from the day of filing the application having effect in the state concerned.

(2) The person invoking the right of priority referred to in paragraph (1) of this Article shall indicate in the application for the grant of a trademark the filing date, the number of the application and the country for which the application was filed.

(3) A correct application referred to in paragraph (1) of this Article shall be considered to be each application fulfilling the conditions of correctness under the national legislation of a Member State of the Paris Union or the WTO for which the application was filed or under the provisions of an international organization established under the treaty concluded among such countries, regardless of the subsequent legal outcome thereof.

(4) The person referred to in paragraph 1 of this Article shall file with the Institute a true copy of the application referred to in paragraph 1 of this Article, certified by the competent authority of a Member Country of the Paris Union, or the World Trade Organization or the international organization with which such application was filed, as well as a certified translation of the true copy in one of the official languages of Bosnia and Herzegovina, within three months from the day of filing the application in Bosnia and Herzegovina.

(5) If the person referred to in paragraph (1) of this Article fails to comply with the obligation referred to in paragraph (4) of this Article, the Institute shall not grant the priority as claimed, and shall determine by a conclusion that a right of priority exists as of the filing date of the application as accorded under Article 18 of this Law, and shall continue the procedure on the application as filed.

(6) The content of the request for priority certificate and the content of the priority certificate, issued by the Institute, shall be regulated by the implementing regulation.

Article 21  
(Exhibition (Fair) Priority Right)

(1) The applicant who has used a certain sign to mark the goods or services, respectively, on an official or officially recognized international exhibition in Bosnia and Herzegovina or in any of the Member Countries of the Paris Union or the World Trade Organization, in accordance with the Convention on International Exhibitions, may claim in the application a right of priority from the first day of the exhibition or from the day on which such sign was used on the exhibition.

(2) The person claiming the grant of the priority right referred to in paragraph 1 of this Article shall submit with the application a written certificate issued by the competent authority of a Member State of the Paris Union or WTO in which the exhibition took place, indicating that the

exhibition or a fair in question had an international character, and specifying the type of the exhibition or fair the venue thereof, its opening and closing dates, and the first day of display, or the date of the first use of the sign the protection of which is sought.

(3) The Foreign Trade Chamber of Bosnia and Herzegovina shall issue a certificate to the effect that the exhibition or fair held in BiH has an officially recognized international character.

Article 22  
(Multiple Priorities)

The applicant may claim multiple priorities on the basis of earlier filed applications in one or more of the Member States of the Paris Union or WTO under the conditions specified in Article 20 of this Law.

Article 23  
(Calculation of the Time Limits of Priorities)

(1) The grant of the right of priority referred to in Article 21 of this Law shall not extend the time limits referred to in Article 20 of this Law.

(2) In the case of claiming multiple priorities referred to in Article 22 of this Law, the time limits which, according to Article 20 of this Law, run from the date of priority shall be calculated from the priority date of the first application.

Article 24  
(Subsequent Alteration of a Sign Contained in the Application)

(1) The appearance of a sign contained in the application shall not be subsequently substantially altered nor shall the list of goods or services accompanying the application be subsequently extended.

(2) Any alteration of any distinctive element of a sign shall be considered as a substantial alteration of a sign.

(3) The specification or reduction of a list of goods or services shall not be considered as the extension thereof.

Article 25  
(Order of Examination of Applications)

(1) The applications shall be examined in order of the filing dates thereof.

(2) By way of derogation from the provision of paragraph (1) of this Article, the application may be examined in an expeditious procedure:

a) in the case of a legal dispute or an inspection control as initiated or a customs procedure;

b) if a request for the international registration of a trademark is filed and, where according to an international agreement, the international registration of the trademark is conditioned by the national registration of the trademark;

c) if, according to other regulations, an expeditious registration procedure shall be carried out within a specified time limit, with the obligation to file a special request therefore;

(3) In the case referred to in paragraph (2) of this Article, a request for the examination of the application in the expeditious procedure shall be filed.

(4) The request for the examination of the application in the expeditious procedure referred to in items b) and c) of paragraph (2) of this Article shall be subject to payment of the administrative fee and procedural charges.

#### Article 26

##### (Examination of the Correctness of the Application and the Rejection Thereof)

(1) The procedure for the examination of the correctness of the application shall include the examination of all the conditions prescribed by this Law and the implementing regulation.

(2) The application shall be correct if it contains the essential elements referred to in Articles 15 and 16 of this Law, evidence of payment of the fee and procedural charges and other prescribed data.

(3) If the Institute establishes that the application is not correct, it shall invite the applicant in writing, stating the reasons, to correct the application within a period which shall neither be less than 30 days nor more than 60 days.

(4) At a reasoned request of the applicant, and subject to the payment of the prescribed fee and special charges, the Institute shall extend the time limit referred to in paragraph (3) of this Article for a period it considers to be appropriate, but which shall neither be less than 15 days nor more than 60 days.

(5) If the applicant fails to correct the application or to pay the fee and procedural charges for the correction thereof within the specified time limit, the Institute shall reject the application by a conclusion.

(6) In the case referred to in paragraph (4) of this Article, the applicant may, subject to the payment of the prescribed fee and procedural charges, file a proposal for the *restitutio in integrum* within 90 days from the day of receipt of the conclusion on the rejection.

#### Article 27

##### (Abandonment of the Application)

(1) The applicant may abandon the application in whole or in relation to some of the goods or services in the course of the procedure.

(2) If a particular right on behalf of a third person has been entered in the Register of Applications, the applicant may not abandon the application without a written consent of the person on behalf of whom such right has been entered in the Register.

(3) Where the applicant abandons the application in whole, the Institute shall issue a special conclusion on the suspension of the procedure.

(4) In the case referred to in paragraph (3) of this Article, the application shall cease to have effect on the day following the day on which a declaration on the abandonment is delivered to the Institute.

Article 28  
(Division of the Application)

(1) The application listing several kinds of goods or services (hereinafter: the original application) may, at the request of the applicant, be divided into two or more applications, up to the entry of a trademark in the Register of Trademarks, by dividing the list of goods or services.

(2) The content of the request for the division of the application shall be regulated by the implementing regulation.

(3) A divisional application shall preserve the filing date of the original application and its right of priority.

(4) A special decision on the division of an application shall be issued, specifying the number or the numbers of new applications, a sign as having been contained in the original application, as well as the goods or services remaining in the original application, and the goods or services indicated in the divisional application or applications.

(5) The divisional application or applications shall be entered in the Register of Applications.

(6) The provisions of paragraphs (1) to (5) of this Article shall not apply to the applications for the grant of a collective trademark or a guarantee trademark.

Article 29  
(Examination of the Absolute Grounds for Refusal of the Application)

If the application is correct within the meaning of Article 26 of this Law, the Institute shall examine whether the absolute grounds for the refusal of the application, prescribed by Article 6 of this Law, exist.

Article 30  
(Special Examination of the General Act on a Collective Trademark and a Guarantee Trademark)

(1) When examining the conditions for the grant of a collective trademark and a guarantee trademark, the Institute shall examine, in particular, whether the general act on the collective trademark or the guarantee trademark is in conformity with the morality and public order.

(2) If the general act on a collective trademark or a guarantee trademark is contrary to morality or public order, the provisions of Article 32 of this Law shall apply accordingly.

(3) Paragraphs (1) and (2) of this Article shall apply to any amendments to the general act on a collective trademark or a guarantee trademark.

Article 31  
(Voluntary Limitation of the Scope of Protection - "Disclaimer")

(1) If a sign contains an element which does not fulfill the conditions for the trademark protection within the meaning of items d), e) and f) of paragraph (1) of Article 6 of this Law, and if the inclusion of such an element in the sign could raise doubt as to the scope of the trademark protection, the Institute shall require from the applicant in writing to file a written declaration in which he confirms that he does not claim any exclusive rights on that element, within a period which shall neither be less than 30 days nor more than 60 days.

(2) If a sign contains an element which is vague and ambiguous within the meaning of paragraph (1) of this Article, the Institute shall require from the applicant in writing to file the description of the sign explaining such an element, within the time limit referred to in paragraph (1) of this Article.

#### Article 32 (Refusal of a Request for the Grant of a Trademark)

1. If the Institute finds that the application does not fulfill the conditions specified in Article 6 of this Law, it shall, on the basis of the examination results, inform the applicant in writing of the grounds for which a trademark shall not be granted and shall invite him to file his observations, within a period which shall neither be less than 30 days nor more than 60 days.

(2) At a reasoned request of the applicant and subject to the payment of the administrative fee and procedural charges, the Institute shall extend once the time limit referred to in paragraph (1) of this Article for a period, which it considers it to be appropriate, but which shall neither be less than 15 days nor more than 60 days.

(3) The Institute shall reject by decision a request for the grant of a trademark in whole or in relation to particular goods or services if the applicant fails to comply with a request referred to in paragraph (1) of this Article or if he complies with it, but nevertheless the Institute still considers that the trademark may not be granted in whole or in relation to particular goods or services.

(4) The Institute shall refuse a request for the grant of a trademark by a decision if the applicant fails to comply with the request of the Institute referred to in Article 30 of this Law.

### **PART THREE - OPPOSITION**

#### Article 33 (Publication of the Application)

(1) The application, which fulfills the conditions referred to in Article 26 paragraph (2) of this Law, shall be published in the Official Gazette of the Institute, provided that there are no grounds for refusal of the application referred to in Article 32 of this Law.

(2) The data contained in the application which are to be published shall be regulated by the implementing regulation.

#### Article 34 (Opinion of an Interested Person)

(1) Upon the publication of the application, any interested person may, within 3 months from the publication, submit to the Institute a written opinion containing an explanation as to why a sign

contained in the published application does not fulfill the conditions specified in Article 6 of this Law.

(2) The person referred to in paragraph (1) of this Article shall not be a party to the procedure.

(3) The Institute shall send to the applicant the opinion referred to in paragraph (1) of this Article if it considers it relevant for the grant of the application, and shall invite him to give his response within the period which shall neither be less than 15 days nor more than 30 days.

(4) Upon receipt of the response of the applicant, the Institute shall, at its own discretion, issue a decision on the grant or the refusal of the request for the grant of a trademark.

#### Article 35 (Objection)

(1) Upon the publication of the application, any interested person may, within 3 months from the publication thereof, submit to the Institute a written opposition containing an explanation as to why a sign contained in the published application does not fulfill the conditions laid down in Article 7 of this Law.

(2) The interested person referred to in paragraph (1) of this Article shall be:

a) the holder of an earlier protected sign in the case referred to in items a), b), c) and d) of paragraph (1) of Article 7 of this Law;

b) the holder of any of the rights referred to in item e) of paragraph (1) of Article 7 of this Law;

c) the holder of an earlier trademark in the case referred to in Article 7 paragraph 1 item f) of this Law;

d) the person who would be entitled to file the application in the case referred to in Article 7 paragraph 1 item g) of this Law; and

e) the holder of the earlier protected sign or the holder of the exclusive license in such a sign.

(3) The time limit for filing the opposition referred to in paragraph (1) of this Article shall not be extended for any reason, nor shall it be possible to submit, after the expiration of this time limit, any amendments to the opposition, including the submission of additional evidence supporting the opposition.

(4) If, on the date of publication of the application against which the opposition is filed, the procedure for the revocation of the decision on the grant of a trademark or an international registration or the procedure for the termination of a trademark due to non-use is pending, and the opposition is based on the trademark which is the subject of any of the indicated procedures, the Institute shall halt the opposition procedure until the decision from the earlier initiated procedure becomes final.

(5) The interested person referred to in paragraph (1) of this Article shall have the status of a party to the opposition procedure.

#### Article 36 (Content of the Objection)

(1) An opposition shall contain, in particular:

a) the name and surname or the company name of the opponent and his address or registered office;

b) a detailed explanation of all the grounds and evidence on which the opponent basis its objection and by which he proves its status of the interested person referred to in Article 35 of this Law;

c) all the published data relating to the application against which an objection is filed, including the number of the application, the name, surname and address or the company name and registered office of the applicant, and a representation of a sign applied for with a list of goods and services;

d) a dully filed power of attorney if the objection is filed through a representative.

(2) An opposition shall be filed in two copies.

#### Article 37 (Opposition Procedure)

(1) Upon the receipt of an opposition, the Institute shall examine whether the opposition complies in whole with Articles 35 and 36 of this Law.

(2) If the conditions laid down in paragraph (1) of this Article are not fulfilled, the Institute shall reject the opposition by a conclusion.

(3) If the conditions laid down in paragraph (1) of this Article are fulfilled, the Institute shall send the opposition to the applicant and shall invite him to submit his written observations on it within 60 days.

(4) The time limit referred to in paragraph (3) of this Article may not be extended, nor shall it be possible for the applicant to submit, after the expiration thereof, any amendments to his response to the opposition, including additional evidence.

(5) If the applicant fails to submit his observations on the opposition within the time limit referred to in paragraph (3) of this Article, the Institute shall refuse by a decision a request for the grant of a trademark as filed, within the limits of the requests contained in the opposition.

(6) If the applicant submits his observations on the opposition within the time limit referred to in paragraph (3) of this Article, the Institute shall examine the justification of the allegations contained in the opposition, and may order oral proceedings.

(7) If the opposition is filed on the grounds referred to in Article 7 paragraph (1) item g) of this Law, and the applicant has submitted his observations on the objection, the Institute may, on

the account of circumstances, instruct the parties to resolve the existence of the grounds referred to in Article 7 paragraph (1) item g) of this Law, as a preliminary matter in the procedure before the competent court.

(8) If the applicant states that the opponent has not used the trademark on which the opposition is based, the opponent shall prove that during the period of five years prior to the publication of the application against which the opposition has been filed, he has used his trademark within the territory of Bosnia and Herzegovina for the goods or services in relation to which the opposition is filed or shall prove that there were justified reasons for non-use of the trademark for such goods or services, provided that the earlier trademark has, on the date of publication of the application against which the opposition is filed, been registered for not less than five years.

(9) If the opponent fails to prove the use of his trademark within the meaning of paragraph (8) of this Article, the Institute shall refuse the opposition by a decision, to the extent to which the use of the trademark has not been proved.

(10) Following the opposition procedure as carried out, the Institute shall, on the basis of the facts as established, issue a decision on the refusal of the opposition or a decision on the partial refusal of the opposition and on the partial grant of a trademark or the refusal of the request for the grant of a trademark.

#### Article 38 (Decision on the Grant of a Trademark)

(1) If the application fulfils the conditions for the grant laid down in Articles 6 and 7 of this Law, the Institute shall issue a conclusion to that effect and shall invite the applicant to pay the administrative fee and procedural charges for the first ten years of protection, for the publication of the trademark and for the certificate, within 30 days, and to file with the Institute the evidence of payments.

(2) If the applicant fails to file the evidence of payments referred to in paragraph (1) of this Article within a specified time limit, it shall be considered that he has abandoned the application, and the Institute shall issue a conclusion on the suspension of the procedure.

(3) In the case referred to in paragraph (2) of this Article, the applicant may, subject to payment of the administrative fee and procedural charges, file a proposal for the restoration to original condition within three months from the day of receipt of the conclusion on suspension of the procedure.

(4) If the applicant submits the evidence of payments referred to in paragraph (1) of this Article, the Institute shall issue a decision on the grant of a trademark, according to the adopted representation of the sign and a list of goods or services determining the scope of the granted trademark protection, publish the trademark and issue a trademark certificate.

#### Article 39 (Entry of Decision on the Grant of a Trademark in the Register of Trademarks)

(1) A decision on the grant of a trademark including the prescribed data shall be entered in the Register of Trademarks.



(2) The data contained in a decision on the grant of a trademark to be entered in the Register of Trademarks shall be regulated by the implementing regulation.

(3) The date of entry of a decision on the grant of a trademark in the Register of Trademarks shall be the date of the decision on the grant of a trademark.

Article 40  
(Publication of a Trademark)

(1) A registered trademark with the prescribed data shall be published in the official gazette of the Institute.

(2) The data on a trademark to be published shall be regulated by the implementing regulation.

Article 41  
(Trademark Certificate)

(1) The Institute shall issue a trademark certificate together with a decision on the grant of the trademark.

(2) The content and form of a trademark certificate shall be regulated by the implementing regulation.

**PART FOUR - PROCEDURE FOR THE INTERNATIONAL REGISTRATION OF A TRADEMARK**

Article 42  
(General Provision)

The provisions of this Law and the implementing regulation shall apply to internationally registered trademarks for which the protection is also claimed for the territory of Bosnia and Herzegovina under the Madrid Agreement Concerning the International Registration of Marks (hereinafter: the Madrid Agreement) and the Protocol Relating to the Madrid Agreement (hereinafter: the Madrid Protocol) in all the matters which are not regulated by these Agreements, unless otherwise provided by the provisions of this part of the Law.

Article 43  
(Request for the International Registration of a Trademark and Request for the Entry of Change in the International Register)

(1) The holder of a trademark from Bosnia and Herzegovina and the person filing the application in Bosnia and Herzegovina may file a request for the international registration of a trademark, as well as a request for the entry of changes in the International Register in accordance with the Madrid Agreement and the Madrid Protocol.

(2) The requests referred to in paragraph (1) of this Article shall be filed through the Institute, in a manner as prescribed by the Madrid Agreement, the Madrid Protocol, the Common Regulations under the Madrid Agreement and the Protocol (hereinafter: the Common Regulations), this Law and the implementing regulation.

(3) The requests referred to in paragraph (1) of this Article shall be subject to the payment of the fees and procedural charges payable to the Institute, and the international fees payable directly to the International Bureau of the World Intellectual Property Organization (hereinafter: the International Bureau).

#### Article 44

(Procedure for the International Registration of a Trademark before the Institute)

(1) The procedure for the international registration of a trademark shall be instituted by filing a request for the international registration of a trademark.

(2) A request for the international registration of a trademark shall be accompanied by:

- a) the representation of a sign;
- b) a correctly drafted and classified list of goods or services in the French or English language;
- c) a power of attorney if the request is filed through a representative;
- d) evidence of payment of the fee and special procedural charges payable for the request.

(3) The content of the request referred to in paragraph (1) of this Article, as well as the content of the attachments accompanying the request shall be regulated by the implementing regulation.

(4) If a request for the international registration of a trademark is not correct, the Institute shall invite the applicant in writing to correct it within 30 days from the day of receipt of the invitation.

(5) On a reasoned request of the applicant, the time limit referred to in paragraph (4) of this Article shall be extended for not more than 60 days.

(6) If the applicant fails to comply with the invitation within the specified time limit referred to in paragraph (4) or (5) of this Article, the Institute shall reject a request for the international registration of a trademark by a conclusion.

(7) If a request for the international registration of a trademark is correct, the Institute shall invite the applicant by a conclusion to pay the fee for the international registration of the trademark to the International Bureau, and to submit evidence of the payment thereof.

(8) Where the applicant for the international registration of a trademark submits evidence of payment referred to in paragraph (7) of this Article, the Institute shall transmit a request for the international registration of a trademark to the International Bureau.

(9) If the applicant for the international registration fails to submit evidence of payment referred to in paragraph (7) of this Article within the specified time limit, the request shall be considered withdrawn, concerning which the Institute shall issue a conclusion.

#### Article 45

(Refusal of Protection of an Internationally Registered Trademark Applied for Bosnia and Herzegovina)

(1) If an international trademark applied for Bosnia and Herzegovina under the Madrid Agreement or the Madrid Protocol does not fulfill the conditions laid down in Article 6 of this Law, the Institute shall, in accordance with the Madrid Agreement or the Madrid Protocol, issue through the International Bureau a provisional refusal of the international registration in writing and shall invite the holder of the international trademark to submit through a domestic representative his observations on the grounds as specified for which his trademark shall not be granted in Bosnia and Herzegovina, within 4 months from the date of the provisional refusal.

(2) The provisions of Article 32 of this Law shall apply in further procedure accordingly.

Article 46

(Opposition to an Internationally Registered Trademark Applied for Bosnia and Herzegovina)

(1) For the purposes of the internationally registered trademarks applied for Bosnia and Herzegovina under the Madrid Agreement and the Madrid Protocol, the publication of the application prescribed in Article 33 of this Law shall be considered to be the publication of the internationally registered trademark in the official gazette of internationally registered trademarks published by the International Bureau (hereinafter: Marque International).

(2) The time limit for filing an opposition to an internationally registered trademark shall run from the first day of the month following the month indicated on the edition of Marque International in which such internationally registered trademark has been published.

(3) The Institute shall, through the International Bureau, send to the holder of an internationally registered trademark a notification of the provisional refusal based on an opposition and shall invite him to appoint a domestic representative.

(4) The representative referred to in paragraph (3) of this Article shall file with the Institute a power of attorney for representation within four months from the date of the notification of refusal.

(5) The Institute shall send a copy of the opposition to the representative referred to in paragraph (3) of this Article, after filing of the power of attorney referred to in paragraph (4) of this Article.

(6) The time limit for the response to the opposition shall be 60 days from the day of receipt of the copy of the opposition by the representative.

(7) The time limits referred to in paragraphs (4) and (6) of this Article shall not be extended.

(8) The provisions of Article 37 of this Law shall apply in further procedure accordingly.

(9) For the purposes of proving the use of a trademark, the date of the international registration of a trademark shall be considered to be the date of expiration of the time limit referred to in Article 5 paragraph (2) of the Madrid Agreement or Article 5 paragraph (2) subparagraph a) of the Madrid Protocol, or if on such a date the grant procedure or the opposition procedure has not yet been concluded, the date of notification of the final decision of the Institute on the grant of protection addressed to the International Bureau.

Article 47  
(Notification Addressed to the International Bureau)

The Institute shall notify the International Bureau without delay on the entry of changes in the Register of Trademarks and on the expiration of the internationally registered trademark.

Article 48  
(Territorial Extension of an International Trademark)

(1) The holder of an internationally registered trademark may file a request for the territorial extension of the international trademark to Bosnia and Herzegovina.

(2) The request referred to in paragraph (1) of this Article may relate to all of the goods and services for which the trademark is registered or to the part thereof.

(3) The content of the request referred to in paragraph (1) of this Article shall be regulated by the implementing regulation.

## **PART FIVE - CONTENT, ACQUISITION AND THE SCOPE OF RIGHTS**

Article 49  
(Exclusive Rights of the Holder of a Trademark)

(1) The holder of a trademark shall be entitled to prevent other persons from using without authorization:

a) a sign which is identical with his trademark with respect to the goods or services which are identical with those for which a trademark is registered;

b) a sign which is identical with or similar to his trademark with respect to the goods or services, which are identical with or similar to the goods or services for which the trademark is registered if there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with that sign and the trademark.

c) a sign which is identical with or similar to his trademark with respect to the goods or services which are not similar to those for which the trademark is registered, where the trademark has a reputation in Bosnia and Herzegovina, and where the use of that sign without due cause takes unfair advantage of or is detrimental to the distinctive character or the reputation of the trademark (a famous trademark).

(2) Within the meaning of paragraph (1) of this Article, the holder of a trademark shall be entitled to prohibit the following:

a) affixing the protected sign to the goods, to the packaging thereof, or labeling means;

b) offering the goods or putting them into circulation or stocking them for such purposes under the protected sign, or providing services there under;

c) importing, exporting, or transit of the goods under the protected sign;

d) using the protected sign on business documents and in advertising.

(3) The rights conferred by this Article shall have effect against third parties from the date of entry of a trademark in the Register of Trademarks.

Article 50  
(Reproduction of a Trademark in Dictionaries)

If the reproduction of a trademark in a dictionary, encyclopedia or similar works, including those in electronic form, gives the impression that the trademark constitutes a generic name of the goods or services for which it is registered, the publisher of the work shall, at a request of the holder of the trademark, ensure that the reproduction of the trademark is, at the latest in the following edition, accompanied by a note that the trademark is registered (the symbol **R**).

Article 51  
(Exhaustion of the Rights of the Holder of a Trademark)

(1) A trademark shall not entitle his holder to prohibit its use with respect to the goods designated by the trademark and put on the market anywhere in the world by the holder of the trademark or the person authorized by him.

(2) The provision of paragraph (1) of this Article shall not apply where there exist justified reasons for the holder of the trademark to oppose to further commercialization of the goods designated by the trademark, especially where the condition of the goods is impaired or substantially changed after they have been put on the market for the first time.

Article 52  
(Limitation of Rights of the Holder of a Trademark)

(1) The holder of a trademark shall not prohibit any other person from putting into circulation his goods or services under identical or similar sign if such a sign represents the trade name or the name of such person, acquired in a conscientious manner before the date of the granted priority of the trademark.

(2) The holder of a trademark shall not prohibit any other person from using, in accordance with good business practices, in the course of trade:

a) his own name or address;

b) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production or other characteristics of the goods or services;

c) a sign protected by a trademark where its use is necessary to indicate the intended purpose of the goods or services, in particular, where spare parts or accessories are concerned.

(3) If the subject matter of protection of a collective trademark or a guarantee trademark is a sign that implies a specific geographical area where the goods or services designated by it

originate from, the user of the collective trademark or the guarantee trademark shall neither prohibit other persons from using such a sign in accordance with good business practices nor prevent the authorized user of identical or similar registered geographical indication for the identical or similar kinds of goods or services from using it.

(4) The holder of a trademark shall not prohibit any other person from using the identical or similar sign to designate the goods or services of another kind, unless a well-known trademark is concerned.

(5) The holder of a registered famous trademark may prohibit any other person from using the identical or similar sign to designate goods or services which are not similar to those for which a trademark is registered if the use of such a sign would indicate a connection of those goods or services and the holder of the protected famous trademark, and if there is a likelihood that the holder of the famous trademark would suffer damage by such use.

#### Article 53

##### (Acquisition and Validity of a Trademark)

(1) A trademark shall be acquired by the entry thereof in the Register of Trademarks, and shall be valid from the filing date of the application.

(2) A trademark shall be valid for ten years counting from the filing date of the application, and subject to payment of the fee and procedural charges, its validity may be extended an indefinite number of times.

(3) The content of a request for the renewal of a trademark shall be regulated by the implementing regulation.

#### Article 54

##### (Obligation to Use a Trademark)

(1) The holder of a trademark shall use the trademark.

(2) If a trademark is not used without due cause, any interested person may, subject to payment of the fee and procedural charges, in accordance with Article 71 of this Law, institute a procedure for the termination of such trademark due to non-use.

#### Article 55

##### (Division of a Trademark)

(1) A trademark which is registered for several kinds of goods or services (hereinafter: original registration) may be divided at any time, at the request of the holder of a trademark, into two or more registered trademarks, by dividing a list of goods or services.

(2) The content of the request for the division of a trademark shall be regulated by the implementing regulation.

(3) A divisional trademark shall retain all the rights conferred by the original registration.

(4) The Institute shall issue a special decision on the division of a trademark, indicating: number of original registration, number or numbers of new trademarks, the sign contained in the original registration, as well as the goods or services remaining in the original registration, and the goods or services contained in the divisional trademark or trademarks.

(5) A divisional trademark or divisional trademarks shall be entered in the Register of Trademarks and published in the official gazette of the Institute.

(6) The Institute shall issue a divisional trademark or trademarks certificate, together with a decision on the grant of such trademarks.

(7) The provisions of paragraphs (1) to (6) of this Article shall not apply to the collective trademark or guarantee trademark.

## **PART SIX - CHANGES IN THE TRADEMARK APPLICATION OR REGISTRATION**

### Article 56

#### (Changes in the Name and Address of the Right Holder)

(1) At a request of the holder of a trademark or the applicant, and subject to payment of the fee and procedural charges, the Institute shall issue a decision on entry in the respective register of the changes of the name and address of the holder of a trademark or the applicant.

(2) The entry of changes of the name and address of the right holder relating to several trademarks or several applications may be requested in a single request referred to in paragraph (1) of this Article, provided that the registration numbers or the application numbers are indicated in the request.

(3) The entry of changes in accordance with paragraph (2) of this Article shall be subject to payment of a special fee and procedural charges for every change as requested.

(4) Every change referred to in paragraph (1) of this Article, as entered in the register, shall be published in the official gazette of the Institute, subject to payment of the fee and procedural charges.

(5) The content of the request for the entry of change referred to in paragraph (1) of this Article shall be regulated by the implementing regulation.

### Article 57

#### (Limitation of a List of Goods or Services)

(1) At the request of the trademark holder or the applicant, a list of goods or services contained in a registered trademark or an application as filed may be limited.

(2) The content of the request for the entry of changes referred to in paragraph (1) of this Article shall be regulated by the implementing regulation.

(3) The request filed in accordance with paragraph (1) of this Article shall be subject to payment of the fee and procedural charges.

(4) The Institute shall issue a special decision on the request for the limitation of the list of goods or services contained in a registered trademark or in an application.

(5) The decision referred to in paragraph (4) of this Article shall be published in the official gazette of the Institute.

(6) The Institute shall issue a trademark certificate with a limited list of goods or services together with the decision referred to in paragraph (4) of this Article on the limitation of the list of goods or services.

#### Article 58 (Transfer of Rights)

(1) The transfer of a trademark or the rights conferred by an application may be made on the basis of a contract on the transfer of rights, as well as on the basis of a change of the status of the holder of a trademark or the applicant or a court or administrative decision.

(2) The transfer of rights referred to in paragraph (1) of this Article shall be entered in the respective register of the Institute at the request of the holder of a trademark or the applicant or the new right holder.

(3) The entry of the transfer of a trademark or the rights conferred by the application, based on the transfer contract, shall not be allowed if such transfer would obviously create confusion in the course of trade with respect to the nature, quality or geographical origin of the goods or services in respect of which it is registered or applied for, unless the new right holder agrees to waive the protection for those kind of goods or services in respect of which there is likelihood of confusion.

(4) The entry of the transfer of a trademark or the rights conferred by the application with respect to some of the goods or services, where the goods or services to be transferred are substantially similar to the goods or services covered by the trademark or the application for the grant of a trademark of the transferor, shall not be allowed.

(5) The entry of the transfer of rights referred to in paragraph (1) of this Article in the respective register shall have legal effects against third parties as of the date of the entry.

(6) The Institute shall issue a special decision on the entry of the transfer of rights referred to in paragraph (1) of this Article in the respective register.

(7) A collective trademark and a guarantee trademark may not be the subject of the transfer of rights.

#### Article 59 (Contract on the Transfer of Rights)

(1) The holder of a trademark or the applicant may transfer the trademark or rights conferred by the application in respect of some or all of the goods or services by a contract on the transfer of rights referred to in paragraph (1) of Article 58 of this Law.



(2) The contract on the transfer of rights referred to in paragraph (1) of this Article shall be made in writing and it shall contain: indication of the contracting parties, the number of a trademark or the number of the application and the amount of remuneration if agreed upon, and the goods or services which are the subject of the transfer.

Article 60  
(License and Franchise)

(1) The holder of a trademark or the applicant may assign the right of use of a trademark or the rights conferred by the application in respect of some or all of the goods or services by a licensing contract.

(2) The licensing contract referred to in paragraph (1) of this Article shall be made in writing and it shall contain: indications of contracting parties, the number of trademark or the number of application, term of license, goods or services for which license is granted and the scope of license.

(3) The licensing contract referred to in paragraph (1) of this Article shall be entered in the respective register at the request of the trademark holder or the applicant or the licensee.

(4) The entry of the licensing contract referred to in paragraph (1) of this Article in the respective register shall have legal effects against third parties as of the date of the entry.

(5) The Institute shall issue a decision on the entry of the licensing contract referred to in paragraph (1) of this Article in the respective register.

(6) A collective trademark and a guarantee trademark may not be the subject of a licensing contract.

(7) The provisions of this Article relating to licensing contract shall apply to franchising contract accordingly.

Article 61  
(Publication of the Transfer of Rights, License and Franchise)

The Institute shall publish in the official gazette that the transfer of rights, the license or the franchise, referred to in articles 59 and 60 of this Law, have been entered in the respective register.

Article 62  
(Pledge)

(1) A trademark or the rights conferred by the application may be the subject-matter of a pledge contract in respect of all or some of the goods or services.

(2) The pledge contract referred to in paragraph (1) of this Article shall be made in writing and it shall contain: date of the execution thereof, the name and surname or the trade name, domicile or residence or the principal place of business of the contracting parties, as well as of the debtors if different persons are concerned, the registration number of a trademark or the number of the application for the grant of a trademark and the data on the debit claims to be secured by the pledge.

- (3) A lien creditor shall acquire a pledge by the entry thereof in the respective register.
- (4) The pledge contract referred to in paragraph (1) of this Article shall be entered in the respective register at the request of the trademark holder or the applicant or the lien creditor, and subject to payment of the fee and procedural charges.
- (5) The Institute shall issue a decision on the entry of the pledge contract referred to in paragraph (1) of this Article in the respective register.
- (6) A collective trademark and a guarantee trademark shall not be the subject-matter of a pledge contract.

#### Article 63

(Procedure for the Entry of a Transfer of Rights, a License and a Franchise or a Pledge in the Register)

- (1) A procedure for the entry of the transfer of rights, a license, a franchise or a pledge in the respective register of the Institute shall be initiated by a written request.
- (2) The request referred to in paragraph (1) of this Article shall be accompanied by:
- a) evidence of the legal basis of the transfer the entry of which is requested;
  - b) a power of attorney if the procedure for the entry of the transfer of rights, a license, a franchise or a pledge is initiated through a representative;
  - c) evidence of payment of the fee and procedural charges for the decision on the entry of the transfer of rights, a license, a franchise or a pledge in the register.
- (3) The entry of the transfer of rights relating to several trademarks or several applications may be contained in a single request referred to in paragraph (1) of this Article, provided that the former holder and the new holder are the same in every trademark or application, and that the registration numbers of trademarks or the numbers of applications are indicated in the request.
- (4) The entry of a license, a franchise or a pledge relating to several trademarks, or several applications may be contained in a single request referred to in paragraph (1) of this Article, provided that the holder of the rights and the holder of a license, the holder of a franchise or the holder of a pledge are the same in every trademark or application, and that the registration numbers of trademarks, or the numbers of applications are indicated in the request.
- (5) The requests referred to in paragraphs (3) and (4) of this Article shall be subject to payment of the fees and procedural charges for every trademark or application indicated in the request.
- (6) The content of the request referred to in paragraph (1) of this Article, as well as the content of the attachments accompanying the request shall be regulated by the implementing regulation.

#### Article 64

(Correctness of a Request for the Entry of the Transfer of Rights, a License, a Franchise or a Pledge in the Register)

(1) A request for the entry of rights, a license, a franchise or a pledge in the register is correct if it contains indications referred to in Article 63 paragraph (2) of this Law and other prescribed indications.

(2) If a request for the entry of the transfer of rights, a license, a franchise or a pledge in the register is not correct, the Institute shall invite the applicant to correct it within a period of 30 days from the day of receipt of the invitation.

(3) At a reasoned request of the applicant and subject to payment of the fee and procedural charges, the Institute shall extend the time limit referred to in paragraph (2) of this Article for a period which it considers it to be appropriate, but which shall not be less than 15 days and not more than 60 days.

(4) If the applicant fails to comply with the invitation within the time limit referred to in paragraph (2) of this Article, the Institute shall reject the request by a conclusion.

Article 65

(Examination of the Legal Basis of a Request for the Entry of the Transfer of Rights, a License, a Franchise or a Pledge in the Register)

(1) If a request for the entry of the transfer of rights, a license, a franchise, or a pledge in the register is correct within the meaning of Article 64 paragraph (1) of this Law, the Institute shall examine whether the legal basis on which such a request is based fulfills the conditions for the entry of the transfer of rights, a license, a franchise, or a pledge in the register, prescribed by the law.

(2) If the legal basis on which a request for the entry of the transfer of rights, a license, a franchise, or a pledge in the register does not fulfill the conditions prescribed by this Law, the Institute shall invite the applicant to submit observations on the grounds for which the entry shall not be effected, within a period of 30 days from the day of receipt of the invitation.

(3) At a reasoned request of the applicant and subject to payment of the fee and procedural charges, the Institute shall extend the time limit referred to in paragraph (2) of this Article for a period, which it considers it to be appropriate, but which shall not be less than 15 days, and not more than 60 days.

(4) The Institute shall refuse a request for the entry of the transfer of rights, a license, a franchise, or a pledge in the register by a decision if the applicant fails to submit observations on the grounds for which the entry in the register shall not be allowed, within the time limit referred to in paragraph (2) of this Article, or if he submits such observations, but nevertheless the Institute continues to consider that the entry shall not be allowed.

## **PART SEVEN - TERMINATION OF RIGHTS**

Article 66

(Termination of a Trademark)

(1) A trademark shall be terminated at the expiration of a period of ten years for which the fee and procedural charges have been paid, unless renewed.

(2) A trademark may be terminated even before the expiration of a time limit referred to in paragraph (1) of this Article:

a) if the holder of a trademark surrenders his right – on the day following the day on which the holder has submitted the declaration of surrender to the Institute;

b) on the basis of a court decision, or a decision issued by the Institute, in the cases provided by this Law – on the day specified by the decision;

c) if a legal person or a natural person, who is the holder of a trademark, ceased to exist, or died - on the day the legal person ceased to exist or the natural person died, unless the trademark has been transferred to legal successors of such persons.

(3) A collective trademark and a guarantee trademark shall also be terminated where the Institute, when examining the amendments to the general act on a collective trademark or a guarantee trademark finds that the conditions laid down in Article 30 paragraph (1) of this Law are not fulfilled.

(4) The Institute shall issue a special decision in cases referred to in paragraph (2) items a) and c) and paragraph (3) of this Article.

#### Article 67 (Right of a Third Person)

(1) If a particular right on behalf of a third party has been entered in the Register of Trademarks, the holder of a trademark may not surrender such a trademark without a written consent of the person on behalf of whom such right has been entered in the register.

(2) If the holder of a trademark fails to pay the prescribed fee and procedural charges within the specified time limit, and a right on behalf of a third person is entered in the Register of Trademarks, the Institute shall notify such person that the fee and procedural charges have not been paid, and that he can pay them within a period of six months from the day of receipt of the notification and maintain thereby the trademark in effect.

### **PART EIGHT - REVOCATION OF A DECISION ON THE GRANT OF A TRADEMARK**

#### Article 68 (Conditions for the Revocation of a Decision on the Grant of a Trademark)

(1) A decision on the grant of a trademark may be revoked in whole or in respect of some of the goods or services if it has been established that the conditions for the grant of a trademark provided by this Law have not been fulfilled at the time of its registration.

(2) A decision on the grant of a collective trademark or a guarantee trademark may be declared null and void, if it has been established that the general act on the collective trademark or the general act on the guarantee trademark or the amendments thereto did not or do not fulfill the conditions referred to in Article 30 paragraph (1) of this Law.

## Article 69

### (Proposal for the Revocation of the Decision on the Grant of a Trademark)

- (1) A decision on the grant of a trademark may be declared null and void *ex officio* or upon a proposal of an interested person, a proposal of the State Attorney of BiH or a proposal of the Ombudsman of BiH, for the whole duration of the term of protection of a trademark.
- (2) By way of derogation from the provision of paragraph (1) of this Article, a proposal for the declaration of a decision on the grant of a trademark null and void on the basis of Article 7 paragraph (1) of this Law may be filed only by the holder of the older right or the person authorized by him, unless he knew, for the period of five consecutive years preceding the filing of the proposal, about the use of the later trademark whose holder acted in good faith, and has not objected to such use.
- (3) If an opposition to a trademark application is filed on the grounds prescribed in Article 7 paragraph (1) of this Law, and the decision on the refusal of the opposition is final, the same person may not file a proposal for the declaration of a decision on the grant of a trademark null and void on the same grounds as indicated in the refused opposition, unless the person filing the proposal submits new evidence which would by itself, or in combination with already used evidence, result in different decision in the opposition procedure.
- (4) A decision on the grant of a trademark shall not be declared null and void on the basis of Article 7 paragraph (1) items a), b) and c) of this Law, if earlier trademark had not been used without due cause in Bosnia and Herzegovina to designate goods or services, to which it related, for a period of five years preceding the filing of proposal for the declaration null and void, unless the applicant for the later trademark acted in bad faith.
- (5) A proposal for the declaration of a decision on the grant of a trademark null and void shall be accompanied by the appropriate evidence.

## Article 70

### (Procedure for the Revocation of a Decision on the Grant of a Trademark)

- (1) Procedure for the declaration of a decision on the grant of a trademark null and void shall be initiated by a written Proposal for the Declaration of a Decision on the Grant of a Trademark Null and Void.
- (2) The contents of the proposal referred to in paragraph (1) of this Article, as well as attachments to accompany the proposal, shall be regulated by the implementing regulation.
- (3) A proposal for the declaration of a decision on the grant of a trademark null and void shall be correct if it contains the prescribed indications.
- (4) If a proposal for the declaration of a decision on the grant of a trademark null and void is not correct, the Institute shall invite the person filing a proposal to correct it within a period of 30 days from the day of receipt of the invitation.
- (5) At a reasoned request of the person filing a proposal, and subject to payment of the fee and procedural charges, the Institute shall extend the time limit referred to in paragraph (4) of this

Article for a period which it considers it to be appropriate, but which shall neither be less than 15 days nor more than 60 days.

(6) If the person filing the proposal fails to comply with the invitation within the time limit referred to in paragraph (4) of this Article, the Institute shall reject the proposal by a conclusion.

(7) The Institute shall send a correct proposal to the holder of a trademark, and shall invite him to submit his response within a period of 30 days from the day of receipt of the invitation.

(8) At a reasoned request of the holder of a trademark, and subject to payment of the fee and procedural charges, the Institute shall extend the time limit referred to in paragraph (7) of this Article for a period which it considers it to be appropriate, but which shall not be less than 15 days, and not more than 60 days.

(9) If the holder of a trademark fails to respond to the proposal for the declaration of the decision on the grant of a trademark null and void within the specified time limit, the Institute shall declare the trademark invalid in respect of those goods or services as are indicated in the proposal.

(10) The Institute may order oral proceedings concerning a proposal for the declaration of the decision on the grant of a trademark null and void if it considers it to be necessary.

(11) After the procedure as carried out concerning the proposal for the declaration of the decision on the grant of a trademark null and void on the basis of the proposal referred to in Article 69 paragraph (1) of this Law, the Institute may issue, at any time, a decision on the declaration of the decision on the grant of a trademark null and void in whole or in respect of some of the goods or services, or a decision on the refusal of the proposal.

(12) The Institute shall publish in the official gazette a decision on the declaration of a decision on the grant of a trademark null and void which has become final in the administrative procedure.

## **PART NINE - SPECIAL CASES OF THE TERMINATION OF A TRADEMARK**

### Article 71

#### (Termination of a Trademark Due to Non-Use)

(1) At a request of an interested person, the Institute shall issue a decision on the termination of a trademark in whole or in respect of some of the goods or services if the holder of the trademark or the person authorized by him has not seriously used, without justified reasons, the trademark in Bosnia and Herzegovina to designate the goods or services to which such a trademark relates for an uninterrupted period of five years, counting from the day of entry of the trademark in the Register of Trademarks or from the day on which the trademark was used for the last time.

(2) In the procedure concerning a request for the termination of a trademark due to non-use, the holder of the trademark or the person authorized by him shall prove that they have used the trademark.

(3) The use of a trademark within the meaning of paragraph (1) of this Article shall also be considered to be the use of a sign protected by a trademark in the form which differs in

elements not changing the distinctive character of the sign, as well as the use of the protected sign on the goods or on the packaging of the goods intended exclusively for exportation.

(4) The justified reasons for the non-use of a trademark referred to in paragraph (1) of this Article shall be considered to be a situation occurring independently of the will of the trademark holder and impeding the use of the trademark, such as a decision issued by the State authority, a prohibition of importation or exportation or any other prohibition relating to the goods or services for which protection by trademark has been granted.

(5) Advertising of the protected sign without the possibility of purchasing the goods, or using the services in respect of which the sign is protected shall not be considered as the use of a trademark.

(6) The Institute shall not issue a decision on the termination of a trademark due to non-use if the use of the trademark has commenced or has been resumed after the expiration of an uninterrupted period of five years in which the trademark was not used, and before the filing of the request for the termination of a trademark due to non-use, unless the commencement or resumption of the use of the trademark occurred after the holder of the right learned that a request for the termination of his trademark would be filed and if the use had begun or had been resumed within a period of three months before the filing of the request for the termination of the trademark.

#### Article 72

##### (Determination of the Date of Termination of a Trademark Due to Non-Use)

In the case referred to in Article 71 of this Law, a trademark shall be terminated upon expiration of the period of five years from the day on which the trademark was used for the last time, or upon expiration of the period of five years from the day on which it was registered, if the trademark has not been used.

#### Article 73

##### (Termination of a Trademark in Other Cases)

(1) The Institute shall also, at a request of an interested person, issue a decision on the termination of a trademark in whole or only in respect of some of the goods or services, in the following cases:

a) if a sign protected by a trademark has, due to activity or inactivity of the holder of the trademark or his legal successor, become a generic name of the goods or services, respectively, for which it has been registered;

b) if a sign protected by a trademark, due to the manner in which it is used by the holder of the trademark or his successor in title, may create confusion in the course of trade with respect to its geographical origin, kind, quality, or other characteristics of the goods or services;

c) if a sign protected by a trademark has become contrary to the morality or public order.

(2) The right of use of a collective trademark and a guarantee trademark may also be terminated if a collective trademark and a guarantee trademark are used contrary to the general act on the collective trademark or the general act on the guarantee trademark.

(3) In the case referred to in paragraphs (1) and (2) of this Article, a trademark shall be terminated on the day following the day on which a decision on the termination of a trademark has become final.

#### Article 74

##### (Procedure concerning a Request for the Termination of a Trademark)

(1) The procedure for the termination of a trademark due to the reasons referred to in Articles 71 and 73 of this Law shall be initiated by a written request.

(2) The content of the request referred to in paragraph (1) of this Article, as well as the attachments to the request shall be regulated by the implementing regulation.

(3) A request for the termination of a trademark shall be correct if it contains prescribed indications.

(4) If a request for the termination of a trademark is not correct, the Institute shall invite the person filing the request to correct it within a period of 30 days from the day of receipt of the invitation.

(5) At a reasoned request of the person filing the request, and subject to payment of the fee and procedural charges, the Institute shall extend the time limit referred to in paragraph (4) of this Article for a period which it considers it to be appropriate, but which shall neither be less than 15 days nor more than 60 days.

(6) If the person filing a request for the termination of a trademark fails to comply with the invitation within the time limit referred to in paragraph (4) of this Article, the Institute shall reject the request by a conclusion.

(7) The Institute shall send a correct request to the holder of a trademark, and shall invite him to submit his response within a period of 30 days from the day of receipt of the invitation.

(8) At a reasoned request of the holder of a trademark, and subject to payment of the fee and procedural charges, the Institute shall extend the time limit referred to in paragraph (7) of this Article for a period which it considers it to be appropriate, but which shall neither be less than 15 days nor more than 60 days.

(9) If the holder of a trademark fails to respond to a request for the termination of a trademark within the specified time limit, the Institute shall issue a decision on the termination of a trademark in respect of those goods or services as are indicated in the request as filed.

(10) The Institute may order oral proceedings concerning a request for the termination of a trademark if it considers it to be necessary.

(11) After the procedure as carried out concerning a request for the termination of a trademark, the Institute shall issue a decision on the termination of a trademark in whole or in respect of some of the goods or services or a decision on the refusal of the request.

(12) The Institute shall publish the decision on the termination of a trademark, which has become final in the administrative procedure, in the official gazette.



Article 75  
(Effect on the Final Court Decision)

The declaration of a trademark invalid and the termination thereof shall not affect court decisions relating to the establishment of infringements of rights, which have been final at the time of issue of such a decision, as well as the contracts of the transfer of rights or licensing contracts, as concluded, if, and to extent to which such contracts have been executed, provided that the plaintiff or the holder of a trademark acted in good faith.

**PART TEN - APPELLATE PROCEDURE**

Article 76  
(Right of Appeal)

(1) Any party entirely or partially adversely affected by the decisions of the Institute issued in the first instance shall have the right to file an appeal within a period of 15 days from the day of receipt of the decision.

(2) Other parties to the procedure which was ended by a decision that can be appealed shall be considered to be parties to the appeal procedure.

Article 77  
(Content of an Appeal)

In addition to the indications which shall be contained in any submission, an appeal shall contain:

- a) an indication of the administrative decision appealed,
- b) a statement to the effect whether the administrative decision is contested in whole or in part,
- c) the grounds for appeal,
- d) the explanation of appeal with all evidence supporting the appellant's allegations contained in the appeal,
- e) the signature of the appellant,
- f) a power of attorney, if the appeal is filed through a representative.

Article 78  
(Board of Appeal)

(1) The Board of Appeal shall be established as an independent body, responsible to decide on appeals in accordance with the provisions of this Law.

(2) The Board of Appeal shall be composed of three members, one of whom shall be the Chairman of the Appellate Board, and three alternate members, one of whom shall be Deputy Chairman.

(3) The members of the Board of Appeal shall be appointed by the Council of Ministers of Bosnia and Herzegovina (hereinafter referred to as Council of Ministers of BiH) from among the independent experts in the field of industrial property law and civil servants from among the employees of the Institute, in the manner as regulated by the Decision of the Council of Ministers of BiH.

(4) The seat of the Board of Appeal shall be at the Institute.

(5) The Institute shall provide the Board of Appeal with necessary premises and equipment, and shall perform the clerical and administrative tasks for it.

(6) The Board of Appeal shall have its own seal.

(7) The Chairman of the Board of Appeal shall administer the work thereof.

(8) In the case of absence, the Chairman of the Board of Appeal shall be replaced by the Deputy Chairman, and a member of the Board of Appeal shall be, in his absence, replaced by an alternate member of the Board of Appeal.

(9) The Chairman and the members of the Board of Appeal shall be independent in their work, not bound by any instructions of the Director of the Institute, and shall perform their tasks impartially, in accordance with the law and professional standards.

(10) The Chairman and the members of the Board of Appeal shall have the status of independent experts, and shall receive compensation for their respective services on the Board of Appeal in accordance with the implementing regulation on compensations for the service on the Board of Appeal.

(11) The members of the Board of Appeal and alternate members, who have participated in decision making in the first instance procedure, or where other reasons for their exclusion exist, shall not participate in the appellate procedure concerning the case concerned.

(12) The Board of Appeal shall enact its Rules of Procedure regulating the details concerning its work.

#### Article 79 (Deciding on an Appeal)

(1) The Board of Appeal shall decide on appeals as filed in sessions, by majority vote.

(2) The Board of Appeal shall decide on the basis of submissions filed by the parties, and when it considers it necessary, it may order oral proceedings.

(3) The provisions of Articles 26, 37 and 70 of this Law shall apply *mutatis mutandis* to the procedure of deciding on an appeal.

### **PART ELEVEN - CIVIL PROTECTION**

Article 80  
(Claims)

(1) In the case of infringement of a trademark or the rights conferred by a trademark application, where the trademark is granted, the plaintiff may claim in an action:

- a) establishment of the infringement of rights;
- b) prohibition of the continuation of infringement as committed, and of future similar infringements by means of cessation or omission of acts which are infringing such right;
- c) termination of situation caused by infringement;
- d) recall of infringing objects from the channels of commerce, respecting the interests of third parties acting in good faith;
- e) complete removal of infringing objects from channels of commerce;
- f) destruction of infringing objects;
- g) destruction of means which are exclusively or predominantly intended or used for infringing acts, and which are owned by the infringer;
- h) surrender of infringing objects to the right holder, along with reimbursement of production costs;
- i) compensation for property damage and reimbursement of reasonable expenses of the proceedings;
- j) publication of court's judgment at the expense of the defendant.

(2) When deciding on claims referred to in paragraph (1) items c), d), e), f), g) and h) of this Article, the court shall take into account all the circumstances of the case, in particular, proportionality between severity of infringement and the claim, as well as best interest of authorized person for ensuring effective protection of rights.

(3) In the proceedings against persons whose services were used for infringement of rights, and provided that the infringement had already been established in the proceedings against third party, the infringement shall be presumed to exist.

(4) The procedure concerning the action referred to in paragraph (1) of this Article shall be expeditious.

Article 81  
(Infringement of a Trademark)

(1) Any unauthorized use of a protected sign within the meaning of Article 49 of this Law shall be considered as infringement of a trademark or the rights conferred by the application, if the trademark is subsequently granted.

(2) Imitation, transcription and transliteration of a protected sign shall also be considered as the infringement referred to in paragraph (1) of this Article.

(3) The infringement referred to in paragraph (1) of this Article shall also be considered to be the addition to a sign of the words “type”, “manner”, “according to procedure”, and the like.

Article 82  
(Indemnification)

(1) General rules governing indemnification and liability for damages shall apply to all infringements of rights under this Law, unless otherwise provided by this Law.

(2) Trademark infringer shall indemnify the right holder in an amount determined pursuant to general rules governing indemnification or in the amount equivalent to the agreed or customary remuneration for the lawful use of a trademark.

Article 83  
(Penalty)

(1) If trademark is infringed intentionally or by gross negligence, a trademark holder may claim indemnification against the infringer up to the treble amount of the stipulated remuneration, and if the remuneration has not been agreed upon, of the appropriate usual license remuneration that would be obtained for the use of a trademark.

(2) When deciding the claim for the payment of penalty, the court shall take into account all circumstances of the case, in particular the extent of the incurred damage, the degree of guilt of the infringer, the amount of the stipulated or usual license remuneration, and preventive purpose of the penalty.

(3) If the incurred damage is in excess of the amount of penalty referred to in paragraph (1) of this Article, the right holder is entitled to claim the difference up to the amount of full indemnification.

Article 84  
(Right of Action)

(1) An action for the infringement of a trademark, or the rights conferred by the application, may be brought by the holder of the trademark, the applicant, the holder of the exclusive license, the user of a collective trademark with the consent of the holder of the collective trademark and the user of a guarantee trademark with the consent of the holder of the guarantee trademark.

(2) The court shall suspend the proceedings concerning an action for the infringement of rights conferred by the application up to the final decision concerning the application as filed issued by the Institute.

(3) If the procedure referred to in Article 69 or 73 of this Law has been initiated before the Institute or the court, the court dealing with the action referred to in Article 79 of this Law shall suspend the proceedings up to the final decision issued by the Institute or the court.

Article 85

### (Time Limit for Bringing an Action)

An action for the infringement of a trademark, or for the infringement of rights conferred by an application, may be brought within a period of three years from the day on which the plaintiff learned of the infringement and the infringer, and not later than within five years from the day on which the infringement was committed for the first time.

### Article 86 (Provisional Measures)

(1) The court shall order a provisional measure to secure claims under the provisions of this Law, if the applicant demonstrates as probable:

- a) that he is the right holder under this Law, and
- b) that his right has been infringed or that there is an actual threat of infringement.

(2) The right holder shall also demonstrate as probable one of the following assumptions:

- a) danger that the enforcement of claim will be made impossible or considerably more difficult;
- b) that provisional measure is necessary in order to prevent damage which will be difficult to repair later, or
- c) that the adoption of provisional measure, which would later in the course of the proceedings prove to be unfounded, would not have more detrimental consequences for the alleged infringer, than the non-adoption of such provisional measure would have for the right holder.

(3) The right holder who applies for provisional measure to be brought without prior notification and hearing of the opposing party shall demonstrate as probable, in addition to requirements under paragraphs (1) and (2) of this Article that any delay in bringing provisional measure would cause to the right holder damage difficult to repair.

(4) Where provisional measure has been brought under provisions of paragraph (3) of this Article, the court shall serve the decision on a provisional measure to the opposite party immediately after the execution thereof.

(5) The right holder shall not have to prove the existence of a danger that the enforcement of claim will be made impossible, or considerably difficult, if he shows probable grounds for belief that the proposed provisional measure will cause only insignificant damage to the alleged infringer.

(6) The danger shall be deemed to exist when the claims are to be enforced abroad.

(7) To secure claims under paragraph (1) of this Article, the court may order any provisional measure with which the purpose of security can be achieved, but it may in particular:

a) prohibit the alleged infringer to proceed with actions which infringe the right under this Law;

b) to seize, remove from circulation and take into custody the objects of infringement and the means of infringement, which are exclusively or predominantly intended or used for committing infringements.

(8) If the measure was ordered before the filing of the claim, the court shall in its order specify a time limit within which the claimant must bring an action for the justification of this measure.

(9) The time limit referred to in paragraph (8) of this Article shall not be longer than 20 working days or 31 calendar days from the day of delivery of the decision to the applicant, depending on which expires later.

(10) The court shall decide on the opposition against the order of a provisional measure within 30 days following the filing of the answer to the opposition or the expiry of the time limit for the filing of such answer.

(11) The procedure concerning the ordering of a provisional measure shall be expeditious.

#### Article 87 (Preservation of Evidence)

(1) The court shall issue an order to preserve evidence if the applicant presents to the court reasonable grounds that:

a) he is the right holder under this Law;

b) his right has been infringed or that there is an actual threat of infringement;

c) the evidence of such infringement shall be destroyed or that it shall be impossible to present it later.

(2) The right holder requesting an order to be brought on preservation of evidence without prior notification and hearing of the opposite party shall, in addition to the requirements under paragraph (1) of this Article, demonstrate as probable that there is a danger that the evidence of infringement shall be destroyed, or impossible to present later, due to the acts of the opposite party.

(3) In the case of ordering the preservation of evidence pursuant to provisions of paragraph (2) of this Article, the court shall serve its order for the preservation to the opposite party immediately after the evidence has been presented.

(4) The court may issue an order, as referred to in paragraph (1) of this Article, for any evidence to be presented, and in particular:

a) inspection of premises, business records, inventory, databases, computer memory units and other objects;

b) seizure of samples of the objects of infringement;

- c) examination and surrender of documents;
- d) appointment and examination of experts;
- e) hearing of witnesses.

(5) The preservation of evidence may also be sought after the completion of proceedings by a final decision if it is necessary for the institution of proceedings on the grounds of extraordinary remedies, or during such proceedings.

(6) In the proceedings for preservation of evidence, according to provisions of this Article, respective provisions of the law on civil procedure pertaining to provisional measures shall be applied, unless otherwise stipulated by this Law.

(7) The proceedings for preservation of evidence shall be expeditious.

(8) Where subsequently found that the claim for preservation of evidence is unjustified, or if the right holder does not justify such claim, the opposite party may request:

- a) return of seized objects;
- b) prohibition of the use of information obtained;
- c) indemnification.

(9) In the proceedings for the preservation of evidence, under the provisions of this Article, the court shall ensure the protection of confidential information pertaining to the parties, and take care that the court proceedings are not abused solely for the purpose of obtaining confidential information of the opposite party.

#### Article 88 (Obligation to Furnish Information)

(1) During lawsuit in the matter of infringement of a right under this Law, and on the basis of the justified claim of one of the parties, the court may order the infringer of a right to provide information on the source and distribution channels of the goods or services infringing the right under this Law.

(2) The court may order that the information referred to in paragraph (1) of this Article be provided to the court also by persons who, within the scope of commercial activity:

- a) possess the goods presumed to infringe the right under this Law;
- b) use the services presumed to infringe the right under this Law; or
- c) render the services presumed to infringe the right under this Law.

(3) It shall be considered that an act has been carried out on a commercial scale if carried out for direct or indirect economic benefit.

(4) The notion of activity on a commercial scale does not include the acts of bona fide end-users.

(5) The court may order that the information referred to in paragraph (1) of this Article is provided to the court also by the person indicated by any of the persons referred to in paragraph (2) of this Article as involved in manufacturing, making and distribution of goods or rendering services presumed to infringe the right under this Law.

(6) The information requested on the grounds of paragraph (1) of this Article may include, in particular:

a) name, address or company name and registered office of the manufacturer, maker, distributor, supplier and other former possessors of goods, or service providers, as well as intended wholesalers and retailers;

b) information on the quantities of manufactured, made, delivered, received, or ordered goods or services, as well as the prices obtained for the goods and services concerned.

#### Article 89 (Presentation of Evidence)

(1) Where the court decides to allow the proposed evidence held by the opposite party to be presented, that party shall surrender such evidence at the request of the court.

(2) Paragraph (1) of this Article pertains also to banking, financial and business documents controlled by the opposite party if the infringement was committed on a commercial scale.

(3) The respective provisions of the law regulating civil procedure shall apply in the procedure for the presentation of evidence, unless otherwise stipulated by this Law.

(4) Following the presentation of evidence, the court shall, according to paragraph (1) of this Article, ensure the protection of confidential information pertaining to the parties, and take care that judicial proceedings are not abused solely with the intention to obtain confidential information of the opposite party.

#### Article 90 (Security Instrument for the Opposing Party)

At the request of the person against whom a procedure for ordering a provisional measure or preservation of evidence has been initiated, the court may order that certain amount of money be deposited by the applicant as a security instrument in the case of an unfounded claim.

#### Article 91 (Challenge of a Trademark)

(1) If the application was filed contrary to the principle of bona fide or if a sign was registered on the basis of such an application or on the basis of an application in breach of legal or contractual obligation, the person whose legal interest has been infringed thereby may request from the court to declare him the applicant or the right holder.



(2) If the claim referred to in paragraph (1) of this Article is upheld in a court decision, the Institute shall, after the receipt of the court decision or at the request of the plaintiff, enter the plaintiff in the respective register of the Institute as the applicant or the holder of a trademark, and shall publish the data on that in the official gazette.

#### Article 92

(Challenge of a Well-Known Trademark Referred to in Article 6*bis* of the Paris Convention)

(1) Natural or legal person using in the course of trade a sign to designate goods or services, for which another person has filed an application or has registered it in his name to designate identical or similar goods, or services, may request the court to declare him the applicant or the right holder, provided that he proves that such a sign has been well-known within the meaning of Article 6*bis* of the Paris Convention for the Protection of Industrial Property as designating his goods or services, before the defendant has filed the application.

(2) If the defendant proves that he has used identical or similar sign to designate identical or similar goods or services in the course of trade, as long as the plaintiff or longer than him, the court shall refuse the claim referred to in paragraph (1) of this Article.

(3) An action referred to in paragraph (1) of this Article shall not be brought after the expiration of the period of five years from the day of entry of a trademark in the Register of Trademarks.

(4) If the claim referred to in paragraph (1) of this Article is upheld in a court decision, the Institute shall, upon receipt of the judgment or at the request of the plaintiff, enter the plaintiff in the respective register as the applicant or the holder of the trademark, and shall publish the data concerning that in the official gazette.

#### Article 93

(Right to a Challenged Trademark Acquired by Third Person)

The right acquired by a third party from the former applicant or the holder of a trademark, referred to in articles 90 and 91 of this Law, shall be terminated on the day of entry of the new applicant or the new trademark holder in the respective register of the Institute.

## **PART TWELVE - CUSTOMS MEASURES**

#### Article 94

(Request Filed by the Right Holder)

(1) The holder of exclusive rights under this Law, who reasonably believes that the importation, transit or export of goods manufactured in contravention of the provisions of this Law shall take place, may apply for protection of his rights with the authority competent for customs matters (hereinafter: the customs authority) by means of customs measures of temporary impounding of the goods.

(2) The application for the protection of rights under paragraph (1) of this Article must contain:

- a) details of the applicant and the holder of the exclusive right under this Law, if they are not the same persons;

- b) detailed description of the goods enabling its identification;
- c) proof that the applicant or a person authorized by him is the holder of the exclusive right under this Law in connection with such goods;
- d) proof that the exclusive right is likely to have been infringed;
- e) other details held by the applicant relevant for deciding on the application, such as details of the location of the goods and the destination thereof, expected date of arrival or dispatch of the package, details of the means of transportation, details of the importer, exporter or recipient, and the like.
- f) time frame within which customs authorities shall comply with the application which may not be longer than two years from the date of its filing.

(3) The customs authority may, before issuing its decision upholding the application referred to in paragraph (1) of this Article, request the right holder to deposit a security instrument for the costs of the storage and transportation of the goods, as well as for the compensation for damage, which may be incurred by the customs authorities in connection with the goods and by the party against which the application referred to in paragraph (1) of this Article is upheld.

(4) If the customs authority upholds the application referred to in paragraph (1) of this Article, it shall inform all customs outposts, and the right holder about it.

#### Article 95 (Procedure Following the Temporary Impounding of Goods)

(1) Where in the course of the customs procedure a customs outpost finds the goods matching the description of the goods indicated in the decision of the competent customs authority, it shall temporarily impound such goods.

(2) The decision on temporary impounding of the goods shall be delivered to its importer.

(3) It shall be specified in the decision referred to in paragraph (2) of this article that the owner of the goods, or person authorized to dispose of the goods, may make a statement, within ten working days from the date of temporary impounding, whether it is the case of counterfeit goods or another infringement of rights under this Law.

(4) Where the customs authority does not receive a written statement of the owner, or person authorized to dispose of the goods, within the period referred to in paragraph (3) of this Article, it may seize and destroy the goods at the request of the right holder, and at his expense.

(5) Where the owner of the goods, or person authorized to dispose of the goods, declares, within the period referred to in paragraph (3) of this Article, that the goods are not counterfeit and that there are no other infringements of rights under this Law, the right holder may, within ten working days from the receipt of the notification of such declaration, bring an action for the infringement of rights.

(6) Where particular circumstances of the case justify it, the customs authority may allow, at the request of the right holder, additional time for bringing an action referred to in paragraph (5) of this Article, which may not be longer than ten working days.

(7) During the temporary impounding, the right holder, or a person entitled by him, may carry out the inspection, and control of the goods and accompanying documents to the extent necessary for establishing his claims, and for the realization of judicial protection of his rights, ensuring at the same time the protection of confidential information.

(8) The importer shall also be entitled to carry out the inspection and control of the goods.

(9) If the right holder fails to bring an action referred to in paragraph (5) of this Article, temporarily impounded goods shall be released into the requested customs approved use, or circulation.

(10) If the right holder institutes judicial proceedings, the customs authority shall issue a decision on the seizure of goods until the issue of the final court decision.

#### Article 96 (Ex-Officio Procedure)

(1) Where a customs outpost reasonably believes, during the customs procedure in connection with the importation, transit or export of the goods, that the rights under this Law are infringed by certain goods, it shall temporarily impound such goods and inform the customs authority about it.

(2) The customs authority shall inform the right holder in writing about the goods impounded, the suspicion that his rights are infringed, and the possibility of filing the application under Article 94 of this Law, within five working days from the date of impounding.

(3) Where the right holder files the application in accordance with paragraph (2) of this Article, the goods shall be impounded until customs authority reaches its decision.

(4) If the customs authority upholds the application referred to in Article 94 of this Law, the goods shall be temporarily impounded for another ten working days.

(5) The right holder must carry out the actions specified in Article 95 paragraph (7) of this Law, within a time limit referred to in paragraph (4) of this Article.

(6) The provisions of Articles 95 and 96 of this Law shall not apply to importation, transit or exportation of small quantities of goods intended for private and non-commercial use, which are brought into or taken out of the country as part of traveler's personal luggage or sent in small consignments.

#### Article 97 (Application of Other Customs Regulations)

(1) Other customs regulations shall apply *mutatis mutandis* to the customs procedure in connection with the goods infringing the rights under this Law.

(2) The regulations governing more closely the implementation of customs measures from this part of the Law shall be brought by the Council of Ministers of BiH, upon the motion of the Indirect Taxation Authority of Bosnia and Herzegovina.

(3) Customs procedure in connection with the goods infringing the rights under this Law shall be expeditious.

## **PART THIRTEEN - MISDEMEANOUR PROVISIONS**

### **Article 98 (Misdemeanors)**

(1) A legal entity shall be punished for misdemeanor by a fine in the amount from KM 5.000 to KM 200.000, and an entrepreneur shall be punished for misdemeanor by a fine in the amount from KM 5.000 to KM 20.000 who infringe a trademark or the right conferred by the application in the manner referred to in Article 81 of this Law.

(2) A responsible person in a legal entity or employed by an entrepreneur shall also be punished for the misdemeanor referred to in paragraph (1) of this Article by a fine amounting from KM 3.000 to 20.000.

(3) A natural person shall be punished for the misdemeanor referred to in paragraph (1) of this Article by a fine amounting from KM 3.000 to KM 10.000.

(4) The objects resulting from the commitment of the misdemeanor referred to in paragraph (1) of this Article shall be seized and destroyed, whereas the objects or devices intended for or used for the commitment of such misdemeanors shall be seized.

(5) The misdemeanor procedure based on the provisions of this Article shall be expeditious.

### **Article 99 (Protective Measure)**

(1) A legal entity and an entrepreneur, who commit misdemeanors referred to in paragraph (1) of Article 98 of this Law in the course of their business activities, may be imposed a protective measure involving the prohibition of business activities or part thereof, infringing a trademark, for a period of one year, if the misdemeanor committed is exceptionally grave regarding the manner in which it was committed, the consequences of the act or other circumstances of the misdemeanor as committed.

(2) A legal entity and an entrepreneur who repeat the commission of the misdemeanor referred to in paragraph (1) of Article 98 of this Law shall be imposed a protective measure involving the prohibition of business activities or part thereof, infringing a trademark, for a period of at least one year.

### **Article 100 (Inspectional Control in Relation to Misdemeanors)**

(1) Inspectional control in relation to misdemeanors sanctioned under Article 98 of this Law shall be carried out by the inspection office in charge of the market control in the Federation of Bosnia and Herzegovina, the Republika Srpska and the Brčko District of Bosnia and Herzegovina.

(2) The inspection procedure shall be expeditious.

## **PART FOURTEEN - TRANSITIONAL AND FINAL PROVISIONS**

### Article 101

(Rights Granted Before the Application of This Law and Implementing Regulations for the Enforcement of This Law)

(1) Registered trademarks that are valid on the day on which this Law enters into force shall remain valid and the provisions of this Law shall apply to them.

(2) The director of the Institute shall bring the implementing regulations for the implementation of this Law within six months from the day on which this Law shall enter into force, with the exception of the regulations referred to in Article 14 of this Law.

(3) Implementing regulations within the meaning of paragraph (2) of this Article are: Regulations on the Procedure for the Grant of a Trademark, Decision on Special Costs of the Procedure for Acquiring and Maintaining Industrial Property Rights, Decision on the Conditions for the Entry in the Registers of Representatives for the Protection of Industrial Property, Regulations on the Professional Examination for Industrial Property Protection Representatives and the Decision on the Compensation for the Service on the Board of Appeal.

### Article 102

(Application of International Treaties)

The provisions of international treaties in relation to trademarks, which Bosnia and Herzegovina acceded to, shall apply to subject-matters treated by this Law and in the case of conflict with the provisions of this Law, the provisions of international treaties shall apply.

### Article 103

(Cessation of Validity of Other Regulations and Pending Procedures for the Grant of Trademarks)

(1) By the commencement of application of this Law, the provisions of Chapter II – TYPES OF INDUSTRIAL PROPERTY RIGHTS Section 2 Trademark (Articles 69 to 96) of the Law on Industrial Property in Bosnia and Herzegovina (“Official Gazette of Bosnia and Herzegovina”, volumes 3/02 and 29/02), as well as the provisions which may be applied to trademarks accordingly, shall cease to have effect.

(2) By way of derogation from the provision of paragraph (1) of this Article, the Law on Industrial Property in Bosnia and Herzegovina shall continue to apply to all the administrative procedures relating to trademarks that are not completed up to the day of the commencement of the application of this Law.

### Article 104

(Unified Application of the Provisions on the Board of Appeal in the Patent Law, Law on the Protection of Indications of Geographical Origin and the Law on Industrial Designs)

The provisions of articles 78 and 79 of this Law and appropriate provisions of the Patent Law, Law on the Protection of Indications of Geographical Origin and the Law on Industrial Designs,

governing the Institute's Board of Appeal, shall be applied in a manner that one board of appeal shall be established.

Article 105  
(Entering into force and application of the Law)

This Law shall enter into force on the eighth day following the day of its publication in the "Official Gazette of Bosnia and Herzegovina" and shall be applied as of January 1, 2011.

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Parliamentary Assembly of Bosnia and Herzegovina, No. 522/10  
May 28, 2010  
Sarajevo

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Speaker  
House of Representatives  
Parliamentary Assembly of Bosnia and Herzegovina  
**Dr Milorad Živković**, signed

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Speaker  
House of Peoples  
Parliamentary Assembly of Bosnia and Herzegovina  
**Sulejman Tihić**, signed