

506/2009 Coll. of Laws of the Slovak Rep.

ACT

of October 28, 2009

on Trade marks

Amendment: 125/2016 Coll. of Laws of the Slovak Rep.
Amendment: 242/2017 Coll. of Laws of the Slovak Rep.
Amendment: 242/2017 Coll. of Laws of the Slovak Rep.
Amendment: 291/2018 Coll. of Laws of the Slovak Rep.

The National Council of the Slovak Republic has adopted the following Act:

PART ONE

BASIC PROVISIONS

§ 1

Subject-matter of regulation

This Act governs the rights and obligations relating to legal protection of trade marks and proceedings in trade mark matters before the Industrial Property Office of the Slovak Republic (hereinafter referred to as the "Office").

§ 2

Sign that may constitute a trade mark

A trade mark may consist of any sign, in particular words, including personal names, designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such sign is capable of

- (a) distinguishing the goods or services of one person from the goods or services of another person and
- (b) being represented in the trade mark register of the Industrial Property Office of the Slovak Republic (hereinafter referred to as the "Register") in a manner which enables the competent authorities and the public to determine the clear and precise subject-matter of the protection afforded to the trade mark proprietor.

§ 3

For the purposes of this Act

- (a) an international trade mark¹) shall mean a trade mark entered in the Trade Mark Register of the International Bureau of the World Intellectual Property Office (hereinafter referred to as "International Register"),
- (b) a European Union trade mark²) (hereinafter referred to as "EU trade mark") shall mean a trade mark entered in the European Union Trade Marks Register (hereinafter referred to as "EU Register"),
- (c) well-known trade mark shall mean a trade mark pursuant to an international convention, 3)
- (d) repealed as of January 14, 2019.

§ 4

Earlier trade mark

For purposes of this Act, an earlier trade mark shall mean

- (a) a trade mark entered in the Register with an earlier priority right;
- (b) an international trade mark with effects in the Slovak Republic with an earlier priority right;
- (c) an EU Trade Mark with an earlier priority right or earlier seniority right; 6)
- (d) a sign that is the subject-matter of a trade mark application (hereinafter referred to as "application"), if it is entered as a trade mark referred to in (a) or (c).

Grounds for refusal of the entry of a sign into the Register

§ 5

(1) A sign shall not be entered in the Register if

- (a) it cannot form a trade mark pursuant to section 2,
- (b) it is devoid of any distinctive character,
- (c) it consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) it consists exclusively of signs or indications which have become customary in the current language or in bona fide and established practices of trade,
- (e) it consists exclusively of the shape, or another characteristic, of a product which results from the nature of the product itself or which is necessary to obtain a technical result, or which gives substantial value to the product,
- (f) it is contrary to "order public" or to accepted principles of morality,
- (g) it may deceive the public in particular as to the nature, quality, geographical origin of goods or services,
- (h) it contains signs protected in accordance with an international convention 7) without the consent of competent authorities,
- (i) its use would be contrary to a special piece of legislation or to obligations resulting for the Slovak Republic or the European

Union from international treaties, providing in particular for the protection of designations of origin and geographical indications, traditional terms for wines and traditional specialties guaranteed, 7a)
(j) it includes a sign of high symbolic value, in particular a religious symbol,
(k) it includes badges, emblems or escutcheons other than those covered by an international convention ⁷⁾, without the consent of the competent authorities,⁹⁾ and which are of public interest,
(l) it is the subject-matter of an application not filed in good faith,
(m) it consists of, or reproduces in its essential elements, an earlier plant variety denomination registered in accordance with a special piece of legislation or an international treaty to which the Slovak Republic or the European Union is party, providing protection for plant variety rights ^{8a)}, and if it is in respect of plant varieties of the same or closely related species.

(2) The sign stated in subsection (1)(b) to (d) shall be entered into the Register if the applicant proves that, before the date of filing the application, the sign has become distinctive in relation to goods or services, for which registration is requested, in consequence of the use which has been made of it within the territory of the Slovak Republic or in relation to the territory of the Slovak Republic.

§ 6

Repealed as of January 1, 2019

§ 7

A sign shall not be entered into the Register on the basis of oppositions against the entry of the sign into the Register (hereinafter referred to as "oppositions") filed pursuant to section 30

(a) by the proprietor of an earlier trade mark if

1. the sign is identical with an earlier trade mark and the application is for identical goods or services, or
2. because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of goods or services covered by the sign and the earlier trade mark there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trade mark;

(b) by the proprietor of an earlier trade mark, if because of identity of the sign with, or similarity to, the earlier trade mark, which has a reputation in the territory of the Slovak Republic or in the case of a EU trade mark has a reputation in the European Union, the use of such sign for goods or services, which are identical with, similar to or not similar to those for which the earlier trade mark is registered, without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;

(c) by the user of a well known trade mark, if the sign is identical with the well known trade mark which became well known by its use in the territory of the Slovak Republic or in relation to the territory of the Slovak Republic before the filing date of an application for such sign for such user, and goods or services, which are covered by the sign and well known trade mark, are identical;

(d) by the user of a well known trade mark, if because of identity of the sign with, or similarity to, the well known trade mark, which, before the filing date of the application for such sign, became well known by its use in the territory of the Slovak Republic or in relation to the territory of the Slovak Republic for such user, and identities or similarities of goods and services which are covered by the sign and well known trade mark, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the well known trade mark;

(e) by the proprietor of a trade mark, protected in a state or in relation to a state which is a party to the Paris Convention for the Protection of Industrial Property or a member of the World Trade Organization, ⁵⁾ if an applicant, who is or was an agent of the proprietor of that trade mark or is his representative on the basis of another legal relationship (hereinafter referred to as "agent"), requested the entry of the sign on his own behalf without the consent of its proprietor; this shall not apply if the agent had legitimate reasons for such action;

(f) by the user of a non-registered sign or the user of another sign used in the course of trade, if the right with respect to that sign arose prior to the application filing date and the sign is of more than only local significance, if because of identity of the sign, being applied for, with, or its similarity to, a non-registered sign or another sign used in the course of trade and identity or similarity of goods or services to which those signs are related there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the non-registered sign or with another sign used in the course of trade.

(g) by a natural person, if using of such sign would infringe his/her rights of privacy⁹⁾ or by the natural person entitled to set up a claim to a right of privacy;

(h) by the proprietor of an earlier industrial property right,¹⁰⁾ if use of such sign would infringe these rights;

(i) by the person whose rights to a copyright work would be infringed by the use of the sign, if such work was made prior to the filing date of the application;

(j) by a person whose rights are affected by an application which has not been filed in good faith.

PART TWO

RIGHTS CONFERRED BY A TRADE MARK

§ 7a

Trade mark proprietor

The proprietor of a trade mark is considered to be a legal entity or a natural person entered as the proprietor in the Register, unless a court decides otherwise.

§ 7b

Co-proprietorship of a trade mark

(1) Each of the co-proprietors of a trade mark has the right to use the trade mark, unless the co-proprietors of the trade mark agree otherwise. In case of unauthorized interference with the exclusive rights in accordance with section 8, each of the co-proprietors of the trade mark can assert claims in accordance with section 8a by a court action according to the Code of Contentious Civil Procedure or a motion in accordance with a special piece of legislation.^{10a)} As soon as the proceedings according to the previous sentence have started or have been finally ended, court actions according to the Code of Civil Procedure or motions in accordance with a special piece of legislation^{10a)} of other co-proprietors of the trade mark for the same claims from the same unauthorized interference are not permissible; this is without prejudice to the right of those co-proprietors of the trade mark to intervene

in the started proceedings on the plaintiff's side. Final decisions on claims in accordance with section 8a(1) issued on the basis of a court action of even just one co-proprietor of the trade mark are also binding for other co-proprietors of the trade mark; this does not affect the right of co-proprietors of the trade mark to assert claims in accordance with section 8a(2).

(2) Granting the right to use a trade mark to a third party requires the consent of all co-proprietors of the trade mark, unless the co-proprietors of the trade mark agree otherwise; this does not affect the right of a co-proprietor of the trade mark to disposals of his co-proprietorship share in accordance with sections 17, 18 and 21.

(3) An agreement on cancellation of the co-ownership of a trade mark and mutual settlement must be in writing, otherwise it is invalid. The agreement according to the first sentence acquires legal effects vis-à-vis third parties on the day of entry into the Register.

(4) If the co-proprietor of the trade mark has no legal successor, after the death or cessation of the existence of the co-proprietor of the trade mark, his share shall be transferred to the other co-proprietors of the trade mark in a proportion corresponding to their co-proprietor shares; this also applies if the co-proprietor of the trade mark gives up his share.

(5) Subsections 1 to 4 shall be applied mutatis mutandis to legal relationships between co-applicants.

(6) Provisions of the Civil Code on ownership in common,^{10b)} shall be applied mutatis mutandis to the legal relationships between co-proprietors of a trade mark, unless subsections 1 to 5 provide otherwise.

§ 7c

Use of a trade mark

(1) If, within five years following the date of the entry of a trade mark in the Register, the proprietor has not put the trade mark to genuine use in connection with the goods or services in respect of which it is registered, or if such use has been suspended for a continuous period of five years, the trade mark shall be subject to the consequences provided for in section 14a, section 32(4) and (5), section 34(1)(a) and section 37a(4) and (5); this does not apply if the trade mark proprietor has legitimate reasons for non-use of the trade mark.

(2) The following shall also constitute use of a trade mark within the meaning of subsection 1:

(a) use of the trade mark in a form differing from the form in which the trade mark was registered only in elements which do not alter its distinctive character; this also applies if the trade mark in the form as used is also registered as another trade mark for the same proprietor,

(b) affixing of the trade mark to goods or to the packaging thereof in the territory of the Slovak Republic concerned solely for export purposes.

(3) Use of a trade mark with the consent of the proprietor and use of a collective trade mark by a person authorized to use a collective trade mark pursuant to section 45(1) shall be considered to constitute use by the proprietor.

(4) Use of the EU trade mark shall be assessed according to a special piece of legislation.10ba)

(5) In the case of an international trade mark, for the purposes of subsection 1, the date of the entry shall be considered to be the date of granting protection to the international trade mark for the territory of the Slovak Republic.

§ 8

(1) The proprietor of a trade mark shall have an exclusive right to use the trade mark in relation to the goods or services, for which the trade mark is registered. The proprietor of a trade mark shall be entitled to use the sign ® with the trade mark.

(2) Unless section 14 to 15 provide otherwise and without prejudice to the rights acquired before the application filing date or the priority date of the trade mark, third parties must not, without the consent of the proprietor of the trade mark, use in the course of trade, in relation to goods or services, a sign

(a) identical with the trade mark for goods or services which are identical with those for which the trade mark is registered;

(b) if due to its identity or similarity with the trade mark and identity or similarity of goods or services, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the trade mark and the sign;

(c) identical with, or similar to, a trade mark having a reputation in the territory of the Slovak Republic, where use of that sign, in relation to goods or services which are identical with, similar to, or not similar to, those for which the trade mark is registered, without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

(3) The following, in particular, shall be considered use of a sign under subsection 2:

(a) affixing the sign to the goods or to the packaging thereof,

(b) offering the goods or putting them on the market, or stocking them for those purposes, under the sign, or offering or supplying services thereunder,

(c) importing or exporting the goods under the sign,

(d) using the sign on business correspondence and in advertising,

(e) using the sign as a trade name or legal entity name or part of a trade name or legal entity name,

(f) using the sign in comparative advertising in a manner that is contrary to a special piece of legislation. 10bb)

(4) Without prejudice to the rights acquired before the application filing date or the priority date of the trade mark, the proprietor of that trade mark shall also be entitled to prevent all third parties from bringing goods, in the course of trade, into the Slovak Republic, without being released for free circulation in the Slovak Republic, where such goods, including the packaging thereof, come from third countries and bear without authorization a sign which is identical with the trade mark registered in respect of such goods; this does not apply if, during the proceedings to determine whether an intellectual property right has been infringed, initiated in accordance with a special piece of legislation,^{10bc)} evidence is provided by the declarant or the holder of the goods that the proprietor of the trade mark is not entitled to prohibit the placing of the goods on the market in the country of final destination.

(5) If the reproduction of a trade mark in a dictionary, encyclopaedia or similar reference work, in print or electronic form, gives the impression that it constitutes the generic name of the goods or services, the publisher of the work may be requested by the proprietor of the trade mark to publish without delay, in the case of a work in printed form at the latest in the next edition of the work, data from which it is obvious that a trade mark is reproduced in the work.

(6) Where a trade mark is entered in the Register in the name of an agent of the proprietor of that trade mark, protected in a state or in relation to a state that is a party to the Paris Convention for the Protection of Industrial Property or a member of the World Trade Organization,⁵⁾ without the proprietor's consent, the latter shall be entitled to prohibit him from using that trade mark; this shall not apply where the agent had legitimate reasons for his action.

(7) Where the risk exists that the packaging, labels, tags, security or authenticity features or devices, or any other means to which the trade mark is affixed, could be used in relation to goods or services and that use would constitute an infringement of the rights of the proprietor of a trade mark under subsections (2) and (3), the proprietor of that trade mark shall

have the right to prohibit the following acts if carried out by third parties in the course of trade:

- (a) affixing a sign identical with, or similar to, the trade mark on packaging, labels, tags, security or authenticity features or devices, or any other means to which the trade mark may be affixed;
- (b) offering or placing on the market, or stocking for those purposes, or importing or exporting, packaging, labels, tags, security or authenticity features or devices, or any other means to which the sign is affixed.

§8a

(1) In the case of unauthorized interference with exclusive rights pursuant to section 8(1) and (2), the proprietor of a trade mark may demand, in particular, that the violation of the right or the endangering of the right be prohibited and the consequences of this interference be removed.

(2) If damage has been caused by interference with the rights pursuant to subsection 1, the proprietor of the trade mark has the right to compensation for the damage, including lost profit. If non-proprietary damage has been caused by interference with the rights pursuant to subsection 1, the proprietor of the trade mark has the right to adequate satisfaction, which may also be monetary performance.^{10c)} The right to the recovery of property obtained as a result of unjust enrichment as a result of interference with the rights under subsection 1 is not affected by this.

(3) The proprietor of the trade mark has rights pursuant to subsection 2 also as a result of interference pursuant to subsection 1 which occurred after the publication of the application; however, exercising these rights shall be possible only as from the date on which the effects of the entry of the trade mark begin.

(4) The right to compensation for damages or the right to adequate satisfaction in money pursuant to subsection 2 shall become time-barred three years from the date the proprietor of the trade mark becomes aware of the damage or non-proprietary damage and of who is responsible for it; when exercising the rights pursuant to subsection 3 there will be no time bar earlier than three years of the date on which the effects of the entry of the trade mark begin. At the latest, the right to compensation for damages or the right to adequate satisfaction in money pursuant to subsection 2 shall be time-barred five years, and in the case of damage or non-proprietary damage caused intentionally, ten years from the day when the rights pursuant to subsection 1 were interfered with, or from the date from which the effects of the entry of the trade mark take effect, whichever of these facts occurs later.

(5) The right to the recovery of property obtained as a result of unjust enrichment pursuant to subsection 2 shall become time-barred three years after the proprietor of the trade mark learns that unjust enrichment has occurred and who has enriched himself at his expense; when exercising the rights pursuant to subsection 3 the time bar shall not occur earlier than three years from the date on which the effects of the entry of the trade mark begin. At the latest, the right to the recovery of property obtained as a result of unjust enrichment pursuant to subsection 2 shall be time-barred five years, and in the case of intentional unjust enrichment, ten years from the date when the rights pursuant to subsection 1 have been interfered with or from the date from which the effects of the entry of the trade mark begin, whichever of these facts occurs later.

(6) Provisions of the Civil Code shall apply to legal relationships that have arisen as a result of the interference with rights pursuant to subsection 1, unless otherwise provided in subsections 1 to 5.

Heading repealed as of January 1, 2019

§ 9

Repealed as of January 14, 2019

§ 10

Repealed as of January 14, 2019

§ 11

Right to information

(1) In the case of unauthorized interference with the rights protected by this Act, the proprietor of a trade mark may request that the person who violates or endangers his rights provide him with information regarding the origin and distribution networks of goods or services and the circumstances of placing the goods or services on the market.

- (2) The information pursuant to subsection 1 shall contain in particular
- (a) the first and last name or business name, or name and permanent residence, or place of business, or registered office of the manufacturer, processor, storer, distributor, supplier, seller, intended seller and other previous holders of goods holders or service provider,
 - (b) data on the produced, processed, delivered or ordered quantity and the price of the respective goods or services.

(3) Any person who

- (a) possesses goods that violate or endanger rights pursuant to this Act,
- (b) uses services that violate or endanger rights pursuant to this Act,
- (c) provides services used in activities related to a violation or endangering of rights pursuant to this Act, or
- (d) has been designated by a person mentioned in paragraphs (a) to (c) as a person involved in the production, processing or distribution of products or the provision of services violating rights pursuant to this Act,

is obliged to provide information pursuant to subsections 1 and 2.

(4) The court shall not grant the right to provide information if the possible consequences of its exercise would be disproportionate to the seriousness of the consequences resulting from the fulfilment of the imposed obligation.

§ 12

Judicial protection of rights

- (1) Disputes concerning trade marks shall be discussed and decided by courts.^{10d)}
- (2) Upon motion of a proprietor of a trade mark, a court shall order that goods, materials or instruments through which a violation or endangering of rights protected by this Act directly occurs be
- (a) recalled from the channels of commerce,
 - (b) definitively removed from the channels of commerce,
 - (c) otherwise secured in a manner preventing further violations or endangering of a right; a simple removal of an unlawfully used

sign from counterfeited goods shall not be considered a means preventing further violation of a right,
(d) destroyed in an appropriate manner.

(3) Measures pursuant to subsection 2 shall be carried out at the expense of the person violating or endangering the rights protected by this Act, unless special circumstances justify a different procedure.

(4) The motion pursuant to subsection 2(d), in the part concerning the method of destruction, it is not binding on the court.

§ 13

Security on the part of the movant for a preliminary injunction

(1) In the resolution ordering a preliminary injunction,¹²⁾ a court may, even without a motion, impose on the movant the obligation to post monetary security in an adequate amount or make the enforceability of the preliminary injunction conditional on the posting of a monetary security. When deciding on the amount of the monetary security, the court shall take into account the extent of the damage or other loss that may be incurred by the adverse party when the preliminary injunction is carried out, as well as the movant's possibilities in terms of property; the imposition of the obligation to post security must not be a significant obstacle to an effective application of the law.

(2) A final legally awarded compensation for damages or other loss shall be satisfied from the posted security pursuant to subsection 1.^{12a)} The obligation to compensate for damage or other loss that has not been satisfied from this security shall not be affected by this.

(3) The court shall return the posted security pursuant to subsection 1 or its proportional part to the movant, if
(a) the injured party does not assert a claim for compensation for damages or other loss^{12a)} in court within six months from the date on which the injured party became aware of the occurrence of the damage or other loss, but no later than three years from the order of the preliminary injunction,
(b) an agreement of the parties on the use of monetary security has been presented to the court or
(c) the movant has succeeded, wholly or partially, in rem.

§ 14

Limitation of trade mark rights

1. A trade mark shall not entitle its proprietor to prohibit a third party from using, in the course of trade:
(a) the first name and last name or address of the third party, where that third party is a natural person;
(b) signs or indications which are not distinctive or which concern the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of goods or services;
(c) the trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark, in particular, where the use of the trade mark is necessary to indicate the intended purpose of a good or service, in particular as accessories or spare parts.

(2) Subsection 1 shall only apply where the third party uses the data under subsection 1 in accordance with trade usage, morality and the rules of business competition.

(3) The proprietor of a trade mark is obliged to suffer situations where a third party uses, in the course of trade, a sign of only local significance, the use of which started prior to the application filing date or prior to the priority right of the trade mark and the scope of the use of which has not changed.

§ 14a

Non-use of a trade mark as a procedural defense in trade mark infringement proceedings

(1) The proprietor of a trade mark shall be entitled to seek the prohibition of the use of a sign only to the extent that his rights are not liable to be revoked pursuant to section 34(1)(a) at the time of bringing the court action.

(2) At the request of the defendant, the proprietor of the trade mark shall furnish proof that, during the five-year period preceding the date of bringing the court action, the trade mark has been put to genuine use (section 7c) in connection with the goods or services in respect of which it is registered and which are cited as justification for the court action, or that there are legitimate reasons for non-use thereof, provided that at the date of bringing the court action at least five years have past since the entry of the trade mark.

§ 14b

Procedural defense of the proprietor of a later trade mark in trade mark infringement proceedings

(1) The proprietor of a trade mark shall not be entitled to seek the prohibition to use of a later trade mark if the later trade mark could not be declared invalid

a) because the conditions for declaring a trade mark invalid, which relate to the distinctive character of the trade mark, the increased distinctive character of the trade mark necessary for establishing the likelihood of confusion pursuant to section 7(a) point 2 or the reputation of the trade mark pursuant to 7(b), were not fulfilled on the application filing date or on the priority date of the later trade mark or

b) pursuant to section 35a(1) or section 37a(4).

(2) The proprietor of a trade mark shall not be entitled to seek the prohibition of the use of a later EU trade mark where that later trade mark would not be declared invalid pursuant to a special piece of legislation.^{12b)}

(3) Where the proprietor of a trade mark is not entitled to seek the prohibition of the use of a later trade mark pursuant to subsection 1 or 2, the proprietor of that later trade mark shall not be entitled to seek the prohibition of the use of the earlier trade mark in trade mark infringement proceedings, even though that earlier trade mark cannot longer be invoked against the later trade mark.

§ 15

Exhaustion of trade mark rights

(1) A trade mark shall not entitle its proprietor to prohibit its use by third parties in relation to goods which have been put on the market in a state being a contracting party to the Agreement on the European Economic Area under that trade mark by the proprietor of the trade mark or with his consent.

(2) Subsection 1 shall not apply where there exist legitimate reasons for the proprietor of the trade mark to oppose

further commercialization of the goods, especially where the condition of the goods is changed or impaired after they have been put on the market.

§ 16

Repealed as of January 14, 2019

§ 17

Trade mark assignment

(1) A trade mark can be assigned to another person for all goods and services for which the trade mark is registered or for some of them. The contract for the assignment of a trade mark must be in writing, otherwise it is invalid.

(2) The assignment of a trade mark shall acquire legal effects vis-à-vis third parties on the date of entry of the assignment in the Register. The rights of third parties acquired prior to the date of the entry of the assignment of the trade mark in the Register shall remain preserved. The entry of the assignment of a trade mark in the Register shall be carried out by the Office on the basis of a request, which any of the contracting parties is authorized to file. The Office shall refuse a request for the entry of the assignment of a trade mark unless the requester attaches documents proving the assignment of the trade mark to the request; before deciding on the refusal of the request for the entry of the assignment of the trade mark, the Office shall allow the requester to comment on the established reasons on the basis of which that request is supposed to be refused.

(3) The acquirer of the trade mark may perform acts towards the Office only after receiving the request for the entry of the assignment of the trade mark; this does not apply to filing a request pursuant to subsection 2 and filing a request for renewal of the registration of a trade mark pursuant to section 22(2).

(4) The Office shall refuse the request for entry of the assignment of a trade mark, if the assignment of the trade mark could be deceptive to the public on the nature, quality or geographical origin of the goods or services for which the trade mark is registered.

(5) If the assignment of the trade mark could be deceptive to the public pursuant to subsection 4 only for some goods or services for which the trade mark is registered, the Office shall refuse the request for the entry of the assignment of the trade mark only to the extent of those goods and services.

(6) Subsections 1 to 5 shall also be applied mutatis mutandis to the assignment of rights resulting from the application.

§ 18

Trade mark transfer

(1) A trade mark is transferred to a new proprietor in cases stipulated by a special piece of legislation.¹⁴⁾

(2) The transfer of a trade mark shall acquire legal effects vis-à-vis third parties on the date of entry of the transfer in the Register. The rights of third parties acquired prior to the date of the entry of the transfer of the trade mark in the Register shall remain preserved. The entry of the transfer of a trade mark in the Register shall be carried out by the Office on the basis of a request of its original proprietor or its new proprietor. The Office shall refuse a request for the entry of the transfer of a trade mark unless the requester attaches documents proving the transfer of the trade mark to the request; before deciding on the refusal of the request for the entry of the transfer of the trade mark, the Office shall allow the requester to comment on the established reasons on the basis of which that request is supposed to be refused.

(3) The new proprietor of the trade mark may perform acts towards the Office only after the request for the entry of the transfer of the trade mark has been delivered; this does not apply to request filings under subsection 2 and to the filing of a request for renewal of the registration of a trade mark pursuant to section 22(2).

(4) Subsections 1 to 3 shall also be applied mutatis mutandis to the transfer of rights resulting from the application.

§ 19

The proprietor of a trade mark protected in the state or in relation to the state which is a party to the Paris Convention for the Protection of Industrial Property or a member of the World Trade Organization,⁵⁾ may file a motion at a court for the determination of his right to the entry of a change of the proprietor of the trade mark, if the trade mark has been entered in the Register in the name of his agent. The court shall refuse the motion if the agent has a legitimate reason for his acts. On the basis of a final court decision, the Office shall enter the change of the proprietor of the trade mark.

§ 20

License contract

(1) The proprietor of a trade mark may grant another person the right to use a trade mark for some goods or services or for all goods or services for which the trade mark has been registered (hereinafter referred to as the "license") by means of a license contract.

(2) The license shall acquire legal effects vis-à-vis third parties on the date of entry into the Register. The entry of the license shall be carried out by the Office based on a request for the entry of the license, which any of the parties to the license contract is authorized to file. The Office shall refuse the entry of the license unless the requester attaches to the request the documents proving the license; before deciding on the refusal of the request for the entry of license, the Office shall allow the requester to comment on the established reasons on the basis of which the request for the entry of the license is supposed to be refused.

(3) The proprietor of a trade mark may grant an exclusive license or a non-exclusive license by means of a license contract. Unless it has been agreed in the license contract that the proprietor of a trade mark has granted an exclusive license, it holds that he has granted a non-exclusive license.

(4) If the proprietor of a trade mark has granted an exclusive license, he must not grant the license to a third party and is obliged, unless otherwise agreed in the license contract, to refrain from using the trade mark. The licensee of the exclusive license is obliged to use the trade mark (section 7c), unless otherwise agreed in the license contract.

(5) If the proprietor of a trade mark has granted a non-exclusive license, his right to use the trade mark (section 8) and his right to grant a license to a third party are not affected.

(6) A license contract by which the proprietor of a trade mark granted a license to a third party is invalid if the licensee of the previously granted exclusive license has not given prior written consent to conclude such license contract.

(7) The assignment or transfer of the right of the licensee is possible exclusively as part of an assignment or transfer of a business enterprise or its part within which the trade mark is used on the basis of a license, unless the license contract stipulates otherwise.

(8) Unless otherwise agreed, in the event of unauthorized interference with exclusive rights pursuant to section 8, the licensee of a non-exclusive license, on his own behalf and on his own account, can assert claims pursuant to section 8a by means of a court action pursuant to the Code of Contentious Civil Procedure or a motion pursuant to a special piece of legislation^{10a)} only with the consent of the proprietor of the trade mark; the licensee of an exclusive license can do so if the proprietor of the trade mark, after a written notification, does not assert claims pursuant to the Code of Contentious Civil Procedure pursuant to section 8(1). The provision of the previous sentence does not affect the rights and obligations of the proprietor of the trade mark and licensee under the Commercial Code^{15a)} nor the right of the licensee to intervene in proceedings initiated by the proprietor of the trade mark as an intervener.

(9) Subsections 1 to 8 shall also apply mutatis mutandis to the license contract by which the applicant grants authorization to use a sign being the subject-matter of the application (hereinafter referred to as the "license for the application"). The entry of a trade mark does not affect the entry of a license for the application and it shall be considered an entry of a license in accordance with subsection 2, unless otherwise agreed in the license contract. Modifying the sign, narrowing the list of goods and services or dividing the application (section 27) does not affect the entry of the license for the application; in the case of a division of the application (section 27(3)), the Office shall also enter a license for the divisional applications.

(10) The proprietor of the trade mark may invoke his rights conferred by his trade mark against a licensee who breaches any provision of the license agreement with regard to its duration, the form in which the trade mark may be used, the scope of goods and services for which the license is granted, the territory in which the trade mark may be used, or the quality of goods manufactured or services produced or provided by the licensee.

(11) Provisions of the Commercial Code^{15b)} shall apply to the creation, termination and exercise of the rights resulting from a license contract, unless otherwise provided in subsections 1 to 10.

§ 21

Right of pledge

(1) A right of pledge may be established for a trade mark.

(2) The contract on the establishment of a right of pledge must be in writing, otherwise it is invalid.

(3) At the request of the pledgee or at the request of the pledgor, the Office shall enter the right of pledge in the Register. The Office shall refuse the entry of the right of pledge with respect to the trade mark unless the requester attaches to the request the documents proving the establishment of the right of pledge with respect to the trade mark; before deciding on the refusal of the request for the entry of the right of pledge with respect to the trade mark, the Office shall allow the requester to comment on the established reasons on the basis of which this request is supposed to be refused.

(4) Subsections 1 to 3 shall also apply mutatis mutandis to the right of pledge with respect to the application and to the right of pledge with respect to a trade mark that would be registered in the future^{15c)} (hereinafter referred to as "right of pledge with respect to the application"). The entry of a trade mark does not affect the entry of the right of pledge with respect to an application and is considered to be an entry of a right of pledge with respect to the trade mark, unless otherwise agreed in the contract for the establishment of the right of pledge or if it does not follow otherwise from the decision by which the right of pledge has been established. Modifying the sign, narrowing the list of goods and services or dividing the application (section 27) does not affect the entry of the right of pledge for the application; in the case of a division of the application (section 27(3)), the Office shall also enter a right of pledge for the divisional applications.

(5) Provisions of the Civil Code shall apply to the creation, termination and exercise of a right of pledge with respect to a trade mark,¹⁶⁾ unless otherwise provided in subsections 1 to 4.

§ 22

Duration and renewal of registration of a trade mark

(1) The duration of the validity of the registration of the trade mark shall be ten years from the application filing date.

(2) The validity of the registration of a trade mark shall be renewed by the Office at the request of the proprietor of the trade mark, pledgee or another person proving a legal interest. The renewal of the registration of the trade mark comes into effect on the date subsequent to the date of the expiry of the validity of the registration of the trade mark.

(3) The request for renewal of the registration of a trade mark shall be filed at the earliest during the last year of the duration of the validity of the registration. If the request for renewal of the registration of the trade mark is not filed at the latest on the last day of the duration of the validity of the registration of the trade mark, it holds that the request for renewal of the registration has not been filed; subsection 4 shall remain unaffected by this.

(4) If the request for renewal of the registration of a trade mark has not been filed in the period pursuant to subsection 3, the request for renewal of the registration of the trade mark may be filed within an additional period of six months which begins on the date subsequent to the day when the request for renewal of the registration of the trade mark was, at the latest, supposed to be filed pursuant to subsection 3.

(5) Where the request is filed only for some of the goods or services for which the trade mark is registered, the Office shall renew the validity of its registration for those goods or services only.

(6) The Office shall inform the proprietor of the trade mark of the expiry of the validity of the registration of the trade mark at least six months before the said expiry. Information under the first sentence is not legally binding and the Office shall not be held liable if it fails to give such information.

§ 23

Termination of a trade mark

(1) A trade mark shall terminate

- (a) on the date of the expiry of the duration of the validity of its registration, unless a request for renewal of registration was filed,
- (b) of the effective date of a surrender of the trade mark by the proprietor; the surrender of the trade mark shall come into effect on the date stated in the notice of surrender of the trade mark as the date as of which the proprietor of the trade mark surrenders the trade mark; if this day is not stated in the notice, the surrender of the trade mark shall come into effect on the date of the delivery of the notice to the Office, or
- (c) on the effective date of a revocation of the trade mark.

(2) Surrender of a trade mark, to which the rights of third persons entered in the Register are attached, shall come into effect on the day of filing a written consent of the person whose rights or interests protected by law may be affected by the termination of the trade mark, or on the day when the proprietor of the trade mark proves the termination of those rights.

PART THREE

PROCEEDINGS BEFORE THE OFFICE

§ 24

Application

- (1) The entry of a trade mark into the Register is requested by an application filed at the Office.
- (2) The application shall contain
 - (a) a request for registration of the sign as a trade mark,
 - (b) information identifying the applicant,
 - (c) information identifying the representative of the applicant, if the applicant is represented,
 - (d) a representation of the sign being applied for, which satisfies the requirements set out in section 2(b),
 - (e) a list of goods or services in respect of which the sign is to be registered as the trade mark,
 - (f) signature of the applicant or his representative.
- (3) The application can concern one sign only.

§24a

Goods and services

- (1) The goods and services in respect of which a sign is supposed to be registered as a trade mark shall be classified in conformity with the system of classification established by an international agreement¹⁷⁾ (hereinafter referred to as "international classification").
- (2) The goods and services for which protection is sought shall be identified by the applicant in the list with sufficient clarity and precision to enable the competent authorities and the public, in particular economic operators, on that basis, to determine the extent of the protection sought.
- (3) The general terms included in the class headings of the international classification or other general terms may be used by the applicant in the list of goods or services, provided that they are clear and precise.
- (4) General terms, including the general terms included in the class headings of the international classification, include all the goods or services clearly covered by the literal meaning of the term; the use of such terms shall not create a claim for protection of goods or services which are not included in the literal meaning of those terms.
- (5) Where the applicant requests registration of goods and services belonging to more than one class, the applicant shall group the goods and services according to the classes of the international classification, each group being preceded by the number of the class to which that group of goods or services belongs, and shall present the groups in ascending order.
- (6) Goods and services shall not be regarded as being similar to each other only on the ground that they appear in the same class under the international classification. Goods and services shall not be regarded as being dissimilar from each other only on the ground that they appear in different classes under the international classification.

§ 25

Application filing date

- (1) The date of filing the application shall be the date of delivery of the filing to the Office which contains
 - (a) data indicating the apparent intention of the applicant that the requests the registration of the trade mark,
 - (b) data allowing identification of the applicant and contact with the applicant or his representative, and
 - (c) requirements in accordance with section 24(2)(d) and (e).
- (2) If the filing does not meet the data and requirements under subsection 1, the Office shall call upon the applicant to supplement them and for this purpose it shall prescribe to him a time limit that cannot be shorter than two months. In such case, the date of filing the application shall be date of delivery of the filing by which the applicant supplemented those data and requirements, otherwise the application shall be considered unfilled.

§ 26

Priority right

- (1) The applicant shall enjoy a right of priority vis-à-vis any person who later files an application containing an identical or similar sign for identical or similar goods or services
 - (a) as from the application filing date under section 25 or
 - (b) as from the priority date pursuant to an international convention⁴⁾ which results from the first application for this trade mark.
- (2) The priority right pursuant to subsection 1(b) must be exercised by the applicant as early as in the application and within three months from the filing of the application he shall prove this right by a document of the priority right,¹⁸⁾ otherwise this priority right shall not be taken into account. This right may be exercised only provided that the first application has been filed in a state or in relation to a state which is contracting party to an international convention⁴⁾ or which is a member of the World Trade Organization;⁵⁾ otherwise this right may be exercised only if the condition of reciprocity has been met.
- (3) If the applicant exercises the priority right in accordance with subsection 1(b), he shall state in the application the number and date of the filing of the trade mark application, from which he derives the priority right, and the state in which the application was filed. If the applicant exercises the priority right from more than one application, he has to state for each of the goods and services from which application he exercises the priority right.
- (4) The priority right pursuant to subsection 1(b) shall apply also to services.
- (5) Upon request of the applicant, the Office shall issue a document of the priority right in paper form.

§ 27

Modification of the sign and division of the application

(1) At the request of the applicant, the Office shall allow a modification of the sign related to his first name, last name, or the business name or registered office, permanent residence or place of business, if their modification occurred after the application has been filed and if the modification harmonizes data contained in the sign with real facts without changing the overall nature of the sign. Other changes to the sign shall not be permissible after filing the application. If the sign is modified after publication of the application, the application shall be re-published with the modified sign.

(2) After filing the application, the applicant shall be entitled to narrow the list of goods or services for which the sign is to be registered; such narrowing cannot be withdrawn. No extension of the list of goods or services, for which the sign is to be registered, shall be permissible.

(3) Until the entry of a sign into the Register, an applicant shall be entitled to divide the application containing in the list more than one good or service in such a way that he take out some goods or services from the application into one or several separate applications. The priority right and the filing date from the original application shall be preserved also for divisional applications. By dividing the application under the first sentence in the course of the opposition proceedings it is not permissible to divide the goods or services against which the filed oppositions are directed.

(4) The provisions of subsections 1 to 3 shall also apply mutatis mutandis to the trade mark. By dividing the entry according to subsection 3 in the course of the proceedings on the request for revocation of a trade mark or the request for declaration of invalidity of a trade mark, it is not permissible to divide those goods or services that are subject to the request for revocation of the trade mark or the request for declaration of invalidity of trade mark. The division of the entry according to subsection 3 does not affect the entry of a license (section 20), the entry of a right of pledge (section 21) or the entry of an execution (section 41a), and the Office shall enter the license, the right of pledge or the execution also for the trade marks that were created by the division of the entry according to subsection 3.

§ 28

Examination and publication of the application

(1) In the proceedings on the entry of a trade mark into the Register, the Office shall examine whether the application meets the conditions stipulated by this Act.

(2) If the application fails to meet conditions pursuant to section 24(2) and (3), 24a(1) and (3) and (5), the Office shall call upon the applicant to remove the deficiencies within the prescribed time limit. If the applicant fails to remove the deficiencies within the prescribed time limit, the Office shall discontinue the application proceedings; if the reasons for a discontinuation of proceedings pursuant to section 24a(2) and (3) related only to a certain part of goods and services, the Office shall discontinue the application proceedings only for those goods or services. The applicant shall be notified of this fact in the call for the removal of the deficiencies.

(3) If the sign being applied for is identical with an earlier trade mark (section 4) of another applicant or proprietor for identical goods or services, the Office shall notify the applicant or proprietor of an earlier trade mark of this fact prior to publishing the application in the Official Gazette of the Industrial Property Office of the Slovak Republic (hereinafter referred to as the "Official Gazette").

(4) If the sign fails to be capable of being entered pursuant to section 5, the Office shall refuse the application. Before refusing the application, the Office shall enable the applicant to comment on the reasons on the basis of which the application is supposed to be refused.

(5) If the reasons for refusing the application pursuant to subsection 4 relate to only a certain part of goods or services, the Office shall refuse the application only for that part of goods or services.

(6) If the application proceedings have not been terminated pursuant to subsection 2 or if the application has not been refused pursuant to subsection 3, the Office shall publish the application in the Official Gazette.

§ 29

Observations against the entry of a sign into the Register

(1) Before the entry of the sign into the Register, any person shall be entitled to file written observations against the entry of the sign into the Register based on the reasons under section 5; the Office shall take into account the observations in deciding on the entry of the sign into the Register. The person who filed the observations is not a participant in the trade mark application proceedings.

(2) The Office shall inform the applicant of the observations and the applicant can comment on them within the prescribed time limit. The Office shall inform the applicant and the person who filed the observations of the results of the assessment of the observations.

Oppositions

§ 30

(1) After publication of the application in the Official Gazette, the person referred to in section 7 (hereinafter referred to as "opposing party") shall be entitled to file oppositions for reasons under section 7 within a period of three months after that publication. The oppositions must specify their grounds and they have to be supported by evidence. Any supplement to and extension of oppositions and evidence submitted after this time limit shall not be taken into account

(2) Oppositions may be filed on the basis of one earlier right or several earlier rights pursuant to section 7, if they belong to the same proprietor. The oppositions can be filed on the basis of a part of goods or services or on the basis of all goods or services, for which the earlier right is protected or being applied for, and they can be directed against a part of goods or services or against all goods or services, for which the sign is supposed to be entered into the Register.

§ 31

(1) If the oppositions were not filed properly and in time pursuant to section 30(1), the Office shall discontinue the opposition proceedings. The Office shall deliver the decision to discontinue the opposition proceedings to the opposing party.

(2) If the Office does not discontinue the opposition proceedings under subsection 1, it shall inform the applicant of the oppositions and shall call upon him to comment on them within the specified period.

(3) If the applicant does not comment on the oppositions within the time limit under subsection 2, the Office shall decide in the matter in accordance with the contents of the file.

(4) If the Office finds out in the opposition proceedings that the entry of a sign into the Register is prevented by some of the reasons asserted pursuant to section 7, it shall refuse the application. If the reasons for the refusal of the application only relate to a certain part of the goods or services, the Office shall refuse the application for those goods or services.

(5) If the Office does not detect the existence of reasons asserted pursuant to section 7 in the opposition proceedings, it shall refuse the oppositions.

(6) The Office shall discontinue the opposition proceedings if the reason for which the opposition had been filed has ceased to exist. The Office shall deliver the decision to discontinue the opposition proceedings to the applicant and the opposing party.

(7) If, after the filing of oppositions the opposing party grants a written consent to the entry of a sign into the Register, the oppositions shall be considered withdrawn and the Office shall discontinue the opposition proceedings.

§ 32

Proving genuine use of an earlier trade mark in opposition proceedings

(1) If at least five years have passed since the registration of an earlier trade mark (section 4) on the application filing date or on the date of the creation of the priority right, the opposing party shall, at the applicant's request, submit evidence of genuine use (section 7c) of the earlier trade mark during the five years preceding the date of filing the application or the creation of the priority right, or evidence of legitimate reasons for its non-use.

(2) The request pursuant to subsection 1 can be filed by the applicant to the Office within two months from the notification of oppositions pursuant to section 31(2).

(3) The opposing party shall submit evidence of genuine use of the earlier trade mark or evidence of legitimate reasons for its non-use pursuant to subsection 1 within four months from the date of delivery of the call to the Office; evidence submitted after this period shall not be taken into account.

(4) If the opposing party fails to prove the genuine use of the earlier trade mark with the evidence submitted within the deadline pursuant to subsection 3 or fails to prove legitimate reasons for its non-use and if the earlier trade mark is the only right asserted by the opposing party, the Office shall refuse the oppositions; otherwise, such an earlier trade mark shall not be taken into account in the opposition proceedings.

(5) If the opposing party has proven the genuine use only for a part of the goods or services for which the earlier trade mark is registered, the earlier trade mark for the purposes of examining oppositions shall be considered registered only for this part of the goods or services.

§ 32a

(1) During the opposition proceedings, the Office shall grant the applicant and the opposing party, based on their joint request, at least two months for an amicable resolution of their dispute.

(2) If the application pursuant to subsection 1 was submitted during the period pursuant to section 31(2) and if there was no amicable resolution of the dispute between the participants, then, after the deadline according to subsection 1, the Office shall set a new deadline for the applicant to comment on the submitted oppositions.

(3) If the request pursuant to subsection 1 was filed during the period pursuant to section 32(2) or (3), and if there was no amicable resolution of the dispute between the participants, the deadlines pursuant to section 32(2) or (3) shall run anew with the expiry of the deadline under subsection 1.

§ 33

Registration of a trade mark

(1) If the conditions for the entry of the sign into the Register have been met and the application proceedings have not been discontinued, no oppositions have been filed within the time limit referred to in section 30(1) or if the opposition proceedings ended by a final decision of the Office to discontinue the proceedings or to refuse oppositions, the Office shall enter the sign into the Register.

(2) The effects of the entry of a trade mark into the Register start on the date of the entry of the sign into the Register. On that day, the applicant shall become the proprietor of the trade mark; the Office shall issue to the proprietor a certificate of the entry of the trade mark into the Register in paper form.

(3) The Office shall notify the entry of the trade mark into the Register in the Official Gazette.

§ 34

Revocation of the trade mark

(1) The Office shall revoke the trade mark at the request of a third party if

(a) the trade mark has not been put to genuine use in connection with the goods or services in respect of which the trade mark is registered within a continuous period of five years in the territory of the Slovak Republic; unless proved otherwise by the proprietor of the trade mark or there are no legitimate reasons for non-use, the trade mark shall be considered not used in the territory of the Slovak Republic within the five consecutive years. The Office shall not revoke the trade mark, if the trade mark was put to genuine use between the end of that five-year period and the filing of the request for its revocation or its use has been resumed; however, use of a trade mark which commenced or was resumed within three months prior to the filing of the request for revocation of the trade mark – that period of time having started to run only after the expiry of the continuous five year period of non-use – shall be disregarded where the preparations for that use started only after the proprietor of the trade mark becomes aware that a request for revocation of the trade mark may be filed;

(b) by the consequence of acts or inactivity of the proprietor the trade mark has become the common name for the goods or services in respect of which it is registered;

(c) as a result of the use made of it by the proprietor or with his consent in respect of the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods

or services.

(2) At the request of a third party, the Office shall revoke a trade mark on the basis of a court decision according to which:

- (a) the trade mark containing the first name and last name or the image of a natural person, or its pseudonym, infringes the rights to the protection of personal rights;
- (b) the trade mark containing the name or the business name of a natural person or legal entity interferes with its reputation;
- (c) the trade mark infringes upon earlier rights to a copyright work;
- (d) use of the trade mark is an act of unfair competition.19)

(3) The request for revocation of the trade mark referred to in subsection 2 shall be filed within six months from date when the court decision becomes final.

(4) Where grounds for revocation of a trade mark exist in respect of only some of the goods or services for which that trade mark has been registered, the Office shall revoke the trade mark for those goods or services only.

(5) The revocation of a trade mark shall come into effect on the date of filing the request for its revocation or on an earlier date determined at the request of a participant in the trade mark revocation proceedings determined as the date as at which the reason of revocation occurred, if the participant in the trade mark revocation proceedings proves a legal interest.

(6) The Office can revoke a trade mark even after its termination pursuant to section 23(1)(a) and (b), if the person having filed the request to revoke the trade mark proves a legal interest.

§ 35

Declaration of invalidity of the trade mark

(1) The Office shall declare a trade mark invalid, if in proceeding initiated at the request of a third party or on its own initiative, it finds out that conditions for the entry of the trade mark into the Register pursuant to legislation valid at the time of its entry have not been met.

(2) Where a trade mark has been registered in breach of section 5(1)(b) to (d), it shall not be declared invalid pursuant to subsection 1 by the Office, if the proprietor of the trade mark proves that after its entry into the Register the trade mark has acquired a distinctive character in consequence of its use in the territory of the Slovak Republic or in relation to the territory of the Slovak Republic for goods or services for which it is registered, before the proceedings on the request for declaration of invalidity of the trade mark started.

(3) The Office shall also declare a trade mark invalid at the request of the person referred to in section 7 for reasons stated in section 7 if the proceedings on declaration of invalidity of the trade mark prove that this reason exists. The conditions of the assertion of earlier rights stated in section 7 must be met as early as on the application filing date or on the date of the creation of the priority right by a motion of the affected trade mark.

(4) The Office may declare the trade mark invalid even after its termination pursuant to section 23(1), if the person filing the request for declaration of invalidity of the trade mark proves a legal interest.

(5) Where the trade mark is declared invalid, the trade mark shall be deemed never to have been registered.

(6) Where the ground for the declaration of invalidity of the trade mark exists only in respect of some of the goods or services for which the trade mark is registered, the Office shall declare the trade mark invalid in respect of those goods or services only.

§ 35a

Suffering the use of a later trade mark

(1) The proprietor of an earlier trade mark (section 4) or the user of earlier rights referred to in section 7(c), (d) and (f) is not entitled to request the declaration of a later trade mark invalid for the goods or services for which that later trade mark is used, if he has suffered its use for five consecutive years and was aware of this use; this does not apply if the application of the later trade mark has not been filed in good faith.

(2) If the proprietor of an earlier trade mark or the user of earlier rights referred to in section 7(c), (d) and (f) is not entitled to request the declaration of a later trade mark invalid according to subsection 1, the proprietor of the later trade mark is not entitled to prevent the use of an earlier trade mark or earlier rights referred to in section 7(c), (d) and (f), even if this earlier trade mark or these earlier rights can no longer be asserted against a later trade mark.

§ 36

Special provisions on the effects of a revocation of a trade mark or declaration of invalidity of a trade mark

(1) The effects of the revocation of a trade mark or declaration of a trade mark invalid do not concern

- (a) decisions concerning trade mark infringement which came into effect and were enforced before the effective date of the decision to revoke the trade mark or declare it invalid,
- (b) contracts concluded before the effective date of the decision on revocation or invalidity of a trade mark to the extent of the performance provided on their basis before the effective date of such a decision; it is however possible to request the return of the performance already provided on the basis of the contract.

(2) The provision of subsection 1 shall be without prejudice to the liability of the proprietor of the trade mark for damage or unjust enrichment.

§ 37

Request for revocation and request for declaration of invalidity of a trade mark

(1) The request for revocation of a trade mark or request for declaration of invalidity of a trade mark shall contain a reasoning and it shall be supported by evidence; supplements to and extension of the reasoning of the request for revocation or declaration of invalidity of the trade mark shall not be taken into account.

(2) The request for revocation of a trade mark or request for declaration of invalidity of a trade mark may be in respect of only some goods or services or all goods or services, for which the trade mark has been registered. The request for declaration of invalidity of a trade mark may be filed on the basis of one earlier right or on the basis of several earlier rights under section 7, if they belong to the same proprietor. The request for declaration of invalidity of a trade mark may be filed on the basis of some goods or services or on the basis of all goods or services for which the earlier right is protected.

(3) If the request for revocation of a trade mark or request for declaration of invalidity of a trade mark fails to meet the requirements referred to in subsection 1, the Office shall discontinue the proceedings on this request. The decision to discontinue the proceedings shall be delivered to the person who filed the request for revocation of the trade mark or request for declaration of invalidity of the trade mark (hereinafter referred to as "Requester").

(4) If the Office does not discontinue the proceedings on the request for revocation of a trade mark or request for declaration of invalidity of a trade mark pursuant to subsection 3 or 7, it shall inform the proprietor of the trade mark of the request and shall call upon him to comment on the request for revocation of the trade mark or request for declaration of invalidity of the trade mark.

(5) If the proprietor of the trade mark does not comment on the request for revocation of a trade mark or request for declaration of invalidity of the trade mark within the time limit under subsection 4, the Office shall decide in the matter on the basis of the content of the file.

(6) If, in the proceedings on the request for revocation of a trade mark, the Office finds that the conditions according to section 34(1) to (3) are not met, or in proceedings for a request for declaration of invalidity of a trade mark it finds that the conditions according to section 35(1) or (3) are not met, it shall refuse the request.

(7) The Office shall discontinue the proceedings on a request for revocation of a trade mark pursuant to section 34 or proceedings on a request for declaration of invalidity of a trade mark pursuant to section 35, if the reason for which the request has been filed has ceased to exist.

(8) Section 31(7) shall be also applied mutatis mutandis to proceedings on a request for declaration of invalidity of a trade mark.

(9) Together with the request for revocation of a trade mark according to section 34(1) or together with the request for declaration of invalidity of a trade mark according to section (1) or (3), the Requester is obliged to deposit a security of 100 Euros. The Office will return the security if the request for revocation of a trade mark or the request for declaration of invalidity of a trade mark is granted in full.

§ 37a

Proving the genuine use of an earlier trade mark in proceedings on a request for declaration of invalidity of a trade mark

(1) If at least five years have passed since the registration of an earlier trade mark (section 4) on the date of filing a request for declaration of invalidity of a trade mark, then, at the request of the proprietor of the later trade mark, the Requester shall submit evidence of the genuine use (section 7c) of the earlier trade mark for five years which precede the filing date of the request, in connection with the goods or services for which it is registered and on which the request is based, or evidence of legitimate reasons for its non-use. If at least five years have passed since the registration of an earlier trade mark (section 4) on the date of filing the application or on the date of the creation of the priority right of the later trade mark, then in addition to the evidence according to the first sentence, the Requester shall also submit evidence of the genuine use of the earlier trade mark during the five years preceding the date of filing of the application or the priority date of the later trade mark, in connection with the goods or services for which it is registered and on which the request is based, or evidence of legitimate reasons for its non-use.

(2) The proprietor of a later trade mark may file the request according to subsection 1 to the Office within two months from the notification of the request for declaration of invalidity of the trade mark according to section 37(4).

(3) The Requester shall submit evidence of genuine use of the older trade mark or evidence of legitimate reasons for its non-use pursuant to subsection 1 within four months from the date of delivery of the call to the Office; evidence submitted after this period shall not be taken into account.

(4) If the Requester fails to prove the genuine use of the older trade mark by means of the evidence submitted within the deadline according to subsection 3 or fails to prove legitimate reasons for its non-use, and if the older trade mark was the only right exercised by the Requester, the Office shall refuse the request for declaration of invalidity of the trade mark; otherwise, the older trade mark shall not be taken into account in the proceedings on the request for declaration of invalidity of the trade mark.

(5) If the Requester proved the genuine use only for a part of goods or services for which the earlier trade mark is registered, then for the purposes of examining the request for declaration of invalidity of the trade mark this earlier trade mark shall be considered registered only for that part of the goods or services.

§ 38

Extension of the time limit and continuation of proceedings

(1) On the basis of a request of a participant in the proceedings on the extension of the time limit set by the Office for performing an act filed before the expiry of such time limit, the Office may extend the time limit.

(2) On the basis of a request of a participant in the proceedings, who missed the time limit determined by the Office for performing the act, the Office may decide to continue the proceedings, if the participant in the proceedings, simultaneously with filing the request for continuation of the proceedings, performs the missed act; the request for continuation in the proceedings must be filed at the latest two months after the date of the expiry of the time limit.

(3) The request referred to in subsection 2 cannot be granted when the time limits are missed pursuant to sections 31(2), 32a(2) and 37(4).

(4) The Office shall refuse a request for extension of a time limit or a request for continuation of proceedings which fails to comply with conditions referred to in subsection 1 or 2 or cannot be granted under subsection 3; prior to the decision to refuse the request, the Office shall enable the requester to comment on the ascertained reasons on basis of which the request is supposed to be refused.

(5) If the Office grants the request for continuation of proceedings, the legal effects of the decision issued as a result of missing the time limit shall cease to exist or will not occur.

(6) If the Office does not decide to refuse the request referred to in subsection 1 within two months from its delivery, the request shall be deemed to have been granted.

§ 39

Restitutio in integrum

(1) On the basis of a request of participant in proceedings, who despite the due care required by the circumstances, missed a legal time limit or a time limit set by the Office for performing an act, and the consequence of the failure to perform this act is a stopping of proceedings or the loss of another right, the Office may decide to perform a restitution in integrum, if the participant in proceedings, simultaneously with filing the request, performs the missed act; the request for a restitution in integrum

must be filed within two months from the disappearance of the obstacle, for which the participant in the proceedings was unable to perform the act, but no later than 12 months from the expiry of the missed time limit and in the case of a missed time limit for the filing of the request for an extension of the validity of the registration of the trade mark no later than six months from the expiry of the missed additional time limit pursuant to section 22(4).

(2) A participant in the proceedings is obliged to justify the request for a restitutio in integrum and to state the facts that have prevented the performance of the act, as well as the date of the disappearance of the obstacle, due to which he could not perform the act.

(3) If there are justified doubts about the truth of the justification pursuant to subsection 2, the Office shall call on the requester to prove his allegations.

(4) Requests for a restitutio in integrum cannot be granted in cases of a missed time limit for

- (a) the filing of a request for continuation of proceedings pursuant to section 38(2) and a request for a restitutio in integrum pursuant to subsection 1,
- (b) the exercise and proving of the priority right pursuant to section 26(2),
- (c) the filing of oppositions pursuant to section 30(1),
- (d) the filing of a remonstrance pursuant to section 40(1) and the filing of the reasoning for the remonstrance pursuant to section 40(3),
- (e) the performance of acts pursuant to section 22(3), section 31(2), section 32a(2), section 34(3) and section 37(4),
- (f) the filing of a request for evidence of genuine use pursuant to section 32(2) or 37a(2),
- (g) the proving of genuine use pursuant to section 32(3) or section 37a(3).

(5) The Office shall refuse a request for a restitutio in integrum which does not meet the conditions pursuant to subsections 1 and 2, or which cannot be granted pursuant to section 4, or if the applicant does not prove his allegations pursuant to subsection 3; before deciding on the refusal of the request, the Office will enable the requester to comment on the facts found, on the basis of which the request is supposed to be refused.

(6) If the Office complies with the request for a restitutio in integrum, the legal effects of the decision issued as a result of the missed time limit shall cease or not occur.

§ 40

Remonstrance

(1) A remonstrance against a decision of the Office may be filed within 30 days from the delivery of the decision; a remonstrance filed in time has a suspensory effect.

(2) When deciding on a remonstrance, the Office is bound by its scope; this does not apply to matters

- (a) in which proceedings can be initiated ex officio,
- (b) of joint rights or obligations concerning several participants in the proceedings on one side.

(3) The reasoning for the remonstrance must be filed within one month from the date of filing the remonstrance. If no reasoning for the remonstrance is filed within the said deadline, the Office shall discontinue the remonstrance proceedings. The Office shall discontinue the proceedings even in cases of a delayed or impermissible remonstrance.

(4) It is not allowed to file a remonstrance against a decision having

- (a) granted a request for the continuation of the proceedings or a request for a restitutio in integrum,
- (b) discontinued the proceedings pursuant to section 51(8), or suspended the proceedings pursuant to section 51(9),
- (c) discontinued the proceedings pursuant to subsection 3.

(5) It is not allowed to file a remonstrance only against the reasoning of a decision.

§ 41

Register

(1) The Office shall keep the Register in electronic form in which it records decisive data about applications and trade marks. The Register shall be public and anybody shall be entitled to inspect it.

(2) Data entered in the Register shall be considered valid unless the relevant authority has decided otherwise.

(3) Changes in data entered into the Register ensuing from a final and enforceable decision of a competent authority shall be entered without delay into the Register by the Office after delivery of the decision with a validity clause of finality and enforceability.

§ 41a

Entering an execution into the Register

On the basis of a writ of execution^{19a)} supported by a notification of the initiation of an execution and a list of rights which also includes the specific application or the specific trade mark, the Office shall enter into the Register the fact that this application or trade mark is affected by an execution pursuant to special legislation with effect from the date of delivery of the writ of execution to the Office. The entry of a trade mark into the Register does not affect the entry of the execution by affecting the rights resulting from the application and is considered to be an entry of execution by affecting the rights resulting from the trade mark. A modification of the sign, a narrowing of the list of goods and services or a division of the application (section 27) does not affect the entry of the execution by affecting the rights resulting from the application; in the case of a division of the application (section 27(3)), the Office shall also enter the execution by affecting the rights resulting from the divisional applications.

§ 42

Official Gazette

The Office issues the Official Gazette, in which the Office shall publish and notify facts relating to applications and trade marks, as well as public notices and decisions of substantial nature.

PART FOUR

COLLECTIVE TRADE MARK

§ 43

(1) A collective trade mark is a trade mark which is denoted as such when filing the application and which is capable of distinguishing the goods or services stemming from the members of an association of manufacturers, producers, suppliers of services or traders, who have the capacity in their own name to have rights and obligations (hereinafter referred to as "association") from the goods or services of other persons.

(2) An application for a collective trade mark may be filed by the association or by a legal person governed by public law.

(3) Unless sections 44 to 45a provide otherwise, provisions of this Act apply to the application of a collective trade mark, the rights resulting from a collective trade mark, its termination, as well as to the proceedings regarding the revocation of a collective trade mark or the declaration of its invalidity.

§ 44

Special provisions on the collective trade mark application

(1) The applicant is obliged to submit, together with the application for a collective trade mark, a contract for the use of the collective trade mark (hereinafter referred to as "use contract") which contains a list of persons authorized to use the collective trade mark including their identification data, the conditions of membership in the association and the conditions of use of the collective trade mark, including sanctions.

(2) The Office shall also refuse an application for a collective trade mark if

- (a) the requirements under subsection 1 or section 43(1)(1) and (2) are not met,
- (b) the use contract is contrary to the "order public" or morality or
- (c) the public is liable to be misled as regards the character or the significance of the sign being applied for, in particular if it is likely to be taken to be something other than a collective trade mark.

(3) The Office shall not refuse the application of a collective trade mark pursuant to subsection 2, if the applicant, by an amendment to the use contract, removes the deficiencies specified in subsection 2.

(4) Observations against the entry of a sign as a collective trade mark into the Register (section 29) can be filed also for reason referred to in subsection 2.

§44a

Amendments to the collective trade mark use contract

(1) The proprietor of a collective trade mark shall submit to the Office any amendments to the use contract.

(2) The Office shall enter the piece of data on the contract amendment into the Register, unless the conditions pursuant to section 44(1) have been satisfied or there is a reason for refusal of the application referred to in section 44(2)(b)(c).

(3) If the amendment to the use contract concerns the list of persons authorized to use the collective trade mark, the Office shall enter the amendment in the list into the Register.

(4) An amendment to the use contract shall take effect on the date of entry of the piece of data on the amendment to the contract into the Register.

§ 45

Special provision on the rights conferred by a collective trade mark

(1) The exclusive right to use a collective trade mark for goods or services for which the collective trade mark is registered belongs to the members of the association stated in the list under section 44(1).

(2) In the event of an unauthorized interference with the exclusive right pursuant to subsection 1, the proprietor of the collective trade mark is entitled to assert claims pursuant to section 8a by means of a court action pursuant to the Code of Contentious Civil Procedure or by a motion pursuant to a special piece of legislation^{10a)} on behalf of the persons authorized to use the collective trade mark.

(3) Unless otherwise stated in the use contract, in case of unauthorized interference with the exclusive right according to subsection 1, the person authorized to use the collective trade mark on its own behalf and on its own account can assert claims pursuant to section 8a by a court action according to the Code of Contentious Civil Procedure or by a motion pursuant to a special piece of legislation^{10a)} only with the consent of the proprietor of the collective trade mark. The provision of the previous sentence does not affect the right of the person authorized to use the collective trade mark to intervene in the proceedings initiated by the proprietor of the collective trade mark as an intervener.

(4) A collective trade mark cannot be assigned to another proprietor and it cannot be the subject-matter of a license or right of pledge.

§ 45a

Special provisions on the revocation of a collective trade mark and declaration of invalidity of a collective trade mark

(1) The Office shall also revoke a collective trade mark if

(a) the proprietor of the collective trade mark did not take reasonable steps to prevent the collective trade mark being used in a manner that is incompatible with the conditions of use laid down in the use contract, including any amendment to that that contract entered in the Register (section 44a(4));

(b) the manner in which the collective trade mark has been used by authorized persons has caused it to become liable to mislead the public in the manner referred to in section 44(2)(c);

(c) an amendment to the use contract has been entered into the Register in breach of the requirements of section 44a(2), unless the proprietor of the collective trade mark, by further amending the use contract, complies with those requirements.

(2) The Office shall also declare a collective trade mark invalid if it has been registered in breach of the requirements

under section 44(2), unless the proprietor of the collective trade mark, by amending the use contract, complies with those requirements.

PART FIVE

INTERNATIONAL TRADE MARK AND EUROPEAN UNION TRADE MARK

Registration of an international trade mark

§ 46

A person who has its permanent residence, seat or a business enterprise in the territory of the Slovak Republic or is a national of the Slovak Republic may request, through the Office, the entry of an international trade mark in an international register or the entering of changes in respect of the entry of the international trade mark in the international register under an international convention.¹⁾

§ 47

(1) From the date of entry of an international trade mark, in which the Slovak Republic is noted, into the international register or from the date of a territorial extension of the entry of an international trade mark for the Slovak Republic in the international register, the entry of the international trade mark has the same effect as a national application.

(2) An international trade mark, next to which the Slovak Republic is noted, shall be subject to examination as to whether it meets the conditions referred to in section 5 and subject to oppositions like the national application.

(3) The time limit for filing the oppositions against the provision of international trade mark protection for the territory of the Slovak Republic starts on the first day of the month subsequent to the month in which the international trade mark was published in the Gazette of the World Intellectual Property Organization.

(4) If the Office fails to notify the refusal of the protection for the international trade mark under an international convention¹⁾ or if such refusal has been withdrawn, the registration of an international trade mark, in which the Slovak Republic is noted, shall have the same effect as the trade mark entered in the Register from the date referred to in subsection 1.

(5) Refusing the protection of the international trade mark for the Slovak Republic shall have the same effect as refusing the national application.

(6) The sign being the subject-matter of the application filed under an international treaty²⁰⁾ shall be entered into the Register without further proceedings.

§ 48

European Union trade mark

(1) The rights resulting from the EU trade mark can be exercised at the earliest on the date the Slovak Republic acceded to the European Union.²²⁾

(2) Pursuant to a special piece of legislation²³⁾, an enforceable decision of the European Union Office for Intellectual Property shall be provided by the Office with a confirmation of enforceability.

§ 49

Conversion of an EU trade mark application and conversion of an EU trade mark to a national application

(1) The Office shall examine whether the request for the initiation of proceedings on the conversion of an EU trade mark application or conversion of an EU trade mark to a national application pursuant to a special piece of legislation²⁵⁾ contains:

- (a) a translation of the request to the Slovak language,
- (b) the address for deliveries in the territory of the state being a contracting party to the Agreement on the European Economic Area;
- (c) a representation of the sign being applied for.

(2) If the request for the initiation of proceedings on the conversion of an EU trade mark application or an EU trade mark to a national application fails to meet the conditions referred to in subsection 1, the Office shall call upon the requester to remove the deficiencies within a time limit of at least two months. If the requester fails to remove the deficiencies within the prescribed time limit, the Office shall discontinue the proceedings. The requester shall be notified of this consequence in the call by the Office.

(3) The national application resulting from the conversion of a EU trade mark application or the conversion of a EU trade mark shall enjoy the date of filing and the priority date from that application or trade mark and, where appropriate, the seniority right.⁶⁾ The rights resulting from such national application and subsequently from the trade mark entered in the Register can be exercised at the earliest on the date of accession of the Slovak Republic to the European Union.²²⁾

(4) The application pursuant to subsection 3 shall be subject to proceedings like the national application.

§ 50

(1) The proprietor of a trade mark entered in the Register, the application for which was filed in good faith with a priority right prior to the accession of the Slovak Republic to the European Union,²²⁾ shall have the right to prohibit the use, in the territory of the Slovak Republic, of an EU trade mark, the effects of which have been extended to the territory of the Slovak Republic on the basis of the accession of the Slovak Republic to the European Union,²²⁾ if

- (a) the trade mark entered in the Register is identical with the EU trade mark registered for the same goods or services,
- (b) because the trade mark entered in the Register is identical with or similar to the EU trade mark and because of the identity or similarity of goods or services covered by both of them there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the EU trade mark,
- (c) because the trade mark entered in the Register, which has a reputation in the territory of the Slovak Republic, is identical with or similar to the EU trade mark, the use of the EU trade mark in connection with goods or services, which are identical with, similar to or not similar to those for which the trade mark is entered in the Register, without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the trade mark entered in the Register.

(2) The proprietor of the trade mark entered in the Register which is mentioned in subsection 1 may claim compensation for the damage he incurred as a result of the use of the EU trade mark in the territory of the Slovak Republic within the scope stipulated in section 8a.

PART SIX

COMMON, AUTHORIZING, TRANSITIONAL AND REPEALING PROVISIONS

Common provisions

§ 51

(1) Persons who have a permanent residence, registered office or business enterprise in the territory of a state that is a party to an international convention,⁴⁾ or in the territory of a state that is a member of the World Trade Organization,⁵⁾ or are nationals of that state, have the same rights and obligations as citizens of the Slovak Republic without prejudice to the provision of subsection 2. If the state of which the person is a national, or the state in whose territory the person has a permanent residence, registered office or business enterprise, is not a state that is a party to an international convention⁴⁾ or a member of the World Trade Organization,⁵⁾ rights pursuant to this Act may be granted only under the condition of reciprocity.

(2) Persons not having a permanent residence or registered office in the territory of the Slovak Republic must be represented by a lawyer²⁶⁾ or a patent attorney^{26a)} in proceedings before the Office.^{26a)}

(3) The mandatory representation according to subsection 2 does not apply to participants in the proceedings, who are citizens of a state being a contracting party to the Agreement on the European Economic Area, have a registered office or business enterprise in the territory of a state being a contracting party to the Agreement on the European Economic Area.

(4) The participant in the proceedings or his representative is obliged to notify the Office of the address for delivery in the territory of the state being a contracting party to the Agreement on the European Economic Area.

(5) Proceedings before the Office pursuant to this Act are subject-matter to a general piece of legislation on administrative proceedings²⁷⁾ except section 19, section 28, section 29, section 30(1)(b) and (d), section 32 to 34, section 39, section 49, section 50, section 59(1) and section 60.

(6) If the attachment to the filing is a copy of a document, about the authenticity of which the Office has doubts, it may request the submission of the original document or its certified copy.

(7) If a party in the proceedings fails to comply with a call of the Office within the specified period, the Office may discontinue the proceedings. The Office shall notify the participant in the proceedings of this consequence in the call.

(8) The Office shall also discontinue the proceedings at the request of the person who filed the request for its initiation; the Office is not obliged to do so, in the case of proceedings that the Office can initiate ex officio. A request to discontinue proceedings cannot be withdrawn.

(9) If proceedings have been initiated on a preliminary issue that the Office is not authorized to resolve, the Office shall suspend the proceedings. As soon as the obstacle for which the proceedings have been suspended disappears, the Office shall continue the proceedings even without a motion. During the suspension of the proceedings, the prescribed time periods (time limits) pursuant to this Act do not run; this does not apply to time limits under section 22(3) and (4). If the proceedings have been suspended within a time limit under section 32(2) or (3) or under section 37a(2) or (3), as soon as the obstacle for which the proceedings have been suspended disappears, the time limits under section 32(2) or (3) or under section 37a(2) or (3) start to run anew.

(10) The filing at the Office shall be in writing, more specifically in paper form or in electronic form, and in the state language,²⁸⁾ unless otherwise provided for in part five of this Act.

(11) Unless otherwise provided for in subsection 12, a filing at the Office made in electronic form without authorization pursuant to a special piece of legislation^{28a)} must be additionally delivered in paper form or in electronic form, authorized pursuant to a special piece of legislation;^{28a)} if it is not additionally delivered to the Office within one month, the filing shall not be taken into account. The Office shall not call for additional delivery of the filing.

(12) Subsection 11 does not apply to a filing made through closed information systems.^{28b)}

(13) The filing shall be assessed in accordance with its contents. It must be obvious from the filing who performs the filing, what matter it concerns and what it requests. Every filing must be signed by the filing person. A filing in electronic form authorized in accordance with a special piece of legislation^{28a)} must contain an identifier of the person of the participant in the proceedings and an identifier of the person of the representative pursuant to a special piece of legislation,^{28c)} if the participant in the proceedings is represented.

(14) Fees under a special piece of legislation shall be paid for acts pursuant to this Act. 29)

§ 52

(1) A party in the proceedings shall be obliged to propose and submit evidence to support his allegations.

(2) The Office shall produce evidence and evaluate evidence at its discretion, each piece of evidence separately and all pieces of evidence in their mutual relations.

(3) The Office shall decide on basis of the reasoning of the filing and the evidence submitted by the parties in the proceedings.

§ 53

Authorizing provision

A generally binding piece of legislation issued by the Office shall stipulate the details of

- (a) the requirements for the application, including requirements of the representation of the sign being applied for,
- (b) the requirements for a request for a modification of the sign,
- (c) the requirements for critical comments against the entry of the sign into the Register,
- (d) the requirements for oppositions against the entry of the sign into the Register,
- (e) the data entered into the Register and published in the Official Gazette,
- (f) the requirements for a certificate, a duplicate of the certificate, an abstract from the Register and a document on the creation of the priority right,
- (g) the requirements for a request for a change of the business name or the name and registered office, or the first name, last name and permanent address,
- (h) the requirements for a request for the entry of the representative or for the entry of a change of the representative into the

Register,

- (i) the requirements for a request for the entry of an assignment or transfer into the Register,
- (j) the requirements for a request for the entry of the license contract into the Register and the requirements of a declaration of the existence of the license agreement,
- (k) the requirements for a request for the entry of a right of pledge into the Register,
- (l) the requirements for a request for renewal of the registration of a trade mark,
- (m) the requirements for a request for revocation of a trade mark,
- (n) the requirements for a request for declaration of invalidity of a trade mark,
- (o) the requirements for a remonstrance,
- (p) file administration,
- (q) the form of the filing, the number of counterparts of the filing with attachments and the details of the delivery to the Office,
- (r) the requirements of a request for proving the genuine use of an earlier trade mark in opposition proceedings or in proceedings to declare a trade mark invalid,
- (s) the requirements for a request for an amicable resolution of a dispute,
- (t) the entry of an execution into the Register,
- (u) the requirements of a request for division of an application or division of the entry.

§ 54

Transitional provisions

(1) Proceedings on applications that have not been finally completed before this Act comes into effect shall be completed in accordance with this Act, provided that the applicant shall be obliged to harmonize his application with the requirements pursuant to this Act within the prescribed time limit upon a call of the Office.

(2) Rights and relations resulting from trade marks entered into the Register before this Act comes into effect shall be governed by the provisions of this Act. The creation of these rights and relations, as well as claims having arisen from them before this Act enters into effect, shall be assessed in accordance with the legislation in force at the time of their creation. A trade mark entered into the Register pursuant to previous legislation shall not be declared invalid if it is in accordance with this Act.

(3) Where a request for the expungement of a trade mark under the hitherto existing Act was filed prior to the effective date of this Act, it shall be considered to be a request for revocation of the trade mark or a request for declaration of invalidity of the trade mark under this Act. Provisions of this Act shall apply to the assessment of the fulfilment of the conditions of the request for revocation of the trade mark or the request for declaration of invalidity of the trade mark and to the proceedings on that request and on its effects.

(4) If oppositions were filed pursuant to section 9 of the hitherto existing Act which fail to meet conditions of this Act, the opposing party shall be obliged to harmonize them with the conditions pursuant to this Act within three months from the effective date of this Act, otherwise they shall not be taken into account.

§ 54a

Transitional provisions for adjustments effective from January 1, 2018

(1) Proceedings initiated and not finally completed by December 31, 2017, shall be completed pursuant to this Act in the version effective from January 1, 2018.

(2) The periods that began to run until December 31, 2017, shall run pursuant to this Act in the version effective until December 31, 2017, and their legal effects shall remain preserved.

(3) Rights and legal relationships resulting from trade marks entered into the Register until December 31, 2017 shall be assessed in accordance with this Act in the version effective as from January 1, 2018. The creation, change and termination of rights and legal relationships, as well as claims arising from them until December 31, 2017 shall be assessed in accordance with the legislation effective at the time of their creation.

§ 54b

Transitional provisions for adjustments effective from January 14, 2019

(1) Proceedings initiated and not finally completed by January 13, 2019 shall be completed pursuant to this Act in the version effective as from January 14, 2019.

(2) The periods that began to run until January 13, 2019, shall run pursuant to this Act in the version effective until January 13, 2019, and their legal effects shall remain preserved.

(3) Rights and legal relationships resulting from trade marks entered into the Register until January 13, 2019 shall be assessed pursuant to this Act in the version effective as from January 14, 2019. The creation, change and termination of rights and legal relationships, as well as claims arising from them until January 13, 2019 shall be assessed in accordance with the legislation effective at the time of their creation.

(4) A defendant shall be entitled to file a request for the submission of evidence of the genuine use of a trade mark under section 14a(2) in the judicial trade mark infringement proceedings that started after January 13, 2019.

§ 55

The legal acts of the European Communities and the European Union stated in the Annex are being transposed by this Act.

§ 56

Repealing provision

The following shall be repealed:

1. Act No. 55/1997 Coll. of Laws of the Slovak Rep. on trade marks as amended by the Act No. 577/ 2001 Coll. of Laws of the Slovak Rep., Act No. 14/ 2004 Coll. of Laws of the Slovak Rep., Act No. 344/ 2004 Coll. of Laws of the Slovak Rep., Act No. 84/ 2007 Coll. of Laws of the Slovak Rep. and Act No. 495/ 2008 Coll. of Laws of the Slovak Rep.;
2. Regulations of the Industrial Property Office of the Slovak Republic No. 117/ 1997 Coll. of Laws of the Slovak Rep.

implementing the Act No. 55/1997 Coll. of Laws of the Slovak Rep. on trade marks as amended by the Act No. 709/ 2002 Coll. of Laws of the Slovak Rep.

§ 57

Effect

This Act shall take effect on January 1, 2010.
The Act No. 125/2016 Coll. of Laws of the Slovak Rep. took effect on July 1, 2016.
The Act No. 242/2017 Coll. of Laws of the Slovak Rep. took effect on January 1, 2018 except Art. IV point 16 section 20(9) and section 21(4), point 24, which took effect on January 1, 2019.
The Act No. 291/2018 Coll. of Laws of the Slovak Rep. took effect on January 14, 2019.

Ivan Gašparovič m. p.

Pavol Paška m. p.

Robert Fico m. p.

ANNEX

LIST OF TRANSPOSED LEGAL ACTS OF THE EUROPEAN COMMUNITIES AND THE EUROPEAN UNION

1. Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (Special edition of the Official Journal of the European Union, chap. 17/vol. 2, Official Journal of the European Union L 157, 30.4.2004).
2. Directive 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (Official Journal of the European Union L 336, 23.12.2015)

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- 1) Madrid Agreement Concerning the International Registration of Marks of April 14, 1891, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Nice on June 15, 1957, and at Stockholm on July 14, 1967 (Regulations of the Ministry of Foreign Affairs No. 65/1975 Coll. of Laws as amended).
Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks as amended (Notice of the Ministry of Foreign Affairs of the Slovak Republic No. 267/1998 Coll. of Laws of the Slovak Rep., as amended).
 - 2) Art. 1 of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (codified version) (Official Journal of the European Union L 154/1, 16.6.2017).
 - 3) Art. 6bis of the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967 (Regulations of the Minister of Foreign Affairs No. 64/1975 Coll. of Laws as amended by Regulations of the Minister of Foreign Affairs No. 81/1985 Coll. of Laws)
Art. 16 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (Notice of the Ministry of Foreign Affairs of the Slovak Republic No. 152/2000 Coll. of Laws of the Slovak Rep. on the conclusion of the Agreement establishing the World Trade Organization).
 - 4) Paris Convention for the Protection of Industrial Property.
 - 5) Agreement establishing the World Trade Organization (Notice of the Ministry of Foreign Affairs of the Slovak Republic No. 152/2000 Coll. of Laws of the Slovak Rep. on the conclusion of the Agreement establishing the World Trade Organization).
 - 6) Art. 39 and 40 of the Regulation (EU) 2017/1001 of the European Parliament and the Council.
 - 7) Art. 6ter of the Paris Convention for the Protection of Industrial Property.
 - 7a) For example, Art. 3 of the Lisbon Agreement on the Protection of Appellations of Origin and their International Registration of October 31, 1958, as revised at Stockholm on July 14, 1967 (Regulations of the Minister of Foreign Affairs No. 67/1975 Coll. of Laws), Art. 23 par. 2 of the Agreement on Trade-Related Aspects of Intellectual Property, the Act No. 469/2003 Coll. of Laws of the Slovak Rep. on designations of origin of products and geographical indications of products and on alterations of and additions to certain laws as amended, Art. 23 of the Regulation (EC) No 110/2008 of the European Parliament and of the Council of 15 January 2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks and repealing Council Regulation (EEC) No 1576/89 (Official Journal of the European Union L 39/16, 13.2.2008) as amended, Commission regulation (EC) No 607/2009 of 14 July 2009 laying down certain detailed rules for the implementation of Council Regulation (EC) No 479/2008 as regards protected designations of origin and geographical indications, traditional terms, labelling and presentation of certain wine sector products (Official Journal of the European Union L 193/60, 24.7.2009) as amended, Art. 14 and 24 par. 1 of the Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs (Official Journal of the European Union L 343/1, 14.12.2012) as amended, Art. 102 of the Regulation (EU) No 1308/2013 of the European Parliament and of the Council of 17 December 2013 establishing a common organisation of the markets in agricultural products and repealing Council Regulations (EEC) No 922/72, (EEC) No 234/79, (EC) No 1037/2001 and (EC) No 1234/2007 (Official Journal of the European Union L 347/671, 20.12.2013) as amended.
 - 8) For example, section 1b of the Act No. 369/1990 Coll. of Laws on municipalities as amended by Act No. 453/2001 Coll. of Laws of the Slovak Rep.
 - 8a) For example, the Council Regulation (EC) No. 2100/94 of 27 July 1994 on Community plant variety rights (Official Journal of European Communities L 227, 1.9.1994) as amended, the Act No. 202/2009 Coll. of Laws of the Slovak Rep. on the legal protection of plant varieties, the International Convention for the Protection of New Plant Varieties (Notice of the Ministry of Foreign Affairs of the Slovak Republic No. 351/2009 Coll. of Laws of the Slovak Rep.).
 - 9) Sections 11 to 16 of the Civil Code.
 - 10) For example, the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, the Act No. 444/2002 Coll. of Laws of the Slovak Rep. on designs as amended, the Act No. 469/2003 Coll. of Laws of the Slovak Rep. as amended, the Regulation (EC) No. 110/2008 of the European Parliament and the Council as amended, the Regulation (EU) 1151/2012 of the European Parliament and the Council as amended, the Regulation (EU) 1308/2013 of the European Parliament and the Council as amended.
 - 10a) Act No. 307/2016 Coll. of Laws of the Slovak Rep. on reminder proceedings and on additions to some laws.
 - 10b) Section 137 to 142 of the Civil Code.
 - 10ba) Art. 18 of Regulation (EU) No. 2017/1001 of the European Parliament and the Council.
 - 10bb) Section 4 of the Act No. 147/2001 Coll. of Laws of the Slovak Rep. on advertising and on alterations of and additions to certain laws, as amended.
 - 10bc) Act No. 486/2013 Coll. of Laws of the Slovak Rep. on customs enforcement of intellectual property.
Regulation (EU) No 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights and repealing Council Regulation (EC) No 1383/2003 (Official Journal of the European Union L 181, 29.6.2013).
 - 10c) Section 442a of the Civil Code.
 - 10d) Section 25 of the Code of Contentious Civil Procedure.
 - 12) Section 324 to 345 of the Code of Contentious Civil Procedure.
 - 12a) Section 340 of the Code of Contentious Civil Procedure.
 - 12b) Art. 60 par. 1, 3 or 4, Art. 61 par. 1 or 2 or Art. 64 par. 2 of Regulation (EU) 2017/1001 of the European Parliament and of the Council.
 - 13) Agreement on the participation of the Czech Republic, the Republic of Estonia, the Republic of Cyprus, the Republic of Latvia, the Republic of

Lithuania, the Republic of Hungary, the Republic of Malta, the Republic of Poland, the Republic of Slovenia and the Slovak Republic in the European Economic Area (Notice of the Ministry of Foreign Affairs of the Slovak Republic No. 266/2004 Coll. of Laws of the Slovak Rep.), Agreement on the participation of the Republic of Bulgaria and Romania in the European Economic Area and four related agreements (Notice of the Ministry of Foreign Affairs of the Slovak Republic No. 122/2008 Coll. of Laws of the Slovak Rep.).

14) For example, section 116 of the Commercial Code, section 483 of the Civil Code, Act No. 111/1990 Coll. of Laws on the state-owned enterprise, as amended.

15a) For example, section 514 of the Commercial Code.

15b) Sections 508 to 515 of the Commercial Code.

15c) Section 151d(4) of the Civil Code.

16) Section 151a to 151md and section 552 of the Civil Code.

17) Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15, 1957, as revised at Stockholm on July 14, 1967, and at Geneva on May 13, 1977 (Regulations of the Minister of Foreign Affairs No. 118/1979 Coll. of Laws as amended by the Regulations of the Minister of Foreign Affairs No. 77/1985 Coll. of Laws).

18) Art. 4 letter D section 3 of the Paris Convention for the Protection of Industrial Property.

19) Sections 44 to 52 of the Commercial Code.

19a) Sections 52 and 113a of the Rules of Execution.

20) Art. 9quinquies of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

22) Treaty between the Kingdom of Belgium, the Kingdom of Denmark, the Federal Republic of Germany, the Hellenic Republic, the Kingdom of Spain, the French Republic, Ireland, the Italian Republic, the Grand Duchy of Luxembourg, the Kingdom of the Netherlands, the Republic of Austria, the Portuguese Republic, the Republic of Finland, the Kingdom of Sweden, the United Kingdom of Great Britain and Northern Ireland (Member States of the European Union) and the Czech Republic, the Republic of Estonia, the Republic of Cyprus, the Republic of Latvia, the Republic of Lithuania, the Republic of Hungary, the Republic of Malta, the Republic of Poland, the Republic of Slovenia and the Slovak Republic, concerning the accession of the Czech Republic, the Republic of Estonia, the Republic of Cyprus, the Republic of Latvia, the Republic of Lithuania, the Republic of Hungary, the Republic of Malta, the Republic of Poland, the Republic of Slovenia and the Slovak Republic to the European Union (Notice of the Ministry of Foreign Affairs of the Slovak Republic No. 185/2004 Coll. of Laws of the Slovak Rep.).

23) Art. 110 of the Regulation (EU) 2017/1001 of the European Parliament and the Council.

25) Art. 140 of the Regulation (EU) 2017/1001 of the European Parliament and the Council.

26) Act No. 586/2003 Coll. of Laws of the Slovak Rep. on the Bar and on alterations of and additions to the Act No. 455/1991 Coll. of Laws on trade entrepreneurship (Trade Act), as amended, as amended.

26a) Act No. 344/2004 Coll. of Laws of the Slovak Rep. on patent attorneys, on an amendment to Act No. 444/2002 Coll. of Laws of the Slovak Rep. on designs and Act No. 55/1997 Coll. of Laws of the Slovak Rep. on trade marks as amended by Act No. 577/2001 Coll. of Laws of the Slovak Rep. and Act No. 14/2004 Coll. of Laws of the Slovak Rep. as amended.

27) Act No. 71/1967 Collection of Laws of the Czechoslovak Socialist Rep. on administrative proceedings (Rules of Administrative Procedure) as amended.

28) Act of the National Council of the Slovak Republic No. 270/1995 Coll. of Laws of the Slovak Rep. on the state language of the Slovak Republic as amended.

28a) Act No. 305/2013 Coll. of Laws of the Slovak Rep. on the electronic form of the exercise of the powers of public authorities and on alterations of and additions to certain laws (e-Government Act) as amended.

28b) Art. 2 par. 2 of the Regulation (EU) No 910/2014 of the European Parliament and of the Council of 23 July 2014 on electronic identification and trust services for electronic transactions in the internal market and repealing Directive 1999/93/EC (Official Journal of the European Union L 257, 28.8.2014) as amended.

28c) Section 3(n) of the Act No. 305/2013 Coll. of Laws of the Slovak Rep. as amended by the Act no. 273/2015 Coll. of Laws of the Slovak Rep.

29) Act of the National Council of the Slovak Republic No. 145/1995 Coll. of Laws of the Slovak Rep. on administrative fees as amended.