

**STATE OFFICE OF INDUSTRIAL PROPERTY**

**LAW ON INDUSTRIAL PROPERTY**  
(as revised and amended)

**Skopje,**

# **LAW ON INDUSTRIAL PROPERTY**

## **BASIC PROVISIONS**

### **Contents of law**

#### Article 1

This law regulates the acquisition, exercising and protection of industrial property rights.

### **Industrial property rights**

#### Article 2

(1) Industrial property rights shall be patent, industrial design, trademark and appellation of origin and geographical indication.

(2) Patent shall be used for protection of invention.

(3) Industrial design shall be used for protection of new form of a body, picture, drawing, contours, composition of colors or a combination of these features-design.

(4) Trademark shall be used for protection of trade sign.

(5) Appellation of origin and geographical indication shall be used for protection of geographical name.

### **Definitions**

#### Article 3

Certain expressions used in this law have the following meaning:

- "industrial property rights" are rights from intellectual creations and economic connections in the field of industry and trade, as well as agriculture under Article 2 paragraph 1 of this Law;

- "patent" is an industrial property right used for protection of an invention in a procedure provided for by this Law;

- "industrial design" is an industrial property right acquired in procedure for protection of design provided for by this law;

- "trademark" (mark for goods, service mark, collective mark and certification mark) is an industrial property right acquired in procedure for protection of trade sign provided for by this Law;

- "geographical indication" is an industrial property right acquired in procedure for protection of a geographical name provided for by this Law;

- "appellation of origin" is an industrial property right acquired in procedure for protection of a geographical name provided for by this Law;

- “invention” is a solution of a technical problem in the context of Article 19 of this Law referring to a product, process or substance per se which came as a result of specific process;
- “design” is a new form of a body, picture, contours, composition of colors, texture or combination of these features within the meaning of Article 82 of this Law;
- “trade sign” is a sign that can be presented graphically and fulfils the conditions under Article 124 of this Law;
- “geographical name” within the meaning of this Law is a name and/or indication of the country, region or place marking the product which originates from that region;
- “subjects of industrial property rights” are domestic or foreign legal and natural persons that acquired industrial property rights in a procedure provided for by this Law;
- “Paris Convention for Protection of Industrial Property” is the Convention passed 1883 that came into force 1884 as revised and amended (hereinafter: “Paris Convention”).
- “Patent Cooperation Treaty” is the Treaty signed June 19, 1970, as revised and amended (hereinafter PCT);
- “Madrid Agreement Concerning the International Registration of Marks” as revised and amended (hereinafter: Madrid Agreement);
- “Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks” as revised and amended (hereinafter: Nice Agreement);
- “Locarno Agreement Establishing an International Classification for Industrial Designs as revised and amended (hereinafter: Locarno Agreement);
- “Paris Union” is a union based on the Paris Convention;
- “Hague Agreement Concerning the International Application of Industrial Design”, Hague document of November 28<sup>th</sup>, 1960, as revised and amended (hereinafter as: The Hague Agreement);
- Agreement for Cooperation in the Field of Patents between the Government of the Republic of Macedonia and the European Patent Organization, as well as the provisions applied in the extension of the European patents from June 24<sup>th</sup> 1997 (hereinafter as The Extension Agreement);
- Protocol related to the Madrid Agreement Concerning the International Registration of Marks from June 27<sup>th</sup>, 1989 (hereinafter as: The Madrid Protocol);
- World Trade Organization, International organization established by the Marakesh Agreement (hereinafter as: WTO), and
- Convention Relating to International Exhibitions, signed in Paris, on 22 November 1928, last revised on May 31<sup>st</sup>, 1988 (hereinafter as: Convention on International Exhibitions).”

## **Principle of legality**

### Article 4

The rights recognized on the basis of this Law cannot be used contrary to the Constitution, the laws and the good business practice.

## **Subjects of industrial property rights**

### Article 5

(1) Subjects of industrial property rights are domestic and foreign legal and natural persons.

(2) Under this Law, foreign legal and natural persons in respect of protection of industrial property rights in the Republic of Macedonia shall enjoy the same rights as domestic legal and natural persons in conformity with international agreements and conventions or by application of the principle of reciprocity.

(3) The existence of reciprocity under paragraph (2) of this Article shall be prescribed by the Minister of Justice, under conditions and in procedure prescribed by law.

## **Rights of subjects of industrial property rights**

### Article 6

(1) The inventor of patent or author of industrial design has moral and economic rights on his creations prescribed by law.

(2) The subjects referred to in paragraph (1) of this Article, the owner of trademark, the authorized user of appellation of origin and the authorized user of the geographical indication also have other rights under international agreements and conventions, other laws, general acts and agreement.

## **Moral right**

### Article 7

(1) The inventor and the author shall have the moral right to be mentioned in the application and the documents referring to the patent and the industrial design.

(2) If the invention or the design comes as a result of the creative work of more than one person, they all shall have the right under paragraph (1) of this Article.

## **Exclusive right**

### Article 8

(1) The economic right of the owner of patent, industrial design and trademark includes the right for using, disposing, right for compensation and prohibition of unauthorized use by third person(s) in the cases and in a manner provided for by international agreements and conventions, this Law, other law and agreement.

(2) The owner of collective mark and the authorized users of appellation of origin and geographical indication shall have the rights under paragraph (1) of this Article, apart from the right for disposal.

## **Competent Institution**

### Article 9

“(1) A State Office for Industrial Property shall be established for the conduction of activities related to acquisition and protection of the industrial property rights (hereinafter as: Office).

(2) The Office shall be an administrative organization with a status of an independent body of the State Administration, having competencies provided for by this or other law.

(3) The Office has the capacity of a legal entity.

(4) The seat of the Office shall be in Skopje.”

## **Management**

### Article 9-a

(1) The Office shall be managed by a Director.

(2) The Director shall have a Deputy.

(3) The Director and the Deputy Director of the Office shall be appointed and dismissed by the Government of the Republic of Macedonia, with the right to be reappointed.

(4) The Director shall represent and present the Office.

## **Competencies**

### Article 9-6

The Office shall perform the following tasks:

- Reception of applications for the protection of industrial property rights;
- Conduct the administrative procedure leading to acquisition of industrial property rights;

- Maintenance of registers of acquired rights and other registers provided for by this law;
- Publication of an Official Gazette including all data regarding applied and recognized rights of industrial property;
- Performs the special examination for the representatives in the field of industrial property;
  
- Promotion of the industrial property protection;
- Represent the Republic of Macedonia and its interests in the international, European, and regional organizations for industrial property;
- Initialize the procedure for ratification of international agreements and assume responsibility for fulfillment of the obligations in the field of industrial property arising from the international agreements ratified by the Republic of Macedonia;
- Cooperation with other entities included in the system for protection of the rights of industrial property in the country and abroad;
- Perform other activities prescribed by the law.

## **Financing**

### Article 9-c

- (1) The Office shall be financed from its own revenues.
- (2) The revenues realized from its operations the Office shall use to cover the expenses for the current operation, development and for employee salaries.
- (3) The surplus of the Office revenues shall be transferred on to the Budget of the Republic of Macedonia.

## **Revenues**

### Article 9-d

The Office realizes its revenues from the activities performed according to the Madrid Agreement, the Madrid Protocol, the Hague Agreement, the Extension Agreement, as well as from collection of fees for the administrative procedure and remunerations for the information services that it performs.

## **Relationships between the Office its clients and/or other entities**

### Article 9-e

In the realization of its activities the Office cooperates with other State bodies, legal and physical entities, and exchanges information with appropriate

foreign or international authorities, unless otherwise prescribed by law for certain type of information exchange.

## **Report**

### Article 9-f

The Office submits, at least once a year, a report for its activities to the Government of the Republic of Macedonia”.

## **Registers and Official Gazette of the Office**

### Article 10

(1) The Office keeps registers of applications, registers of recognized industrial property rights and registers of representatives in the field of industrial property.

(2) Subsequent changes related to the applicant, the holder of the right, and the right itself are also recorded in the registers.

(3) The registers referred to in paragraph (1) of this Article shall be open to the public.

(4) The data on the applied for protection and recognized industrial property rights shall be published in the Official Gazette issued by the Office under the provisions of this Law.

## **Types of applications for industrial property right protection**

### Article 11

(1) Protection of industrial property rights in the Republic of Macedonia shall be sought by filing the adequate application to the Office.

(2) The Office shall also accept applications requiring protection of industrial property rights abroad if that is in accordance with the international agreements and conventions which have been ratified by the Republic of Macedonia.

(3) Protection of industrial property rights may also be required in the Republic of Macedonia with an application filed abroad, if that is in accordance with the international agreements and conventions, which have been ratified by the Republic of Macedonia.

(4) The applicant referred to in paragraph (3) of this Article shall have the same rights as the national applicants, unless provided otherwise by the respective agreement or convention.

## **Filing application**

### Article 12

(1) Application for recognition of industrial property right shall be filed in writing, personally, by mail or by electronic means.

(2) Application for recognition of industrial property right may be filed in foreign language provided that it includes indication of the requested right and information for contact with the applicant in Macedonian language.

(3) If the application is filed in a foreign language, within 90 days from the date of filing the application in a foreign language, the applicant must submit translation of the application in Macedonian language. Otherwise, the application shall be deemed to be withdrawn.

## **Administrative procedure**

### Article 13

(1) In the administration procedure for acquisition, exercising, maintenance and protection of industrial property rights the Office shall decide in first instance.

(2) The Office, in its administrative procedure, shall act according to the provisions of this law and the regulations issued in compliance with this law, and all issues not provided for in this law shall be governed by the Law on General Administrative Procedure.

## **Appeal to first instance decision**

### Article 14

(1) The applicant shall have the right to appeal to a first instance decision issued by the Office to a Commission of the Government of the Republic of Macedonia.

(2) The Commission referred to in paragraph (1) of this Article shall consist of five members appointed by the Government of the Republic of Macedonia who shall be scientists and experts in the field of industrial property right.

(3) Members of the Commission under paragraph (1) of this Article may not be persons who are registered representatives in the field of industrial property, lawyers, legal agents of trade companies or other persons who may have any interest in acquisition, exercising and protection of industrial property rights.

## **Procedure in accordance with international agreements**

### Article 15

The Office shall perform the procedure referring to applications under Article 11 paragraphs (2) and (3) of this Law in accordance with the international agreements which have been ratified by the Republic of Macedonia.

## **Exercising rights through representative**

### Article 16

In the procedure before the Office and the governmental administration bodies, the foreign legal or natural persons shall exercise their rights arising from this Law through a representative who is a domestic legal or natural person registered for representation in the field of industrial property.

## **Availability of Office documentation and information**

### Article 17

(1) The Office is obliged to make available to all interested legal and natural persons its documentation and information for applied for protection and protected industrial property rights, apart from the documentation which has not been published in the Official Gazette issued by the Office.

(2) Only information from the register of applications shall be available for the applications for industrial property right.

(3) Unpublished application may be made available only with consent of the applicant.

(4) The documentation and information referred to in paragraph (1) of this Article, as well as the other services related to protection of industrial property, shall be made available after paying specified expenses.

## **Fees and expenses**

### Article 18

(1) For acquisition and maintenance of industrial property right fees shall be paid under the Law on administrative fees, as well as specific expenses in the procedure for recognizing the right.

(2) The amount of the specific expenses of the procedure from paragraph (1) of this article, and the expenses for the provision of information services from article 17, paragraph (4) of this law, shall be prescribed by the Director of the Office and approved by the Government of the Republic of Macedonia.

## **PART ONE**

### **PATENT**

#### **Patentable invention**

##### Article 19

(1) Patent shall be granted for invention in all fields of technique and technology which is new, involves inventive step and is susceptible of industrial application.

(2) The following in particular shall not be considered to be inventions within the meaning of paragraph (1) of this Article:

1. discovery, scientific theory and mathematical method;
2. esthetic creation;
3. plan, rule and procedure for performing intellectual activity, playing games or doing business, as well as computer program;
4. presentation of information.

(3) Exception to the object of protection under paragraph (2) of this Article shall be possible only if the subject matter of the patent application does not refer to some of those objects per se.

#### **Exceptions to patentability**

##### Article 20

(1) The following shall be excluded from protection by patent:

- inventions related to new animal and plant varieties and essentially biological processes for production of animals or plants, apart from inventions related to microbiological processes and products from such processes;

- inventions for surgical and diagnostic methods or method for treatment of living human or animal body, apart from inventions related to a product, in particular substances or compositions used for application of any of these methods;

- inventions the publishing or exploitation of which would be contrary to the order public or morality, where exploitation of invention shall not be deemed as such only because of the fact that it is prohibited by law.

## **Novelty of invention**

### Article 21

(1) Invention shall be considered to be new if it does not form part of the state of the art.

(2) The state of the art shall be held to comprise everything made available to the public by means of oral or written description of the invention, by use or in any other way before the date of filing the patent application in a manner which allows to be applied by experts skilled in the art.

(3) The state of the art under paragraph (2) of this Article shall also include:

- the contents of national patent applications, as originally filed in the Office, apart from patent applications that have been rejected or withdrawn;

- - the European patents, as recognized by the European Patent Office according to the European Patent Convention, for which protection is requested on the territory of the Republic of Macedonia, according to the Extension Agreement

- International applications, as originally filed under the PCT filed to the Office as elected institution.

(4) The provisions from paragraphs (2) to (3) of this Article shall not exclude from patentability any substance or composition comprised in the state of the art where it is intended for use in method or treatment referred to in Article 20 paragraph (1) item 2 of this Law, provided that such use is not comprised in the state of the art.

## **Non-prejudicial disclosures**

### Article 22

(1) While estimating whether the invention is new under Article 21 of this Law, the fact that the invention was available to the public six months prior to the filing of the application shall not be taken into consideration if it was due to or in consequence of:

- evident abuse in relation to the applicant or his legal predecessor, or
- the fact that the applicant or his legal predecessor had displayed the invention at an official or officially recognized exhibition falling within the terms of the Convention on International Exhibitions

(2) The provision under paragraph (1) item 2 of this Article shall be applied only if while filing the application the applicant indicates that the invention had been displayed and submits written certificate issued by the competent authority of the state where it was exhibited.

## **Inventive step**

### Article 23

(1) Invention shall be considered to involve an inventive step if, having regard to the state of the art within the meaning of Article 21 of this Law, it is not obvious to a person skilled in the art.

(2) The applicant may renounce the initial application and file a new application for the same invention and, in that case, the first application shall not be taken into consideration in deciding whether there has been an inventive step in the later application.

## **Industrial application**

### Article 24

An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.

## **Persons entitled to acquire a patent**

### Article 25

(1) The right to a patent shall belong to the inventor or his successor in title.

(2) If the invention has been created jointly, by several inventors, the right to patent shall belong to all inventors or their successors in title.

## **Inventor**

### Article 26

(1) Inventor shall be the person who had created the invention in the course of his creative work.

(2) The person who has contributed to the creation of an invention by providing only technical assistance shall not be deemed to be inventor.

## **Inventor's successor in title**

### Article 27

(1) Inventor's successor in title shall be legal or natural person entitled to acquire a patent right by virtue of law, legal business, inheritance or court decision.

(2) The employer shall be considered to be inventor's successor in title where by virtue of law or employment contract he has the right to acquire patent for invention created under inventor's employment.

## **Initiation of procedure**

### Article 28

(1) Patent granting procedure shall be initiated by filing a patent application to the Office.

(2) Patent granting procedure may also be initiated by the filing of applications in compliance with PCT, and applications filed according to the Extension Agreement

## **Unity of invention**

### Article 29

(1) Each invention shall be filed as separate patent application.

(2) One patent application may contain more than one invention linked in such a way as to form a single inventive concept.

(3) The contents of the application that fulfills the condition for unity of invention shall be prescribed by a regulation issued by the Director of the Office

## **Priority right**

### Article 30

(1) As from the date of filing a proper patent application in the Office, the applicant shall have priority right to any other person who shall later file an application for the same invention.

(2) Exception to paragraph (1) of this Article shall be the case when the conditions for recognition of union or exhibition priority right under Articles 31 and 32 of this Law are fulfilled.

### **Exhibition priority right**

#### Article 31

(1) A person who has exhibited an invention at an officially recognized international exhibition or fair in the Republic of Macedonia or in any of the states member of the Paris Union or the WTO may claim in his application that the date of the first day of exhibition of the invention be accorded as priority date within 90 days from date of the closing of the exhibition or fair.

(2) The application referred to in paragraph (1) of this Article shall be accompanied by a certificate issued by a competent authority of the state member of the Paris Union or the WTO proving that the exhibition or fair was recognized within the meaning of the Convention for International Exhibitions and shall indicate the type of exhibition or fair, its place, its opening and closing date or the date of use.

### **Union priority right**

#### Article 32

(1) Any legal or natural person who had filed a proper patent application in any of the state member of the Paris Union or WTO shall be granted priority right in the Republic of Macedonia from the date of filing the first application if that is claimed within 12 months of the filing date of the first application.

(2) The application referred to in paragraph (1) of this Article shall be considered proper if the filing date is prescribed under the national legislation of the state member of the Paris Union or the WTO in which it was filed or in accordance with the international agreements made between the states member of the Union or WTO, regardless of the future legal outcome of the application.

### **Obligations of applicant for union priority**

#### Article 33

(1) The applicant who intends to use the priority right referred to in Article 32 of this Law shall be obliged in the application filed in the Republic of Macedonia to give all information on the application the priority to which is claimed and, no later than 90 days from the date of filing the application, to submit a priority document certified by the competent authority of the state member of the Paris Union or the WTO in which the first application was filed.

## **Multiple priority right**

### Article 34

(1) The applicant may file a claim for grant of multiple priority right on the basis of several earlier applications filed in one or more states member of the Paris Union or the WTO.

(2) Where multiple priority right is claimed, the time limits under this Law shall run from the date of granted priority right starting from the earliest date of multiple priority right.

## **Scope of priority claim**

### Article 35

(1) The priority claim shall relate only to such characteristics of the invention which are contained in the first application or applications for which priority is claimed.

(2) If certain characteristics of the invention do not appear among the patent claims contained in the first application or applications for which priority is claimed, it shall be sufficient for recognition of priority right that all other documents of application as a whole specifically disclose such characteristics.

## **Priority Certificate**

### Article 36

(1) On request of the applicant, the Office shall issue a Priority Certificate as of the date accorded as filing date of the patent application.

(2) The contents and form of the request and the Priority Certificate shall be prescribed by the regulation issued by the Director of the Office .

## **Amendments in patent application**

### Article 37

Patent application with accorded filing date may not be additionally amended by extending the object for which protection is required.

## **Contents of patent application**

### Article 38

(1) Patent application shall contain:

1. request for grant of patent;
2. description of the invention;
3. one or more patent claims;
4. brief contents of the essence of the invention (abstract);
5. drawing (if necessary) referred to in the description and the patent claim;
6. evidence for paid application fee;
7. translation in Macedonian language if the application was filed in foreign language.

(2) Other components and supplements shall be delivered together with the Application from paragraph 1.

(3) The contents and form of the application and other components and supplements added to the application shall be prescribed by the regulation issued by the Director of the Office.

## **Contents of request for grant of patent**

### Article 39

(1) The request for grant of a patent shall contain:

- an express indication that grant of a patent is required,
- title of the invention expressing the essence of the invention,
- indications concerning the applicant and the inventor.

(2) A written declaration of the inventor, in case he does not want to be mentioned in the application, shall be filed to the Office within 60 days from the filing date of the application.

## **Disclosure of invention**

### Article 40

(1) The description of the invention must disclose the invention in a manner sufficiently clear and precise for it to be carried out by a person skilled in the art in that field.

## **The claims**

### Article 41

(1) Patent claims shall define the subject matter for which protection is sought.

(2) Patent claims shall be clear and fully contained in the description of the invention.

(3) Patent claims may be independent and dependent.

(4) The independent claims shall contain new, essential characteristics of an invention.

(5) The dependent claims shall contain specific characteristics of the invention defined in the independent or other dependent claim.

## **The Abstract**

### Article 42

Abstract shall be a short summary of the essence of an invention serving exclusively for information on the invention.

## **Filing date requirements**

### Article 43

(1) The Establishment of the filing date of the patent application shall require that on such a date the application contains:

1. request for grant of patent;
2. name or company name and residence or business seat of the applicant;
3. description of an invention and one or more patent claims.

## **Accordance of filing date of application**

### Article 44

(1) If the application does not contain all elements provided for in Article 43 of this Law, the Office shall notify the applicant that his application is not proper and that filing date cannot be accorded.

(2) If the filing date of the application cannot be accorded, the Office shall invite the applicant to correct the deficiencies referred to in paragraph (1) of this Article within 60 days from the day of receipt of the notification.

(3) If the applicant removes the deficiencies in the prescribed time limit, the Office shall establish the filling date of the Application.

(4) Filing date shall be considered to be the date of reception of a proper application within the meaning of Article 43 of this Law submitted by the applicant under the notification.

(5) If the applicant fails to correct the deficiencies within the prescribed time limit, the application shall be rejected by conclusion.

### **Register of patent applications**

#### Article 45

(1) A patent application for which the filing date has been accorded by a decision shall be entered into the Register of Patent Application kept by the Office.

(2) The contents and manner of maintenance of the Patent Application Register and the excerpt from the Register shall be prescribed with the regulation issued by the Director of the Office.

### **Division of patent application**

#### Article 46

(1) The applicant may divide the subject matter of the patent application having accorded filing date (the original application) into two or more applications and separate procedure shall be carried out on the basis of each of them.

(2) Division of the original patent application shall be possible until the issuing of the decision for grant of patent.

(3) Patent application resulting from division of the original application (a divisional application) shall maintain the filing date of the original application and enjoy the priority thereof.

(4) The contents and form of the divisional application shall be prescribed by the regulation issued by the Director of the Office.

### **Formal examination of the Application**

#### Article 47

(1) After the entering of the patent application in the register of patent applications, the Office shall examine whether:

1. the filing fee for the application has been paid;
2. translation of the application in Macedonian language has been filed, where the application is in a foreign language;
3. the drawings referred to in Article 38 paragraph (1) item 5 of this Law have been filed;
4. proper power of attorney has been filed, where the application was filed through a representative.

(2) If the patent application does not contain all basic elements referred to in paragraph (1) of this Article, the Office shall invite the applicant to correct the prescribed deficiencies within 60 days from the day of receipt of the invitation.

(3) On reasoned request of the applicant, the time limit referred to in paragraph (2) of this Article may be extended for justified reasons by no more than 60 days.

(4) If the applicant fails to correct the prescribed deficiencies referred to in paragraph (2) of this Article within the prescribed time limit, the Office shall reject the patent application by issuing a conclusion.

(5) Where a patent application refers to drawings which are not included in the application, the Office shall notify the applicant that he may file them within the prescribed time limit.

(6) If the applicant does not comply with the notification of the Office referred to in paragraph (5) of this Article, any reference to the drawings shall be considered to be non-existent.

(7) If the applicant corrects the application within the time limit, the application shall be deemed to be proper.

### **Processing patent application in case of dispute**

#### Article 48

(1) In case of dispute regarding the right from the patent application, the applicant may require the Office to process the application immediately.

(2) Request for immediate processing of the application may not be filed earlier than 12 months from the date of filing the patent application.

(3) In case of dispute referred to in paragraph (1) of this Article, the applicant shall submit evidence from substantive examination performed in one of the institutions for examination under this Law.

### **Examination of the patent application**

#### Article 49

The examination of the patent application shall establish whether the application complies with the following requirements:

1. whether the inventor has been mentioned;
2. whether a recognition of a priority right is requested according to articles 31 and 32 from this law;
3. whether the application complies with the rule on unity of invention under Article 29 of this Law;
4. whether the separate elements of application are in accordance with Articles 38,39,40,41 and 42 of this Law;
5. whether the subject matter of the application is at first sight patentable under Article 19 paragraph (2) and (3) and Articles 20, 21(3), and 24 of this Law.

## **Deficiencies of patent application**

### Article 50

(1) If the Office determines that the patent application does not meet all basic requirements under Article 49 of this Law, it shall notify the applicant of that fact in writing and invite him to correct the prescribed deficiencies within 60 days as of the day of receipt of the notification.

(2) On reasoned request of the applicant, the Office may extend the time limit referred to in paragraph (1) of this Article by no more than 60 days.

(3) The Office shall issue a conclusion for rejection of the patent application if the applicant fails to correct the deficiencies prescribed in the notification referred to in paragraph (1) of this Article 37 within the prescribed time limit.

## **Payment of expenses and fees**

### Article 51

(1) Where the patent application complies with the requirements under Article 49 of this Law, the Office shall issue a conclusion that the requirements for grant of a patent had been fulfilled and invite the applicant to pay the expenses for publication of the patent in the Official Gazette of the Office, the expenses for issuing a patent certificate and the maintenance fee within 30 days.

(2) The Office shall issue a conclusion for rejection of the patent application if the applicant fails to pay the expenses referred to in paragraph (1) of this Article.

## **Decision for grant of patent**

### Article 52

(1) If the applicant acts in compliance with the conclusion in the time limit set in Article 51 paragraph (1) of this Law, i.e. pays the prescribed fees and expenses, the Office shall issue a decision for grant of a patent for the first ten years of validity and invite the applicant within nine years to submit written evidence of substantive examination issued by institutions authorized for substantive examination.

(2) The data from the decision for grant of a patent shall be entered in the patents register at the day of issuing of the decision and shall be published in the Official Gazette of the Office within 90 days from the day of issuing.

## **Decision for refusal of patent application**

### Article 53

(1) The Office shall issue a decision for refusal of the claim for grant a patent if the application has been filed for an invention which is not patentable under Article 19 paragraph (2), Article 20, Article 21 paragraph (3), Article 22 and Article 24 of this Law.

(2) Decision for refusal of patent application shall not be issued if the applicant had not been previously notified in writing about the grounds on which the claimed right cannot be recognized and invited to make a declaration thereon in due time.

(3) The term from paragraph (2) of this article, upon an explained request from the applicant, may be extended to six months

## **Filing evidence of substantive examination**

### Article 54

(1) The patent-owner or owner of the exclusive right from patent is obliged to submit translation in Macedonian language of the evidence of substantive examination performed in one of the institution for examination within nine years from the date of filing the application in the Office.

(2) If the applicant filed an application for recognizing the same invention to the patent offices of other countries, he may submit as evidence the translation of the results from the substantive examination or the granted patent.

(3) If the patent-owner or owner of the exclusive right from patent does not act in compliance with paragraph (1) of this Article, the validity of the patent in question shall expire on the date of the expiring on the tenth year of the patent term.

(4) The patent-owner or owner of the exclusive right from patent is also obliged to submit the evidence referred to in paragraph (1) of this Article if a third party had instituted an action for infringement of patent rights.

(5) In the case referred to in paragraph (4) of this Article, the Office shall rule an expeditious procedure for issuing a decision for grant of patent, partial grant of patent or refusal of the claim for grant of patent.

(6) The contents of the evidence from the substantive examination shall be prescribed by the regulation issued by the Director of the Office

## **Institutions for substantive examination**

### Article 55

(1) The substantive examination of the patent application referred to in Article 56 shall be conducted in one of the institution for examination.

(2) The institution for examination referred to in paragraph (1) of this Article shall be as a rule national and international offices which under the PCT have the status of International Searching Authority or International Preliminary Examining Authority for international search or for preliminary examination of international patent applications.

### **Substantive examination**

#### Article 56

(1) Substantive examination determines whether the invention is in compliance with all requirements for grant of a patent right, i.e. whether the subject matter of the application is:

1. invention which is patentable under Articles 19 and 20 of this Law;
2. invention which has been described in a manner that can be applied by a person skilled in art under Article 40 of this Law;
3. invention which is in compliance with the rule of unity of invention under Article 29 of this Law;
4. invention which is new under Article 21 paragraphs (1), (2) and (4) and Article 22 of this Law, which contains an inventive step under Article 23 of this Law and is industrially applicable under Article 24 of this Law.

### **Additional examination**

#### Article 57

(1) The Office shall issue a decision for grant of patent on the basis of submitted evidence from the substantive examination under Article 54 paragraph (1) and (2) of this Law and on the basis of the additional examinations from this Article.

(2) The additional examination of a patent application shall establish whether the invention complies with the requirements for grant a patent, i.e. whether the subject matter of the application is:

1. invention which is not patentable in compliance with Article 19 paragraph (2) and Article 20 of this Law;
2. invention which is new with regard to all patent applications filed earlier to the Office in compliance with Article 21 paragraph (3) of this Law.

(3) The Decision from paragraph (1) of this article cannot be issued by the Office, if the holder of the patent had not been previously informed about the reasons why the requested right cannot be completely or partially recognized, and if he/she had not been called in due time to give a statement regarding the reasons.

(4) The term from paragraph (2) of this article, upon an explained request from the applicant, may be extended to six months

## **Decisions based on evidence from the substantive examination**

### **Article 58**

(1) On the basis of the filed evidence, the Office shall determine to what extent the contents and scope of the patent claims for the given invention comply with the requirements under Articles 21, 23 and 24 of this Law and it shall issue one of the following decisions:

1. decision that the invention complies with all requirements referred to in Articles 21, 23, and 24 of this Law and that patent claim(s) fully complies with those requirements;
2. decision that the invention only partially complies with the requirements referred to in Article 21, 23 and 24 of this Law and that it gives limited future validity of the patent claim(s) in the scope in which it complies with the requirements;
3. decision for declaring as nullity if the invention did not comply with the requirements from Articles 21,23 and 24 of this Law from the day of filing the patent application.

## **Patent Register**

### **Article 59**

(1) The data from the decision for grant a patent shall be entered into the patents register kept by the Office on the date of the decision.

(2) The data from the decision for rejection of patent application and for refusal of claim for grant a patent shall be entered into the register of patent applications.

(3) The contents and manner of maintenance of the Patent Register and the excerpt from the Registers shall be prescribed by the regulation issued by the Director of the Office.

## **Recording changes in the Register**

### **Article 59-a**

(1) Changes related to the applicant, holder of the right, and the right itself shall be recorded in the Application Register and in the Patent Register.

(2) The changes recorded, the contents and form of the request, as well as the procedure of recording the changes shall be prescribed by the regulation issued by the Director of the Office.

## **Publication**

### Article 60

(1) The data from the decision for grant a patent shall be published in the Official Gazette of the Office within 90 days from date of the decision of the grant thereof.

(2) Together with the data from the Decision issued according to article 52 of this law, the patent abstract shall also be published.

(3) The first patent claim shall be published together with the data of the Decision issued according to article 58 from this law, and the number of other patent claims shall be stated.

(4) The contents of the data on granted patent which are published in the Official Gazette of the Office shall be prescribed by the regulations issued by the Director of the Office.

## **Patent certificate**

### Article 61

(1) The patent-owner shall be issued a patent certificate within 6 months from the date of the decision on grant of patent.

(2) The Office shall issue a patent specification upon request of the holder of the patent.

(3) The contents of the certificates and the patent specification shall be prescribed by the regulations issued by the Director of the Office.

## **Patent for secret invention**

### Article 62

(1) The applications for grant of patent on invention referring to national defense shall be deemed to be secret and shall be filed to the Minister of Defense.

(2) The provisions under Articles 46, 47, 49, 50 and 51 of this Law shall apply mutatis mutandis in the procedure for grant of patent for secret invention, unless otherwise provided for by this Law.

(3) If in the procedure for examination of the filed application the Minister of Defense determines that the invention is not secret, the application shall be submitted to the Office.

(4) If in the course of procedure for examination of the application the Office determines that the invention is secret, it shall pass it on to the Minister of Defense.

(5) If the Minister of Defense determines that the invention ceased to be secret, the entire file shall be submitted to the Office.

(6) After receiving the patent, the Office shall enter the patent in the patents register, issue to the patent-owner a patent certificate and specification and publish the data under Article 60 of this Law.

### **Use of a Secret Invention**

#### Article 63

(1) The Ministry of Defense has an exclusive right to use the secret invention and to have the same at disposal.

(2) The holder of the right is entitled to a one time compensation for a secret invention protected by patent, regardless the fact whether the invention shall be used for the needs of the Defense and in what degree.

(3) The amount of the compensation from paragraph (2) of this article shall be prescribed by the applicant and the Minister of Defense.

(4) If both parties fail to reach an agreement, the applicant of the patent may require, according to the rules of exprocess procedure, the court to determine the amount of the compensation. “

### **Characteristics of a Secret Invention**

#### Article 64

(1) The patent for a secret invention shall not be published.

(2) The protection of a secret invention in a foreign country may be requested by the domestic legal and natural persons, only by a written approval from the Minister of Defense.

(3) The provisions from articles 62 and 63 from this article apply accordingly to the patent applications for recognition of inventions that are in the interest of the State security.

(4) The Minister of Internal Affairs is competent for deciding upon the applications from paragraph (3) of this article.

(5) The Government of the Republic of Macedonia shall prescribe, with a special provision, which invention shall be considered as secret in context of articles 62 and 64 from this law, as well as the manner for recognition of a patent for those inventions.

### **Term of a patent**

#### Article 65

(1) The term of patent shall be twenty years as from the filing date of the patent application.

(2) The term of patent under paragraph (1) of this Article may be extended for over twenty years if the subject matter of the patent is a medical product or a product for protection of plants or process for their production which has to undergo an administrative authorization procedure required by law before it can be put on the market, but no for more than 5 years.

### **Supplementary protection certificate**

#### Article 66

(1) The term of the patent under Article 65 paragraph (2) of this Law may be extended by issuing a supplementary protection certificate.

(2) The procedure for issuing supplementary protection certificate shall be prescribed by the regulations issued by the Director of the Office.

### **Payment of fees**

#### Article 67

(1) Before issuing a decision for grant of patent, the Office shall invite the patent-owner to pay the total amount of fees for maintenance of the patent right for the period from the filing date of the application to the date of the grant of patent.

(2) The annual maintenance fee for the forthcoming period shall be due on the date corresponding to the filing date of the patent application.

### **Ceasing of patent before expiration of validity**

#### Article 68

(1) A patent right shall cease before the expiration of its validity date:

1. if the prescribed fees are not paid, the day after the expiration of the time limit for payment thereof;
2. if the patent-owner renounces his right, the day after the filing of the request for renouncing to the Office;
3. on the basis of court decision or act of the Office in cases provided for by this Law, at the day prescribed in the decision or act;
4. with the lapse of the legal person or upon the death of the natural person who is the patent-owner, on the day of lapse or death, or with the declaration of a missing patent-owner dead, on the day of the coming into force of the declaration, unless the right has been

transferred to the legal successors in title of the legal person or to the heirs of the natural person;

5. If the patent-owner or the owner of exclusive right from patent does not comply with Article 52 paragraph (1) and Article 54 of this Law, the validity of the patent shall expire on the date of the expiring of the tenth year of the patent term.

## **Rights of third person**

### Article 69

(1) If license, pledge or any other right of a third person has been entered into the patent register, the patent-owner may not renounce his rights without written consent from the person who is signatory of the license, pledge or other right.

(2) If the patent-owner fails pay the fee within the prescribed time limit and the license, pledge or any other right of a third person has been entered into the patents register, the Office shall notify the third person that the fee had not been paid and that in order to keep his right he shall have to pay the fee within six months from the date of the notification.

(3) In case of a dispute regarding transfer of the registered rights to a third party, if that is necessary for provision of those rights, the court may decide that the patent right should be transferred to the person holder of a license, guarantee of a loan or other right until the fulfillment of the obligations.

## **Exclusive rights**

### Article 70

(1) The patent-owner shall have:

1. exclusive right to use the protected invention in production;
2. exclusive right to put on the market objects produced according to the protected invention;
3. right to dispose of the patent;
4. right to prohibit use of the protected invention in production or in trade by third person(s) who did not have his consent for that.

(2) The right under paragraph (1) of this Article refers to a patent for process and the product obtained directly by that process.

## **Free use**

### Article 71

The patent-owner's right under Article 70 of this Law for exclusive exploitation of the invention shall not apply to:

1. acts in which the invention is exploited for private and non-commercial purposes;
2. acts done for the purpose of research and development of the subject matter of the protected invention, in particular: making, using, offering for sale, import or export of protected invention, where such acts are reasonably connected with experiments and tests necessary for registration of human and veterinary medications, medical and veterinary products or preparations for protection of plants;
3. direct and individual preparation of medicine in pharmacy on the basis of an individual medical prescription and acts relating to the medicine so prepared.

## **Process patent**

### Article 72

(1) If the patent was issued for a process, its rights shall also refer to the products and substances directly obtained by that process.

(2) In absence of proof to the contrary, it shall be deemed that the product have been obtained by a protected process if the product is new or there is a reasonable doubt that the product was obtained by a protected process and that the patent-owner was not able to determine the process actually used in spite of the reasonable efforts.

(3) It shall be deemed that there is reasonable doubt that the product was obtained by protected process if the protected process is the only known process.

(4) The burden of the proving referred to in paragraph (1) of this Article shall fall on the alleged infringer only if one of the conditions referred to in paragraph (2) of this Article is fulfilled.

## **Scope of exclusive rights**

### Article 73

The scope of the exclusive rights of the patent-owner shall be prescribed with the text of the patent claims which have been finally accepted in the patent granting procedure, where the description and the drawings shall be used for interpreting the patent claims.

## **Right based on prior use**

### Article 74

(1) The patent right shall have no effect on the person who used the invention prior to the filing date of the application or the date of recognized priority right in good faith and not publicly in the Republic of Macedonia or performed preparation necessary for use thereof.

(2) The person referred to in paragraph (1) of this Article shall have the right, without consent from the patent-owner, to continue using the invention to the extent to which it was used or prepared for using until the filing date of the application for the invention.

## **Exception from infringement of patent right**

### Article 75

It shall not be considered as an injury of the exclusive rights of the patent owner, if the subject of the invention applies to the products prepared according to the patent, used in construction or equipment for ships, airplanes or road vehicles that belong to some of the countries from the Paris Union or WTO, when that vehicle temporarily or accidentally is on the territory of the Republic of Macedonia, under the condition that the integrated product serves exclusively for the purposes of that vehicle.

## **Compulsory license**

### Article 76

(1) If the patent-owner does not exploit the protected invention or exploits it to the extent which is insufficient to satisfy the needs of the Macedonian market, and refuses to conclude a license agreement or sets forth non-market conditions for conclusion of such agreement, the right of use of the invention may be given to another person with obligation to pay remuneration to the patent-owner.

(2) Compulsory license shall not be given if the patent-owner proves the existence of legitimate reasons justifying the non-exploitation or insufficient exploitation of the protected invention.

## **Request for a compulsory license**

### Article 77

(1) A request for a compulsory license cannot be put forward before expiry of the period of four years from the filing date of the Patent application, i.e.

before expiry of the period of three years from the date of granting of the patent, if this period is of later expiry date.

(2) If the benefit from the protected invention is of a public interest, such as: health, defense, protection, promotion of the environment or is of special interest for a certain economic field, the compulsory license may be given before expiry of the period from paragraph (1) of this article.”

### **Processing of a request for a compulsory license**

#### Article 78

The request for issue of a compulsory license shall be decided upon by the court in a litigation procedure, on the bases of previously supplied opinion from a State body of the State Administration competent for issues from the field relevant for the license.

### **Remuneration**

#### Article 79

(1) Where compulsory license is granted, the patent-owner has the right to adequate remuneration.

(2) The amount of the remuneration is agreed by the patent-owner and the user to whom the license was granted, i.e. who shall be using the invention protected with patent.

(3) If agreement is not achieved, the amount of the remuneration shall be prescribed by the competent court.

(4) The absence of agreement or court decision referred to in paragraph (3) of this Article shall not prevent the person who was granted license from exploiting the invention.

### **Duration of compulsory license**

#### Article 80

(1) Compulsory license shall not be exclusive.

(2) The duration of the compulsory license shall be connected exclusively with the duration of the reasons it had been granted for.

(3) The compulsory license shall not be transferable.

## **Compulsory license of dependant patent**

### Article 81

(1) Compulsory license may also be granted if the invention protected by patent cannot be exploited fully or partially without using some other invention protected with previous patent where the later invention, which is a more significant technical progress, is of particular significance to state economy or for supplying the general needs.

(2) If compulsory license is granted under paragraph (1) of this Article, the owner of the former patent may request compulsory license for exploiting the invention of the later patent.

### **Applications filed to the Office in the capacity of a receiving Office, according to the PCT**

#### Article 81-a

(1) International applications filed to the Office as a reception office according to the PCT, shall be governed by the provisions of the PCT and by the provisions of this law.

(2) The application from article (1) of this article shall be submitted in English language.

(3) The contents and form of the request for the applications from paragraph (1) of this article shall be prescribed by the regulation issued by the Director of the Office.

### **Applications for which the Office is designated or elected according to the PCT**

#### Article 81-b

(1) The provisions from the PCT, and the provisions from this law, shall be applied to the applications filed to the Office as a designated or elected office according to the PCT.

(2) The contents and form of the request for the applications from paragraph (1) of this article shall be prescribed by the regulation issued by the Director of the Office.

### **Applications that are filed according to the Extension Agreement**

#### Article 81-c

(1) The provisions from the Extension Agreement, and the provisions from this law shall apply for the applications that are submitted according to the Extension Agreement

(2) The contents and form of the request for the applications from paragraph (1) of this article shall be prescribed by the regulation issued by the Director of the Office.

## **PART TWO**

### **INDUSTRIAL DESIGN**

#### **Object of protection**

##### Article 82

(1) Industrial design right shall protect new appearance of body, picture, drawing, contours, composition of colors, texture, or combination of these features applicable on certain industrial or handcraft products or part thereof to the extent that it fulfils the requirements as to novelty and individual character.

(2) For the purpose of this Law, the term "design" shall be use for new appearance of body, picture, drawing, contours, composition of colors, texture, or combination of these features applicable on certain industrial or handcraft products or part thereof to the extent that it fulfils the requirements as to novelty and individual character.

#### **Product and parts of product**

##### Article 83

(1) The product under Article 82 paragraph (1) of this Law shall be any industrial or handcraft object, including parts intended for incorporation in a complex product.

(2) Under this Law, the product shall be complex where it consists of different physical parts united in one physical unit, as well as a number of independent parts that form that unit.

(3) The design transferred to a product, which is intended for an integration into another more complex product, may be protected as an industrial design, if the integrated part, for which protection is requested, remains visible in normal use of the complex product, and when the visible design of the integrated part, independently fulfils the requirements for novelty and individual character.

(4) Normal use referred to in paragraph (3) of this Article shall refer to use with purpose by the user of the product and shall not apply to maintenance and repairing of the product.

## **Novelty of design**

### Article 84

(1) A design of product shall be considered new under this Law if it is essentially different from any design previously applied for protection or made available to the public prior to the filing date of the application, except if the application was withdrawn before the publication of the decision for grant of industrial design right.

(2) The design shall be deemed to have been made available to the public if it has been published as application or granted industrial design right, if it has been exhibited or used in trade or if it has been disclosed otherwise in the normal course of business that has made it known to the relevant business circles specialized in the given field.

(3) The fact that the filed design was made available to the public no more than six months prior to the filing date of the application without consent from the applicant shall not influence the assessment of novelty and individual character.

## **Individual character**

### Article 85

(1) Designs of products shall be considered identical when if features differ only in insignificant details.

(2) Design of product shall be considered to have individual character if a skilled person can immediately notice individual character compared to any design which was previously made available to the public.

(3) Design of product shall not be considered to have individual character for the sole fact that its application refers to other industrial or handcraft products or parts thereof.

## **Absolute grounds for refusal**

### Article 86

(1) An industrial design right shall not protect a design of product which:

- 1) is contrary to law or morality;
- 2) presents technical plan or scheme;
- 3) exclusively presents cartographic or photographic work;
- 4) contains national coat of arms or any other public coat of arms, flag or emblem, name or abbreviated name of a country or international organization, unless with consent from competent authority of that country or organization;
- 5) contains or imitates appearance of a famous person, unless with consent from that person or the government body competent for

general administrative affairs in the case of a deceased famous person;

(2) The Ministry of Justice shall be the competent body for the Republic of Macedonia for issuing the permit from paragraph (1), items 4), and 5).

### **Relative grounds for refusal**

#### **Article 87**

(1) An industrial design right may not protect design of product:

1) which is not new under Article 84 of this Law;

2) which has no individual character under Article 85 of this Law;

3) which is exclusively dictated by the type of that product or the product in which it is incorporated, or by the technical or functional characteristics necessary for achievement of a certain technical result or normal function of any of those products;

4) which infringes previously granted rights of the holder.

(2) Grounds for exclusion from protection by industrial design right under paragraph (1) item 4 of this Article may be invoked only by the applicant of earlier application or the owner of earlier right.

### **Applicant**

#### **Article 88**

(1) The autor or his successor in title shall be entitled to initiate procedure for acquiring industrial design right.

(2) If several autors have jointly created an industrial design, all the autors or their successors in title shall be deemed entitled to initiate a procedure referred to in paragraph (1) of this Article.

### **Autor**

#### **Article 89**

(1) Autor shall be the person who created the design in the course of his creative work.

(2) A person who only provided technical assistance in the creation of industrial design shall not be deemed to be autor.

## **Autor's successor in title**

### Article 90

(1) Autor's successor in title shall be legal or natural person entitled to acquire an industrial design right by virtue of law, legal business, inheritance or court decision.

(2) The employer shall be considered to be autor's successor in title if by virtue of law or employment contract he has the right to acquire industrial design created under the inventor's employment.

## **Initiation of procedure**

### Article 91

(1) The procedure for grant of an industrial design right shall be initiated by filing an application for industrial design right to the Office.

(2) The procedure for grant of an industrial design right may also be initiated by filing an international application for industrial design right under the Hague Agreement.

(3) The procedure for international registry of industrial design, according to the provisions of the Hague Agreement, shall be initiated by a submission of an application for international registry of industrial design, directly to the International Bureau of the World Intellectual Property Organization.

## **Uniqueness of design**

### Article 92

(1) Separate application is submitted for each design for which protection is requested.

(2) Protection of more product designs (multiple application) may be required with a single application for recognition of the right to industrial design.

(3) If a multiple application is applied, all designs from the application must be intended to be used in products classified in the same class, according to the Locarno classification.

(4) The multiple application may contain maximum of a hundred designs.

## **Priority right**

### Article 93

(1) As from the date of filing of a proper application of industrial design in the Office, the applicant shall have the right to acquire priority right over any other person who shall later file an application for the same design.

(2) Exception to paragraph (1) of this Article shall be the case when the conditions for filing an application for industrial design under Articles 94 and 95 of this Law are fulfilled.

## **Exhibition priority right**

### Article 94

(1) A person who has exhibited design at an officially recognized international exhibition or fair in the Republic of Macedonia or in any of the states member of the Paris Union or the WTO may claim in his application that the date of first day of exhibition of the design be accorded as priority date within 3 months from date of the closing of the exhibition or fair.

(2) The application referred to in paragraph (1) of this Article shall be accompanied by a certificate issued by a competent authority of the state member of the Paris Union or the WTO proving that the exhibition or fair was recognized within the meaning of the Convention for International Exhibitions and shall indicate the type of exhibition or fair, its place, its opening and closing date or the date of use.

## **Union priority right**

### Article 95

(1) Any legal or natural person who has filed a proper industrial design application in any of the states member of the Paris Union or of the WTO shall be granted priority right in the Republic of Macedonia from the date of filing the first application provided that it is claimed within 6 months from the filing date.

(2) The application under paragraph (1) of this Article shall be considered proper if the filing date is prescribed under the national legislation of the state member of the Paris Union or the WTO in which it was filed or in accordance with the international agreements made between the states member of the Union, regardless of the future legal outcome of the application.

## **Obligations of applicant for union priority right**

### **Article 96**

(1) The applicant who intends to use the priority right under Article 95 of this Law shall be obliged in the application filed in the Republic of Macedonia to give all information on the application the priority to which is claimed and, no later than three months from the date of filing of the application, to submit a copy of the first application certified by the competent authority of the state member of the Paris Union or the WTO with which the first application was filed.

## **Multiple priority right**

### **Article 97**

(1) The applicant may file a claim for grant of multiple priority right on the basis of several earlier applications filed in one or more states member of the Paris Union or the WTO.

(2) Where multiple priority right is claimed, the time limits under this Law shall run from the date of granted priority right starting from the earliest date of multiple priority right.

## **Certificate for priority right**

### **Article 98**

(1) On request of the applicant, the Office shall issue a certificate of priority right as of filing date of the application for industrial design.

(2) The contents of the request and the contents of the certificate for the priority right shall be prescribed by the regulation issued by the Director of the Office.

## **Contents of application**

### **Article 99**

(1) The Application for industrial design must contain the following:

- 1) Request for recognition of the right to industrial design;
- 2) Data related to the applicant;
- 3) Representation of the design, for which protection is requested, and
- 4) Description of the design, if it is necessary for determination of its novelty.

(2) Other components and supplements shall be delivered together with the Application from paragraph (1).

(3) If a request has been filed for prolongation of publication of the application for two-dimensional industrial design, in context of article 107, paragraph (2) from this law, samples of the object for which the design has been applied may be filed together with the request, instead of design descriptions.

(4) The contents and form of the Application and the other components and supplements added to the Application shall be prescribed by the regulation issued by the Director of the Office.

### **Accordance of filing date of application**

#### Article 100

(1) If the application does not contain the elements provided for in Article 99 paragraph (1) of this Law, the Office shall notify the applicant that his application is not proper and that filing date cannot be accorded.

(2) If the filing date of the application cannot be accorded, the Office shall invite the applicant to correct the deficiencies in accordance with Article 99 paragraph (1) of this Law within 60 days from the day of receipt of the notification.

(3) If the applicant removes the deficiencies in the prescribed period, the Office shall establish the filing date of the Application.

(4) Filing date shall be considered to be the date of receipt of a proper application within the meaning of Article 99 paragraph (1) of this Law, submitted by the applicant under the notification.

(5) If the applicant fails to correct the deficiencies within the prescribed time limit, the application shall be rejected by conclusion.

### **Register of industrial design applications**

#### Article 101

(1) The application with an established filing date shall be entered in the register of industrial design applications.

(2) The contents and manner of maintenance of the Industrial Design Application Register and the excerpt from the Register shall be prescribed by the regulation issued by the Director of the Office.

### **Division of industrial design application**

#### Article 102

(1) During the granting procedure, multiple industrial design application may, at the applicant's request, be divided into two or more applications.

(2) The request for division of industrial design application may be filed until the issuing of the decision for grant of industrial design right.

(3) The divided industrial design application shall maintain the filing date and the priority right of the first application.

(4) The contents of the request for divisional application for industrial design shall be prescribed by the regulation issued by the Director of the Office

### **Processing application in case of dispute**

#### Article 103

(1) In case of dispute referring to infringement of the right from the industrial design application, the applicant may request the Office to proceed the application immediately.

### **Orderly filed application**

#### Article 104

(1) After the entry of the industrial design application in the register of industrial design applications, the Office shall examine whether:

1. the filing fee for the application has been paid;
2. translation of the application in Macedonian language has been filed, where the application is in a foreign language;
3. the application contains the elements and supplements under Article 99 of this Law;
4. proper power of attorney has been filed, where the application was filed through representative.

(2) If the industrial design application does not contain the basic elements referred to in paragraph (1) of this Article, the Office shall notify the applicant to correct the prescribed deficiencies within 60 days from the day of receipt of the notification.

(3) On reasoned request of the applicant, the time limit referred to in paragraph (2) of this Article may be extended for justified reasons by no more than 60 days.

(4) If the applicant fails to correct the prescribed deficiencies referred to in paragraph (2) of this Article within the prescribed time limit, the Office shall reject the industrial design application by issuing a conclusion.

(5) Where an industrial design application refers to supplements which are not included in the application, the Office shall notify the applicant that he may file them within the prescribed time limit. If the applicant does not comply with the notification of the Office, any reference to the supplements shall be considered to be non-existent.

(6) If the applicant corrects the application within the time limit, the application shall be deemed to be orderly filed.

### **Examination of the conditions for recognition of the right**

#### Article 104-a

If the application is correct, in context of article 104, paragraph (1) from this law, the Office shall examine whether the conditions for recognition of the right to industrial design have been fulfilled.

### **Decision for refusal of the application**

#### Article 105

(1) If the applied industrial design cannot be recognized due to some of the reasons stated in article 86 from this law, the Office shall adopt a decision for a complete or partial refusal of the application.

(2) The Office cannot adopt a decision on refusal of the application for industrial design, if the applicant had not been notified previously about the reasons due to which the requested right cannot be recognized, i.e. cannot recognize the right in the requested degree, and if the applicant had not been called in due time to give a statement regarding the reasons.

(3) The term from paragraph (2) of this article, upon an explained request from the applicant, may be extended to six months.

(4) The applicant cannot additionally change the design during giving of the statement.

## **Payment of expenses**

### Article 106

(1) If the application of an industrial design fulfills the conditions, in the context of article 104, paragraph (1) from this law, and if the design is not excluded from protection, in the context of article 86 from this law, the Office shall invite the applicant with a Conclusion, within 30 days, to pay the fees for publication of the data from the application in the Official Gazette of the Office

(2) The Office shall issue a conclusion for rejection of the industrial design application if the applicant fails to pay the expenses referred to in paragraph (1) of this Article.

## **Publication of industrial design application**

### Article 107

(1) If the applicant complies with Article 106 paragraph (1) of this Law, the Office shall publish the contents of the application in the Official Gazette of the Office within 90 days.

(2) The publication stated in paragraph (1) from this article, upon request of the applicant, may be prolonged for a period not longer than 12 months, counting from the filing date of the application, i.e. the priority date.

(3) The data from the Application that are published in the Official Gazette of the Office shall be prescribed by the regulation issued by the Director of the Office.

## **Opposition**

### Article 108

(1) The following may submit an opposition to the Office regarding the published Application for industrial design, within 90 days, counting from the date of publication:

- 1) Applicant of a previously applied industrial design, as well as holder of previously recognized right to industrial design;
- 2) Holder of a previous right to industrial property, if its the case of that right is the same as the published industrial design, or the published industrial design is similar to it;

- 3) Each person who has a copyright to a work, which is the same as the published industrial design or the published industrial design is similar to it, and
  - 4) Every interested person who considers that the published industrial design does not fulfill the requirements for novelty and speciality or is exclusively conditioned by the functional characteristics of the product, in context of article 87, paragraph (1) of this law.
- (2) The period for submission of the opposition from paragraph (1) of this article cannot be extended.
- (3) A separate opposition is submitted for each published Industrial Design Application.
- (4) The contents of the opposition, as well as the conditions for submission shall be prescribed by the regulation issued by the Director of the Office.

### **Examination of opposition**

#### Article 109

- (1) The Office shall examine whether the opposition is filed by the person entitled to file opposition within the meaning of Article 108 paragraph (1) of this Law and whether the opposition is filed in the prescribed time limit.
- (2) If the requirements referred to in paragraph (1) of this Article are not complied with, the Office shall issue a conclusion on rejection of the opposition.
- (3) If the requirements referred to in paragraph (1) of this Article are complied with, the Office shall notify the industrial design applicant about the grounds specified in the opposition and invite him to make a declaration thereon within prescribed period that cannot be longer than 60 days.
- (4) If the applicant does not declare himself on the reasons specified in the opposition within the time limit referred to in paragraph (3) of this Article, the Office shall decide on the grounds specified in the opposition.

### **Deciding on opposition**

#### Article 110

- (1) If the applicant declares himself on the grounds specified in the opposition and submits a response to it, the Office shall examine the justification of the opposition, taking into consideration the grounds for opposition and the response to the opposition.

(2) If the Office establishes that the opposition is unjustified, it shall refuse it by decision.

(3) The decision under paragraph (2) of this Article shall be sent to the applicant and to the person who filed the opposition.

(4) If the Office establishes that the opposition is justified, it shall refuse the industrial design application and communicate a written decision to that effect to the applicant and to the person who filed the opposition.

### **Grant of industrial design right and entry in register**

#### Article 111

(1) If the reasons prescribed in article 86 and article 87, paragraph (1) from this law do not present an impediment for recognition of the right, the Office shall issue a conclusion that all requirements for grant of right to industrial design had been complied with and invite the applicant within 30 days to pay the maintenance fee for the first five-year term of the industrial design, the expenses for publication of the industrial design in the Official Gazette and the expenses for issuing an industrial design certificate.

(2) If the applicant pays the fees and expenses within the time limit referred to in paragraph (1) of this Article, the Office shall issue a decision for grant of right to industrial design and enter the granted right in the industrial designs register.

(3) If the applicant fails to pay the fees and expenses within the time limit referred to in paragraph (1) of this Article, the Office shall issue a conclusion for rejection of the application.

(4) The contents and manner of maintenance of the Industrial Design Register and the excerpt from the Register shall be prescribed by the regulation issued by the Director of the Office.

### **Recording changes in the Registers**

#### Article 111-a

(1) Changes related to the applicant, holder of the right, and the right itself shall be recorded in the Application Register for Industrial Design and the Industrial Design Register.

(2) The recorded changes, the contents and form of the request, as well as the procedure of recording the changes shall be prescribed by the regulation issued by the Director of the Office.

## **Scope of protection**

### Article 112

(1) The decision under Article 111 of this Law determines the scope of the granted protection of the industrial design right presented with the issued description and presentation.

## **Acquisition of industrial design right**

### Article 113

(1) Industrial design right shall be acquired on the day of the issuing of the decision for grant of right and the entry of the industrial design in the register.

(2) The date of entering the industrial design in the register is the same as the date of issuing the decision for grant of industrial design.

## **Publication of industrial design**

### Article 114

(1) The data on the industrial design shall be published in the Official Gazette of the Office no later than 90 days from the date of entry of the industrial design in the register.

(2) The data published in the Official Gazette shall be prescribed by the regulations issued by the Director of the Office.

## **Industrial design certificate**

### Article 115

(1) The industrial design owner shall be issued industrial design certificate within six months from the date of issuing a decision for grant of industrial design.

(2) The contents of the certificate for industrial design shall be prescribed by the regulation issued by the Director of the Office.

## **Moral rights of autor**

### Article 116

(1) The autor shall always have the right to be mentioned as the autor of the industrial design in all the documents and public presentations, irrespective of the fact whether he is the applicant or the right-owner.

(2) The transfer or waiver of the right under paragraph (1) of this Article shall be considered as nullity.

(3) If several autors have jointly created an industrial design, all the autors shall have equal rights, irrespective of their contribution to the creation of the industrial design, and therefore all of them shall have right to be mentioned as autors.

## **Exclusive rights**

### Article 117

(1) The owner of industrial design shall have the exclusive rights to apply the protected industrial design on products and put on the market products embodying protected industrial design.

(2) The owner of industrial design shall have the right to prohibit any unauthorized use of the industrial design by third persons.

(3) Without consent from the owner of industrial design, third person may not manufacture, offer, put on the market, import, export or use any product that embodies or imitates protected industrial design, nor store such a product for the specified purposes.

(4) The owner of industrial design is entitled to demand information about the origin of the product and trade circulation of the product or the documentation relating to that product from each person who had put or intends to put on the market a product that embodies or imitates protected industrial design.

## **Free use**

### Article 118

(1) The exclusive industrial design rights under Article 117 of this Law shall not affect the use of the product that embodies or on which protected industrial design is applied:

1. for private and non-commercial purposes;
2. for the purpose of informing the public or for education, if this is in compliance with good business practices and shall not harm the interests of the right-owner and autor;
3. for experimental and scientific purposes.

## **Exception from prohibition to use an industrial design**

### Article 119

It shall not be considered as an injury of the exclusive rights of the industrial design owner, if products produced according to the industrial design are used in construction or equipment for ships, airplanes or road vehicles that belong to some of the countries from the Paris Union or WTO, when that vehicle temporarily or accidentally is on the territory of the Republic of Macedonia, under the condition that the integrated product serves exclusively for the purposes of that vehicle.

## **Right based on prior use**

### Article 120

(1) The right-owner may not invoke the exclusive rights in relation to a third person who has been using the same industrial design or who has performed the relevant preparations for the use of the same industrial design prior to the filing date of the application to the Office or the date of granted priority right, if claimed, provided that the third person created the industrial design without knowledge of the existence of industrial design not available to the public at that time.

(2) Third person may not use the industrial design under paragraph (1) of this Article in a manner exceeding the boundaries of usual entrepreneurial activities.

## **Tolerance of use of industrial design**

### Article 121

(1) The holder of the previously recognized industrial design does not have the right to request cancellation of the later recognized industrial design, according to the priority right, neither to prohibit use of the later recognized identical or similar industrial design, if during a period of five years he/she has knowingly tolerated use of that design, unless the latter recognized industrial design has been protected by some abuse.

(2) The owner of the later granted industrial design right should have no right to prohibit use to the owner of the earlier granted industrial design right.

## **Term and maintenance of industrial design right**

### **Article 122**

(1) The term of industrial design right shall be 5 years from the filing date of industrial design application.

(2) The industrial design term may be renewed by periods of five years up to the total of 25 years, provided that the industrial design owner, during the last year of protection or within six months upon the expiration of that term, files to the Office a request for renewal of the industrial design validity and pays the appropriate maintenance fee and expenses.

(3) The new period of protection shall begin with the day of expiration of the preceding term of protection.

(4) The contents and form of the request for renewal of an industrial design shall be prescribed by the regulation issued by the Director of the Office.

## **Ceasing of industrial design right**

### **Article 123**

(1) An industrial design shall cease to be valid:

1) if the term of the industrial design validity under Article 122 of this Law has expired;

2) upon a written declaration of the right-owner on waiver of the industrial design the day following the day of filing the declaration to the Office;

3) with the lapse of the legal person or upon the death of the natural person who is the industrial design owner, on the day of lapse or death, or with the declaration of a missing industrial design owner dead, on the day of the coming into force of the declaration, unless the right has been transferred to the legal successors in title of the legal person or to the heirs of the natural person.

(2) The ceasing of industrial design validity shall be entered in the register of industrial designs.

## **Third party rights**

### **Article 123-a**

(1) If a license, pledge or other right is recorded in the Industrial Design Register in the interest of a third party, the owner of the industrial design cannot waive his/her rights without a written consent from the person whose name is on the registered license, guarantee or other right.

(2) If the owner of the industrial design fails to pay the prescribed duty in the prescribed period, and a license, a pledge or other right have been recorded in the interest of a third party, the Office shall inform that person that the duty has not been paid, and that the person may pay the same within six months from the date of notification, and with that retain the registered right.

(3) In case of a dispute regarding transfer of the registered rights to a third party, if that is necessary for provision of those rights, the court may decide that the industrial design right should be transferred to the person holder of a license, pledge or other right until the fulfillment of the obligations.

## **PART THREE**

### **TRADEMARK**

#### **Object of trademark protection**

##### Article 124

(1) A trademark shall protect a sign which may be represented graphically and which is capable for distinguishing goods or services of one undertaking from those of other undertakings.

(2) Trademark shall protect signs capable for distinguishing, in particular: words, letters, numerals, pictures, drawings, combinations of colors, three-dimensional forms, including shapes of goods or their packaging, as well as combinations of all of the above-mentioned signs.

(3) The words and letters referred to in paragraph (2) of this Article may be written in any language and alphabet.

#### **Distinctiveness**

##### Article 125

(1) A sign shall be capable for distinguishing if it gives to certain goods or services comparing them with the identical or similar goods or services, a special distinctive character.

(2) While establishing whether a given sign is capable for distinguishing, all circumstances shall be taken into consideration, particularly the time and scope of its past use in trade.

## **Absolute grounds for refusal**

### Article 126

(1) A trademark shall not protect a sign:

1. the publishing or use of which is contrary to law or morality;
2. which cannot be represented graphically;
3. which is not distinctive, i.e. capable for distinguishing goods or services in trade;
4. which indicates exclusively the kind of goods or services, their purpose, time or manner of production, geographical origin, quality, price, quantity or weight;
5. which is customary for designating certain kind of goods or services;
6. which exclusively consists of shape defined by the kind of goods, shape of goods necessary to obtain a specific technical result or shape giving a substantial value to the goods;
7. the appearance of which may create confusion in trade and mislead the average consumer particularly as to the geographical origin, kind, quality or any other characteristic of the goods or services;
8. which contains a national coat of arms or other public coat of arms, flag or emblem, name or abbreviated name of a country or an international organization, as well as imitations thereof, except with authorization from the competent authority of the country or organization;
9. contains or imitates appearance or name of a famous person, unless with consent from that person, or the government body competent for general administrative affairs in the case of deceased famous person;
10. which contains seal, official sign or hallmarks for control and guarantee of quality and imitations thereof;
11. which contains religious symbols or imitations thereof.

(2) The signs under paragraph (1) items 3, 4 and 5 of this Article may be protected by trademark if the applicant proves that during the long years of use, the sign acquired distinctiveness.

(3) The Ministry of Justice shall be the competent body for the Republic of Macedonia for issuing the authorization from paragraph (1), items 8), and 9).

## **Relative grounds for refusal**

### Article 127

(1) Trademark may not protect a sign:

1. which is identical with an earlier trademark filed or registered by another person designating the identical kind of goods or services;
2. which is identical with or similar to an earlier trademark, filed or registered by another person designating the same or similar kind of goods or services which would mislead the average consumer,

including the possibility of association to earlier filed for or registered trademark.

(2) Trademark, earlier filed for protection shall be a reason for refusal within the meaning of paragraph (1) of this Article only if it was registered.

(3) The term "earlier filed or registered trademark" shall comprise:

1. trademark enjoying priority right under the provisions of this Law;
2. earlier internationally registered trademark with effect in the Republic of Macedonia;
3. trademarks which at the time of filing the trademark application for the sign referred to in paragraph (1) of this Article are well-known in the Republic of Macedonia within the meaning of Article 6-bis of the Paris Convention or Article 16(3) from the TRIPs Agreement.

(4) Well-known trademark referred to in paragraph (3) item 3 of this Article shall be in particular trademark known to the relevant sector of the public and trademark which is well-known as a result of representation, publication and advertising in the public.

(5) A trademark shall not protect a sign which infringes earlier acquired rights of:

1. The owner of a trademark registered in a country member of the Paris union or WTO, for which the representative in the Republic of Macedonia filed an application without the owners' consent;
2. a natural person whose name and surname or appearance are identical with or similar to the published sign;
3. the owner of an earlier industrial property right, if the subject matter of such right is identical with or similar to the published sign;
4. the person having copyright on the work which is identical with or similar to the published sign.

(6) A trademark shall not protect a sign which is identical with or similar to a trademark the validity of which has expired on the ground of expiring of term of protection and if the right-holder failed to file a request for renewal of validity and pay the prescribed fees in the prescribed time limit, when a trademark application was filed before the expiration of the period of nine months, counting from the expiration date of the trademark validity, unless the protection of such a sign is required by the owner in whose name the trademark has been protected, or by his successor in title.

(7) Grounds for exclusion from trademark protection under this Article may be invoked only by the applicant of the earlier application or the owner of the earlier right.

## **Applicant**

### Article 128

(1) Procedure for acquiring right to trademark may be initiated by a natural or legal person.

## **Initiation of procedure**

### Article 129

(1) The procedure for granting of a trademark right shall be initiated by filing of a trademark application to the Office.

(2) The procedure for granting of a trade mark right may also be initiated by filing of an application according to the Madrid Agreement and the Madrid Protocol.

(3) Separate application shall be filed for each sign for which trademark protection is sought.

(4) One and the same trademark application may be used for requesting protection of several goods and services.

## **Content of application**

### Article 130

(1) A trademark application shall contain the following:

- 1) Request for recognition of a trademark right;
- 2) Data related to the applicant;
- 3) Appearance of the mark for which protection is requested, and
- 4) List of the goods and services for which protection is requested.

(2) Other components and supplements can be submitted together with the Application from paragraph (1).

(3) The contents and form of the Application and the other components and supplements added to the Application shall be prescribed by the regulation issued by the Director of the Office.

## **Establishing the filing date of an application**

### Article 131

(1) If the application does not contain the basic elements provided for in Article 130 paragraph (1) of this Law, the Office shall notify the applicant that his application is not proper and that filing date cannot be established.

(2) If filing date of the application cannot be established, the Office shall invite the applicant to correct the deficiencies in accordance to Article 130 paragraph (1) of this Law within 30 days from the date of receipt of the notification.

(3) If the applicant removes the deficiencies in the prescribed period, the Office shall determine the filing date of the Application.

(4) Filing date shall be considered to be the date of reception of a proper application within the meaning of Article 130 paragraph (1) of this Law submitted by the applicant under the notification.

(5) If the applicant fails to correct the deficiencies within the prescribed time, the application shall be rejected by conclusion.

### **Changes to a trademark application**

#### Article 131-a

In the trademark application, with an established filing date, there can be no additional changes to the sign itself nor is it possible to insert supplements to the list of the goods and services.

### **Trademark Application Register**

#### Article 131-b

(1) The Application for a trademark shall be recorded in the Trademark Application Register.

(2) The contents and manner of maintenance of the Trademark Application Register and the excerpt from the Register shall be prescribed by the regulation issued by the Director of the Office.

### **Division of trademark application**

#### Article 132

(1) Any trademark application may, at request of the applicant, be divided during the trademark granting procedure into two or more applications in respect to the proposed list of goods and services.

(2) The divided applications shall maintain the priority right of the first application.

(3) Request for division of application shall be allowed if the applicant of the earlier application filed a request for protection of one trademark for several goods or services from the International classification of goods and services.

(4) The request for division of application may be filed until the issuing of the decision for grant of trademark right.

(5) The contents of the request for a divisional application for a trademark shall be prescribed by the regulation issued by the Director of the Office.

## **Priority right**

### Article 133

(1) If the trademark application is filed in accordance with Article 130 paragraphs (1) of this Law, the applicant shall acquire priority right as from the date of filing of the application over any other applicant filing a later trademark application for identical or similar sign and identical or similar goods or services.

## **Union priority right**

### Article 134

(1) Any legal or natural person who had duly filed application in any of the state member of the Paris Union or WTO shall be granted priority right in the Republic of Macedonia from the date of filing the first application if that is claimed within six months of the filing date of the first application.

(2) The applicant who intends to use the priority right under paragraph (1) of this Article shall be obliged in the application filed in the Republic of Macedonia to give all information on the first application (state, date and number of application) and, within 90 days from the date of filing the application, to submit a copy of the first application certified by the competent authority of the state member of the Paris Union or the WTO with which the first application was filed, as well as translation of the first application in Macedonian language.

## **Exhibition priority right**

### Article 135

(1) The person who exhibits goods or services marked by a specific sign at an officially recognized international exhibition or fair in the Republic of Macedonia or in any of the member states of the Paris Union or the WTO may request when filing an application that the date of exhibition of the goods or rendering of the services be accorded as priority date, within three months from the date of the closing of the exhibition or fair.

(2) The application referred to in paragraph (1) of this Article shall be accompanied by a certificate issued by a competent authority of the state member of the Paris Union or the WTO proving that the exhibition or fair was recognized within the meaning of the Convention for International Exhibitions and indicate the type of exhibition or fair, its place, its opening and closing date and the first day of exhibiting the goods or rendering the services specified in the application.

## **When time limits cannot be extended**

### **Article 136**

(1) With grant of priority right under Article 135 of this Law, the time limit under Article 134 of this Law shall not be extended.

## **Certificate for a priority right**

### **Article 136-a**

(1) The Office, upon request of the applicant, shall issue a Certificate for the priority right, which shall be considered the date prescribed as a filing date of the trademark application.

(2) The contents of the request and the Certificate for the priority right shall be prescribed by the regulation issued by the Director of the Office

## **Order of proceeding**

### **Article 137**

(1) Trademark applications shall be proceeded according to their filing date.

(2) By way of exception from the provision from paragraph (1) of this article, the applicant may request immediate initiation of a procedure regarding the Application:

1. where, request for international registration of trademark according to the Madrid Agreement has been filed;
2. there is a dispute referring to infringement of the right;
3. where, under other regulations, it is necessary to perform earlier registration of a trademark.

(3) In the cases under paragraph (2) items 2 and 3 of this Article, the applicant shall file an individual request for immediate proceeding of the application and pay the prescribed fees.

## **Proper trademark application**

### **Article 138**

(1) The trademark application shall be correct if:

1. separate application has been filed under Article 129, paragraph (3) of this Law;

2. the prescribed application fee has been paid and evidence of that submitted thereto;
3. composed in a manner to include all necessary components and supplements prescribed in article 130 from this law and the regulation issued by the Director of the Office, and
4. an orderly power of attorney is attached thereto, if the application is filed through a representative.

### **Formal examination of the Application**

#### Article 139

(1) After entering the trademark application in the Application Register, the Office shall examine whether it is correct, in context of article 138 from this law.

(2) If the application is not correct, the Office shall invite the applicant to correct the prescribed deficiencies within a period not longer than 60 days, from the day of receipt of the invitation.

(3) On reasoned request of the applicant, the time limit referred to in paragraph (1) of this Article may, for the justified reasons, be extended by no more than 60 days.

(4) If the applicant corrects the application within the prescribed time limit, the application shall be deemed to be proper.

(5) If the applicant fails to correct the deficiencies referred to in paragraph (1) of this Article within the prescribed time limit, the application shall be rejected by conclusion.

### **Examination of the requirements for grant of the right**

#### Article 139-a

If the application is correct, in context of Article 138, from this law, the Office shall examine whether the requirements for grant of the trademark right have been fulfilled.

### **Decision for refusal of application**

#### Article 140

(1) If the sign for which trademark application is filed is excluded from protection in respect to all or some of the specified goods or services on the grounds referred to in Article 126 of this Law, the Office shall issue a decision for refusal of the application.

(2) Decision for refusal of trademark application may not be issued if the applicant has not been previously notified in writing about the grounds for the full or partial exclusion from protection and invited to make a declaration thereon in due time.

(3) The term from paragraph (2) of this article, upon an explained request from the applicant, may be extended to six months.

## **Publication of application**

### Article 141

(1) If the trademark application fulfills all the requirements regarding correctness of the application under Article 138 of this Law, if the sign is not excluded from protection under Article 126 of this Law and if the prescribed publication fee is paid, the data from application shall be published in the Official Gazette of the Office.

(2) The application data published in the Official Gazette of the Office shall be prescribed by the regulations issued by the Director of the Office.

## **Opposition**

### Article 142

(1) Opposition to a published trademark application may, within 90 days from the publication date, be filed with the Office by:

1. applicant of an earlier filed trademark application and owner of earlier registered trademark under Article 127 paragraphs (1) to (4) of this Law;
2. the owner of the trademark registered in a country member of the Paris Union or WTO, for which the representative in the Republic of Macedonia filed an application without the owner's consent;
3. natural person whose name and surname or appearance are identical with or similar to the published sign;
4. owner of an earlier protected industrial property right, if the subject matter of that right is identical with or similar to the published sign;
5. any person having copyright on the work which is identical with or similar to the published sign.
6. The owner of a trademark that has expired due to the expiration of the term of protection, in the context of article 127, paragraph (6) from this law.

(2) The time limit for filing opposition referred to in paragraph (1) of this Article shall not be extended.

(3) A separate opposition shall be submitted for each published Trademark Application.

(4) The contents of the opposition, as well as the manner of submission shall be prescribed by the regulation issued by the Director of the Office.

## **Examination of opposition**

### **Article 143**

(1) The Office shall examine whether the opposition is filed by a person entitled to file an opposition within the meaning of Article 142 paragraph (1) of this Law and whether the opposition is filed in the prescribed time limit.

(2) If the requirements referred to in paragraph (1) of this Article are not complied with, the Office shall issue a conclusion for rejection of the opposition.

(3) If the requirements referred to in paragraph (1) of this Article are complied with, the Office shall notify the trademark applicant about the grounds specified in the opposition and invite him to make a declaration thereon within prescribed period that cannot be longer than 60 days.

(4) If the applicant does not make a declaration on the grounds specified in the opposition within the time limit referred to in paragraph (3) of this Article, the Office shall decide within the boundaries of the grounds specified in the opposition.

## **Deciding on opposition**

### **Article 144**

(1) If the applicant makes a declaration on the grounds specified in the opposition, the Office shall examine the justification of the opposition within the boundaries of the specified grounds, taking into consideration the declaration thereon.

(2) If the Office establishes that the opposition is unjustified, it shall be refused with decision.

(3) The decision under paragraph (2) of this Article shall be sent to the applicant and to the person who filed the opposition.

(4) If, in the examination procedure on the opposition, the Office establishes that the opposition is justified, it shall refuse the trademark application and submit a written decision to that effect to the applicant and to the person who filed the opposition.

## **Grant of trademark right and entry in register**

### **Article 145**

(1) If the reasons prescribed in article 126, paragraph (1) and article 127, paragraphs (1), (2), (3), (4), (5), and (6) from this law do not constitute a barrier for grant of the trademark right, the Office shall issue a conclusion that the requirements for grant of a trademark right had been fulfilled and invite the applicant within 30 days from receipt of the conclusion to pay the fee for

maintenance of the trademark for the first ten-year period, the expenses for publication of trademark in the Official Gazette of the Office and the expenses for issuing a trademark certificate.

(2) If the applicant pays the fee and expenses referred to in paragraph (1) of this Article within the prescribed time limit, the Office shall issue a decision for grant of a trademark right and enter the granted right in the trademark register.

(3) If the applicant fails to pay the fee and expenses referred to in paragraph (1) of this Article, the trademark application shall be rejected by conclusion.

(4) The contents and manner of maintenance of the Trademark Register, as well as the contents and the form of the excerpt from the Register shall be prescribed by the regulation issued by the Director of the Office.

### **Recording changes in the Registers**

#### Article 145-a

(1) Changes related to the applicant, owner of the right, and the right itself shall be recorded in the Trademark Application Register, and the Trademark Register.

(2) The changes recorded, the contents and form of the request, as well as the procedure of recording the changes shall be prescribed by the regulation issued by the Director of the Office.

### **Acquisition of trademark right**

#### Article 146

(1) Trademark right shall be acquired by issuing decision for grant of the right and entry of the trademark in the trademark register.

(2) The date of entering the trademark in the trademark register is the same as the date of issuing the decision for grant of the trademark.

### **Publication of trademark**

#### Article 147

(1) The data on the trademark shall be published in the Official Gazette of the Office within 90 days from the date of entry of the trademark into register.

(2) The data published in the Official Gazette of the Office shall be prescribed by the regulations issued by the Director of the Office.

## **Trademark certificate**

### Article 148

(1) The Office shall issue to the owner a trademark certificate no later than six months from the date of publication of the trademark in the Official Gazette of the Office.

(2) The contents of the certificate for trademark shall be prescribed by the regulation issued by the Director of the Office.

## **Exclusive rights**

### Article 149

(1) The trademark-owner shall have the exclusive right to use the trademark on the market for marking his goods or services.

(2) The trademark-owner shall have the right to use the symbol ® next to his trademark.

(3) The trademark-owner has the right to prohibit use on the market by a third person, without his consent, of a sign which is:

1. identical with trademark used for identical goods or services;
2. identical with or similar to trademark used for identical or similar goods or services if that similarity may mislead the average consumer, including the possibility of association between the sign and the trademark;
3. identical with or similar to trademark used for different goods or services if the trademark is well-known in the Republic of Macedonia and if the use of that sign without justified reason may lead to unfair competition and damage the distinctive character or reputation of the trademark.

(4) The prohibition under paragraph (3) of this Article shall also include:

1. affixing the sign on goods and their packages;
2. rendering services or putting on the market goods under that sign, or storing goods with that intention;
3. import or export of goods under that sign;
4. use of the sign in correspondence, publishing or advertising.

## **Limitations to the trademark right**

### Article 150

(1) The trademark shall not entitle its owner to prohibit third persons to use in trade their name, surname, sign or trade name, address, indications on the kind, quality, quantity, purpose, value, geographical origin, date of production of the goods or rendering of the services or any other characteristic of the goods,

irrespective of the fact that those indications are identical with or similar to the trademark or parts thereof, provided that they are used in compliance with the good business practices and does not lead to unfair market competition.

(2) The trademark shall not entitle its owner to prohibit third persons from using in trade a sign which is identical with or similar to a trademark if that is necessary for indicating the purpose of the goods, particularly the spare parts thereof, or the kind of services rendered in compliance with the good trade practices and does not lead to unfair competition.

### **Acquiescence in the use of a trademark**

#### Article 151

(1) The owner of prior trademark right shall not have the right to require cancellation of later trademark on the basis of his earlier priority right nor to prohibit use of the later trademark in relation to the goods or services for which the later trademark has been used, if he had acquiesced this use for five consecutive years, unless the later trademark was protected in bad faith.

(2) The owner of a trademark with later priority right shall not have the right to prohibit the use to the owner of earlier registered trademark.

### **Exhaustion of right**

#### Article 152

(1) The owner of trademark shall not have the right to prohibit use of the trademark for marking goods or services put on the domestic market by himself or with his consent, unless there have been essential changes in the goods, deterioration of their characteristics or change of the nature of the goods or services after their putting on the market.

### **Reproduction of trademark in publications**

#### Article 153

(1) If the reproduction of a registered trademark in dictionaries, encyclopedia or similar publications creates an impression that it is a generic

name of the products or services for which the trademark was registered, the editor of the publication shall, on request of the trademark-owner, accompany the reproduction of the trademark in the first following edition of the publication by an indication that the trademark has been registered.

### **Term of trademark**

#### Article 154

(1) A trademark term shall be 10 years as from the date of filing the trademark application.

(2) A trademark may be renewed indefinite number of times for term of ten years, provided that the trademark applicant files with the Office a request for renewal of the trademark validity and pays the corresponding fee and procedural expenses during the last year of the ten-year term of protection or no later than nine months after the expiration of the validity.

(3) The new period of protection shall begin with the day of expiration of the previous ten-year period of protection.

(4) The contents and form of the request for renewal of the right to a trademark shall be prescribed by the regulation issued by the Director of the Office.

### **Obligation to use trademark**

#### Article 155

(1) A trademark-owner shall, in order to maintain the trademark validity, use the trademark in respect to the goods or services for which it has been granted, unless there are serious reasons for its non-use that do not depend on the trademark-owner's will.

(2) The use of trademark within the meaning of paragraph (1) of this Article shall also include use of the trademark on packages, catalogues, brochures, manuals, advertisements, invoices, correspondence, means for electronic commerce, etc.

(3) The use of a trademark in an insignificantly modified form without changing its distinctive character and the use of a trademark on goods and equipment exclusively for the purpose of export shall also be constitute the use thereof.

(4) The use of a trademark by another person with owner's consent shall be considered to be the use by the owner himself.

### **Ceasing of trademark right**

#### Article 156

(1) A trademark shall cease to be valid:

1. if the term of protection expires and the trademark-owner fails to file, within a prescribed time limit, a request for renewal of the trademark validity and pay the prescribed fee;
2. upon a written declaration of the right-owner on waiver of the trademark, on the day following the day of filing the declaration to the Office;
3. with the lapse of the legal person or upon the death of the natural person who is trademark-owner, on the day of lapse or death, or with the declaration of a missing trademark-owner dead, on the day of the coming into force of the declaration, unless the right has been transferred to the legal successors in title of the legal person or to the heirs of the natural person;
4. on the basis of a court decision or act of the Office in cases provided for by this Law, from the date prescribed in that decision or act.

(2) The trademark shall also cease to be valid when in case of non-activity of the owner of the right, it has become a common name on the market for the goods, i.e. services for which it has been registered.

### **Third party rights**

#### Article 156-a

(1) If a license, pledge or any other right of a third person has been entered into the trademark register, the trademark owner cannot renounce his rights without written consent from the person who is signatory of the license, pledge or other right.

(2) If the trademark owner fails to pay the fee within the prescribed time limit and the license, pledge or any other right of a third person has been entered into the trademark register, the Office shall notify that person that the fee has not been paid, and that in order to keep his right he shall have to pay the fee within six months from the date of notification.

(3) In case of a dispute regarding transfer of the registered rights to a third party, if that is necessary for provision of those rights, the court may decide that the trademark right should be transferred to the person holder of a license, pledge or other right until the fulfillment of the obligations.

### **Object of protection by collective mark**

#### Article 157

(1) Collective mark shall protect a sign intended for collective designation of the goods or services put on the market by an association of legal and natural persons.

## **Applicant for collective mark**

### Article 158

(1) Applicant for collective mark may be a domestic association of legal and natural persons.

(2) Under this Law and in compliance with the international conventions, which have been ratified by the Republic of Macedonia, applicant for collective mark may also be a foreign legal person.

## **Contents of application for collective mark**

### Article 159

(1) The application for collective mark shall be accompanied by a general act or contract for collective mark.

(2) The general act or contract referred to in paragraph (1) of this Article shall contain name of the firm or of the applicant, name of the authority or person authorized to represent the applicant, provisions about the appearance of the sign and the products or services to which that sign refers, provisions on who have the right to use the collective mark and the circumstances of the use, provisions on the rights and obligations of the users of the collective mark in case of infringement of the trademark right, provisions on the measures and consequences in case of infringement of the trademark right and provisions on the measures and consequences in case of non-following of the provisions from the general act or contract.

## **Recording of the changes in the agreement for a collective trademark**

### Article 160

(1) On request of the applicant or the owner of a collective mark, the Office shall record into the register any change or amendment of the agreement regulating the use of a collective mark.

(2) The rights arising from a collective mark shall not be transferable and shall not be the subject matter of the license.

## **Object of protection by certification mark**

### Article 161

(1) Certification mark shall protect a sign which is being used by several companies under supervision of the certification mark owner and it shall protect the quality, origin, way of production and other joint characteristics of goods or services of those companies.

(2) The provision from Article 126 paragraph (4) of this Law shall not be applied on certification marks.

## **Contents of application for certification mark**

### Article 162

(1) The application for certification mark shall be accompanied by rules for use of the certification mark containing provisions on the quality and other characteristics of the goods or services, the control measures that will be used by the applicant of the certification mark and the sanctions he will be applying.

(2) The owner of the right to certification mark may not use that mark for marking products and services he put on the market.

## **International registration**

### Article 163

(1) The trademark-owner or applicant may file an application for international registration of the trademark under the international agreements and conventions ratified by the Republic of Macedonia.

(2) The provisions of this Law shall be applied to all issues which are not provided for by those agreements.

(3) The application referred to in paragraph (1) of this Article shall be filed through the Office in a procedure prescribed by the regulations issued by the Director of the Office.

(4) For the purpose of international registration of trademarks under the Madrid Agreement and the Madrid Protocol, the publication of the application under Article 141 of this Law shall be replaced with publication of the international registration in the Official Gazette of international registrations of trademarks of the World Intellectual Property Organization.

(5) The time limit for filing opposition to the grant of internationally registered trademark for the Republic of Macedonia shall run as from the first day of the month following the month of publication of the Official Gazette of the World International Property Organization in which that trademark was published.

## **PART FOUR**

### **APPELLATION OF ORIGIN AND GEOGRAPHICAL INDICATION**

#### **Subject matter of protection**

##### Article 164

(1) Geographical name shall be protected with appellation of origin and geographical indication.

(2) Geographical name shall mark products produced by natural or legal persons on a given geographical area.

#### **Appellation of origin**

##### Article 165

Appellation of origin shall be the geographical name of the country, region or place marking the product which originates from that region, the quality and particular characteristics of which are exclusively or mainly conditioned by the geographical environment, including the natural and human factor, and the production, processing and preparation of which are entirely carried out in the limited region of origin.

#### **Geographical indication**

##### Article 166

(1) Geographical indication shall be the geographical name of the country, region or place marking the product the quality, reputation or other characteristic of which may be essentially attributed to the geographical origin.

(2) The geographical indication of a product may be protected only if the production and/or processing and/or preparation for production are carried out in the place of origin.

(3) The geographical name which does not comply with the requirements for protection with appellation of origin may be protected as geographical indication.

#### **Origin of raw materials**

##### Article 167

(1) With the exception of the wines and spirits, the product may be marked with appellation of origin even in case when the raw materials for its production originate from a broader region or outside the processing area, provided that:

1. the production area of the raw materials is limited or that production of raw materials needs special conditions;
2. the traditional way of production, i.e. the human factor, is crucial to the quality and particular characteristics of the product.

### **Traditional names**

#### Article 168

Appellation of origin and geographical indication may also be used to protect geographical name of a given country, region or place which, in the course of long years of use on the market, became generally known as name of the product which originated from that territory, as well as the traditional geographical or non-geographical name which refers to certain origin of the product and complies with the requirements under Article 165 and Article 166 paragraph (2) of this Law.

### **Scope of protection**

#### Article 169

Geographical name may be used for marking natural, agricultural, industrial, handcraft and home-made products.

### **Exceptions from protection**

#### Article 170

(1) A geographical indication or appellation of origin shall not be granted for protection of name of place of origin of a product which:

1. does not meet the requirements under this Law,
2. is against law or morality;
3. with its contents may be misleading as to the kind, origin, quality, manner of production or other characteristics of the product;
4. is identical to name of a plant variety or animal race, in case in which it may be misleading as to the geographical origin of the product;
5. is identical or similar to a geographical name or trademark previously registered for identical or similar products, when it may be misleading to the average consumer.

## **Generic names**

### Article 171

(1) A geographical indication or appellation of origin shall not be granted protection if the name of the place of origin of a product has become a common name for a certain type of products as a result of long years of presence on the market.

(2) The name of the place of origin protected by a geographical indication or appellation of origin may not become generic.

## **Homonyms**

### Article 172

If the names of two or more places of origin of a product are the same or almost the same in writing, protection of such geographical names with geographical indication or appellation of origin shall be granted to all persons who comply with the requirements under this Law and in the manner prescribed in the regulations issued by the Director of the Office, on the principles of equitable treatment of producers on the market and truthful informing of consumers, except when it may mislead the public as to the true geographical origin.

## **Equitable treatment of domestic and foreign persons**

### Article 173

(1) Geographical name may be protected in favor of a foreign natural or legal person and he may be registered as authorized user of the protected geographical name only if those rights have been granted in the countries of origin and if the requirements under this Law are fulfilled.

(2) Foreign natural and legal person may be granted the rights referred to in paragraph (1) of this Article if that results from the international agreements ratified by the Republic of Macedonia or on the grounds of bilateral agreement for mutual protection if so provided in the legislation of the person's country of origin.

(3) The geographical name which has already been protected with geographical indication or appellation of origin in the Republic of Macedonia may also be protected abroad on the grounds of bilateral agreements for mutual protection or the international agreements ratified by the Republic of Macedonia.

(4) The application for protection in a foreign country may be filed only by the authorized users of geographical names who have been entered in the adequate register kept by the Office.

## **Initiation of procedure**

### Article 174

The procedure for grant of protection of a geographical name i.e acquisition of the right to use a protected geographical name shall be initiated by filing an application containing a request for grant of geographical name i.e request for grant of the right to use a protected geographical name, accompanied by the other supplements provided for by this Law.

## **Application by foreign person**

### Article 175

While filing the application, foreign persons shall accompany the request for grant of geographical name or request for grant of the right to use, by a true copy of public certificate or another legal act in the official language of the country of origin, as evidence that the geographical name had been protected in that country or that right to use had been granted to the authorized user, as well as certified translation in Macedonian language.

## **Uniqueness of application**

### Article 176

One application may refer to protection and grant of the right to use only one geographical name relating to only one type of product.

## **Applicant**

### Article 177

The application for protection of a geographical name may be filed by:

- natural or legal persons which produce a given product and associations having capacity to acquire rights and incur liabilities relating to protection and right of use;
- state administrative body, local administrative body and chambers interested in protection of geographical names in the region of their activity.

## **Contents of application for protection of a geographical name**

### Article 178

(1) The application for protection of geographical name shall contain a request for protection of the geographical name with indication that the requested protection is by geographical indication or appellation of origin.

(2) The application for protection of geographical name by appellation of origin, apart from the request for protection of geographical name, shall also contain elaboration for the product which shall be marked with the geographical name.

(3) The application for protection of geographical name by geographical indication, apart from the request for protection of geographical name, shall also contain specification for the product which shall be marked with the geographical name.

(4) If the Application for protection of a geographical name by geographical indication is applied for wines and spirits, instead of a specification it contains an elaborate for the product.

(5) The contents and form of the Application from paragraph (1) of this article, the elaborate, specification and the other components and supplements added to the Application shall be prescribed with the regulation issued by the Director of the Office.

## **Elaboration**

### Article 179

(1) The elaboration shall be prepared by an institution that fulfills the requirements provided for in the regulations issued by the Director of the Office.

(2) The institution competent on preparing the elaboration or any other institution that fulfills the requirements provided for in the regulations issued by the Director of the Office shall perform the control of the particular characteristics of the product and shall issue evidence for that.

(3) The applicant for protection of geographical name with geographical indication shall prepare the specification and guarantee for the data therein.

## **Registers**

### Article 180

(1) The Office shall keep register of applications for protection of geographical names and register of applications for use of protected geographical names, register of protected geographical names and register of authorized users of protected geographical name.

(2) The contents and the manner of maintenance shall be prescribed with the regulation issued by the Director of the Office.

(3) On written request of interested party the Office shall issue excerpt from the registers.

## **Acquisition of right**

### Article 181

(1) Protection of the name of the place of origin of product by geographical indication or appellation of origin shall be made by issuing a decision and entering the geographical name of the product and type of product to which that name refers in the register of protected geographical names.

(2) The right to use protected geographical names shall be acquired by issuing a decision for grant of the right and entering it in the register of authorized users of protected geographical names.

## **Term of protection**

### Article 182

(1) The term of the protection of the geographical name is unlimited.

(2) The right for use of the protected geographical name is for a period of five years, considering from the day of adoption of the decision.

(3) The validity of the right to use may be renewed for an unlimited number of times, by increments of five years each time, under the condition that the holder of the right, during the fifth year of the validity period, submits a request for renewal to the Office for the protected geographical name.

(4) The contents and form of the request for renewal of the validity shall be prescribed by the regulation issued by the Director of the Office.

(5) The right to use the protected geographical name shall be renewed, if the conditions for granting of that right are fulfilled, if the opposite is true, the right shall terminate to be valid the following day from the day of expiry of the fifth year from its validity.

## **Right of use**

### Article 183

(1) The appellation of origin is a collective right and may be used exclusively by legal and natural persons which:

1. produce a product the geographical name of which has been protected with appellation of origin;
2. fully perform the production process in the geographical region specified in the elaboration;
3. are entered in the register of authorized users as users of that appellation of origin.

(2) The geographical indication is a collective right and may be used exclusively by legal and natural persons which:

1. produce a product the geographical name of which has been protected with geographical indication;
2. perform the production and/or processing and/or the preparation of the product in the geographical region specified in the specification;
3. are entered in the register of authorized users as users of that geographical indication.

### **Contents of application for grant of right to use**

#### Article 184

(1) The Application for recognition of the right to use contains the following:

- 1) Request for recognition of the right to use a protected geographical name;
- 2) Evidence for performing certain activity;
- 3) Evidence for a performed control, if granting of a right to use the appellation of origin is requested, i.e. statement from the applicant, if granting of the right to use a geographical indication is required; and
- 4) evidence for a performed control, if granting is requested of the right to use geographical indication in case of wines and spirits.

(2) The contents and form of the Application from paragraph (1) of this article, as well as the other components and supplements shall be prescribed with the regulation issued by the Director of the Office

### **Examination of application**

#### Article 185

(1) If the application does not contain all the necessary elements and supplements under this Law and the regulations issued by the Director of the Office, the Office shall notify the applicant to correct the established defects within 30 days from the day of receipt of the notification.

(2) On reasoned request of the applicant, the time limit referred to in paragraph (1) of this Article may, for the justified reasons, be extended by no more than 30 days.

(3) If the applicant, within the prescribed time limit, fails to correct the application or pay the expenses for correcting the application, the Office shall issue a conclusion for rejection of the application for protection of geographical name or the application for use of a protected geographical name.

## **Fulfillment of requirements**

### Article 186

If under this Law and the regulations issued by the Director of the Office the Office establishes that the application is proper, it shall examine the application and determine whether it complies with the prescribed requirements for protection of geographical name or grant of right to authorized user.

## **Proceeding application and deciding**

### Article 187

(1) If the Office determines that the application does not fulfill the requirements for protection of geographical name or grant of right to authorized user of protected geographical name, it shall notify the applicant in writing about the grounds for which the geographical name cannot be protected or the right to authorized user granted and invite him to declare himself thereon within 90 days from the date of receipt of notification.

(2) On reasoned request of the applicant, the time limit referred to in paragraph (1) of this Article may, for justified reasons, be extended by no more than 90 days.

(3) If the applicant does not, within the prescribed time limit, declare himself or if he does so and the Office decides that it cannot protect the geographical name or grant the right to authorized user of a protected geographical name, it shall issue a decision for refusal of the application for protection of geographical name or the application for grant of right of authorized user of geographical name.

(4) If in the case referred to in paragraph (3) of this Article the subject matter is an application for protection of geographical name with appellation of origin which complies with the requirements for protection by geographical indication, the Office shall notify the applicant of that fact and, with his consent, it shall protect geographical name with geographical indication.

## **Granting a decision**

### Article 188

(1) If the application for protection of geographical name complies with the requirements under this Law, the Office shall issue a decision for protection of the geographical name and enter it in the register of protected geographical names.

(2) If the application for grant of right to authorized user of geographical name complies with the requirements under this Law, the Office shall invite by conclusion the applicant to pay within 30 days from the date of receipt of conclusion the, fee for grant of right of authorized user of geographical name for the first 5 years, the expenses for publishing the data on the granted right to use a protected geographical name and the expenses for issuing a certificate, as well as to submit evidence of the payments.

(3) If the applicant fails to submit evidence of the made payments within the time limit referred to in paragraph (2) of this Article, the Office shall issue a conclusion for rejection to grant right to authorized user of protected geographical name.

## **Entry into registers**

### Article 189

If the applicant submits evidence of the made payments under Article 188 paragraph (2) of this Law, the Office shall issue a decision for grant of right to authorized user and enter the name of the applicant in the register of authorized users of protected geographical name and the register of protected geographical names.

## **Publication of protected geographical name**

### Article 190

(1) The publication of the protected geographical name in the Official Gazette of the Office shall be done ex officio.

(2) The data on the protected geographical name which are being published in the Official Gazette of the Office shall be prescribed by the regulations issued by the Director of the Office.

## **Publication of data on authorized user**

### Article 191

(1) When the holder of the user right pays the expenses for publication of the right of authorized user, the Office shall publish the data on the granted right of authorized user in the Official Gazette.

(2) The data on the granted right of authorized user which are being published in the Official Gazette of the Office shall be prescribed by the regulations issued by the Director of the Office.

## **Certificate**

### Article 192

(1) The Office shall issue a certificate for the granted right to an authorized user of the protected geographical name, within six months from the day of issuing of the decision.

(2) The contents of the certificate from paragraph (1) of this article shall be prescribed by the regulation issued by the Director of the Office.

## **Rights of authorized user**

### Article 193

(1) The user of protected geographical name shall have the right to use it for marking exclusively the type of product entered in the register of protected geographical names kept by the Office.

(2) The right on use shall also refer to the use of the protected geographical name on packages, business certificates and marketing materials.

(3) The manner of marking the products geographical name of which has been protected shall be prescribed by the regulations issued by the Director of the Office.

## **Transferability**

### Article 194

(1) The right to use the protected geographical indication cannot be transferred, licensed or pledged with any kind of contract.

(2) If the protected geographical name is subject of previously applied for protection or registered trademark, that trademark cannot be transferred, licensed, pledged.

## **Prohibition**

### Article 195

- (1) The users of geographical names may request prohibition of:
1. direct or indirect unauthorized use of the protected geographical name for identical or similar products for the purpose of acquiring financial gain;
  2. marking products which do not originate from the place of origin indicated with the protected geographical name, even when the true geographical origin of the product is indicated, when translation of it is used or when it is accompanied by additional expressions, like “kind”, “type”, “sort”, “imitation”, etc.;
  3. any kind of use of a protected geographical name that damages or takes advantage of the reputation of the protected geographical name;
  4. any use of false information which may mislead the consumers as to the geographical origin, quality or characteristics of the product, placed on the packaging, business certificates or other documents, giving false impression as to the real origin;
  5. any other uses that may mislead the consumers as to the geographical origin of the product.

## **Free use**

### Article 196

(1) The authorized users of protected geographical names cannot request prohibition due to infringement of the right if the protected geographical name is being used for information or education of the public in a way that does not damage their interests.

(2) The use of geographical names for the purposes under paragraph (1) of this Article shall be performed without remuneration.

## **Changes in register**

### Article 197

(1) At a written request of the applicant or the authorized user of the protected geographical name, the Office shall enter in the adequate register all changes regarding the granted right of authorized user which occurred after the

filing of the application or the grant of the right, if they correspond to the factual situation.

(2) If the request refers to significant changes in the scope of production, the request shall be accompanied by evidence under Article 178 paragraphs (2) and (3) of this Law, no older than six months.

(3) The changes entered in the register of authorized users shall be published in the Official Gazette of the Office.

(4) The contents and form of the request for the recording of the changes shall be prescribed by the regulation issued by the Director of the Office.

### **Conditions for revocation of right to use**

#### Article 198

(1) The decision for grant of right of use of a protected geographical name may be revoked if established that the requirements for protection of geographical name provided for by this Law have ceased to exist. In the proceeding on the request for revocation of the decision for grant of right to use of a protected geographical name, the authorized user of the protected geographical name shall be obliged to prove that there are grounds for grant of the right.

### **Request for revocation of decision**

#### Article 199

(1) The decision for grant of right to use protected geographical name may be revoked ex officio or at proposal of an interested party or a public prosecutor.

(2) The request for revocation of the decision under paragraph (1) of this Article shall be filed to the Office in written form.

(3) The request referred to in paragraph (2) of this Article shall be accompanied by the necessary evidence.

(4) The Office shall, within 15 days of receiving the request, submit it to the holderr of the right of use and invite him to declare himself thereon within 30 days from the reception of the notification.

(5) The contents of the request for revocation of the decision from paragraph (1) of this article shall be prescribedwith the regulation issued by the Director of the Office.

## **Continuation of procedure for revocation of decision**

### **Article 200**

(1) If the person who filed the request for revocation of the decision for grant of right to use protected geographical name gives up the request during the procedure, the Office may continue the procedure ex officio.

(2) The right of use of protected geographical name granted to a person registered as authorized user shall terminate the day after the issuing of the decision for revocation of that right.

## **PART FIVE**

### **JUDICIAL PROTECTION**

#### **Infringement of rights**

### **Article 201**

(1) The person who shall infringe the right to industrial property under this Law shall be responsible for the damage according to the general rules for remuneration of damages.

(2) The person whose right was infringed may request, apart from the remuneration, that the court orders the person who had infringed the right to desist any future infringement, confiscate and destroy the products produced or put on the market that infringe the right, request submission of the documentation and the data on the person who infringed the right and publish the decision stating the infringement in the media on expense of the infringing party.

#### **Action**

### **Article 202**

(1) An action for infringement of the rights under this Law may be instituted by the applicant, the right-owner, the person who was granted exclusive license, the authorized user of geographical indication and the appellation of origin or the authorized user of collective and certification mark.

(2) The court may interrupt the procedure for infringement of right of applied for protection patent, industrial design, trademark and use of geographical indication or appellation of origin until the Office issues a decision for grant of the right.

(3) Infringement of applied for protection right or granted right under this Law shall be any unauthorized exploitation, disposal, limitation, imitation, association, disturbing thereof, etc. which is contrary to the provision of this Law.

(4) Imitation within the meaning of paragraph (3) of this Article shall be established if the average consumer, regardless the type of goods, can notice difference only by paying particular attention, i.e. if the trademark is translation, transcription or transliteration.

(5) The plaintiff shall accompany the action for infringement of patent right by adequate written evidence under Article 54 of this Law.

(6) The court may prescribe the time limit within which the plaintiff has to file the evidence under paragraph (5) of this Article.

(7) If the evidence referred to in paragraph (5) of this Article is not filed within the time limit prescribed by the court, the action shall be rejected.

### **Time limit for institution of action**

#### Action 203

The action for infringement of rights under this Law may be instituted within 3 years from the day the plaintiff learnt about the infringement and the infringer, and no later than 5 years from the day of the infringement.

### **Urgency of procedure**

#### Article 204

The action for infringement of protection of rights under this Law shall be expeditious.

### **Declaring a patent owner i.e. industrial design owner**

#### Article 205

The inventor or the autor, his heir or any other successor in title may institute an action before the competent court and request to be declared owner of the patent or industrial design during the entire term of validity of that patent or industrial design, if that right was granted to a person who is not a inventor or autor, his heir or any other successor in title.

### **Entry in register**

#### Article 206

(1) Within 90 days from the date of submission of the final judgment accepting the request, the plaintiff may request to be entered into the adequate register as an owner of the appropriate right and adequate certificate to be issued to him by the Office.

(2) If the person whose request was accepted within the time limit referred to in paragraph (1) of this Article fails to file a request to be entered in the

adequate register as owner of the granted right, the right shall be deleted from that register.

### **Right of third person**

#### Article 207

The rights which a third person has acquired from the former right-owner shall also apply to the new right-owner if they had been entered in the adequate register or properly filed for registration before the action.

### **Dispute regarding recognition of authorship**

#### Action 208

(1) The inventor of the patent or the autor of the industrial design may institute an action to the competent court asking to be mentioned in the application and the documents.

(2) In case of death of the inventor or autor referred to in paragraph (1) of this Article, the right for instituting an action passes on his heirs.

### **Request for publication of judgment**

#### Article 209

(1) Apart from the request under Article 201 paragraph (2) of this Law, the plaintiff may also ask for court decision recognizing him as inventor or autor to be published on the expense of the defendant.

(2) Apart from the request referred to in paragraph (1) of this Article, the plaintiff may also request remuneration for non-material damage.

### **Time limit for filing action**

#### Article 210

The action for infringement of right according to Article 208 of this law may be initiated from the date of filing an application during the entire term of validity of the patent or the industrial design.

## **Infringement of moral right**

### Article 211

In case of infringement of moral right, the court may rule the inventor or autor to receive adequate remuneration for damage on his personality, honor and reputation, i.e. for non-material damage, if that is prescribed as justified under the circumstances in the case, particularly the degree of damage and its duration.

## **Contesting right to trademark**

### Article 212

(1) Legal or natural person may institute an action and request the competent court to establish that the sign he uses on the market to mark his goods or services is identical with or similar to the trademark used by another legal or natural person to mark his own goods or services of the same or similar type and that that sign was generally known as sign for marking of the goods or services of the plaintiff even before the defendant had filed the trademark application.

(2) The plaintiff may ask the court to issue a decision declaring him trademark-owner.

(3) The action under paragraph (1) of this Article shall not be accepted by the court if the defendant, the trademark-owner, proves that he had used the mentioned sign for the same or similar type of goods or services even before filing the application for as long as the plaintiff or longer.

(4) The action under paragraph (1) of this Article may not be instituted after the expiration of the time limit of 5 years from the date of entering the trademark in the trademark register.

## **Other cases of disputes regarding the right to a trademark**

### Article 212-a

The person that owns a company at the time of filing of an Application for recognition of the right to trademark, with the name of the company being identical with a trademark of another person, that person may dispute that trademark for the same or similar type of goods and services, except if the owner of the trademark at the time of his filing had the same type of company, i.e. the same company name.

## **PART SIX**

### **SECURITY MEASURES**

#### **Provisional measures**

##### Article 213

The right-owner who can initiate an action for infringement of his rights under this Law may also submit to the court request for ruling provisional measures under the conditions and in the manner provided for by the Law on executive procedure.

#### **Submission of data and other documents**

##### Article 214

(1) The right-owner may request the persons who were in any way connected with the infringement of the right acquired under this Law (producer, publisher, importer, distributor, consignor, owner, seller, owner of samples, items or means with which his right was infringed and other persons) to submit the data and documents regarding the infringement without delay.

(2) If the persons referred to in paragraph (1) of this Article fail to submit the data or document at their disposal, they shall be responsible for remuneration of damages caused by that failure.

(3) If the right-owner referred to in paragraph (1) of this Article abuses the data or documents acquired from the persons under paragraph (1) of this Article, causing them damages, he shall be obliged to remunerate the damages under the general provisions for remuneration of damages.

#### **Border measures**

##### Article 215

(1) If the right-owner lodges an application that the import of given goods in the Republic of Macedonia infringes his rights acquired under this Law, at his request, the customs officials may rule the following border measures:

1. an authorized customs employee, accompanied by the right-owner or his representative, to inspect the goods which are being imported and exclude them from trade or store them in a safe place, unless the importer has authentic evidence on the production of the goods he is importing.

(2) At request of the customs officials or the importer, the right-owner shall be obliged to submit bail for possible damages caused by the measures under paragraph (1) of this Article.

(3) The customs officials shall immediately notify the importer and receiver of goods of the ruled measures.

(4) The customs officials shall suspend the ruled measures under paragraph (1) of this Article if the right-owner does not institute an action for infringement of right to the competent court within 8 days from the date of filing the request.

### **Civil penalty**

#### **Article 216**

(1) During an infringement of rights acquired under this Law, if the right has been infringed intentionally and because of omission, the right-owner may request payment of the usual remuneration increased by 200%, regardless whether the infringement resulted in material damage.

(2) On deciding on the request for payment of remuneration under paragraph (1) of this Article and determining the amount, the court shall take into consideration all circumstances in the case, particularly the degree of guilt of the defendant, the amount of the usual remuneration and the preventive purpose of the penalty.

(3) If the material damage is higher than the penalty, the right-owner may request remuneration of the difference until full compensation.

## **PART SEVEN**

### **TRANSFER OF INDUSTRIAL PROPERTY RIGHTS**

#### **Agreement for transfer of right**

#### **Article 217**

(1) The applicant for industrial property right and the right-owner may by agreement fully or partially transfer their right under the conditions prescribed by this Law and other provisions.

(2) The agreement for transfer of right shall be filed in written form and the signatures of the parties in the agreement shall be certified by a notary public.

(3) On request of one of the parties in the agreement, the agreement under paragraph (2) of this Article shall be entered in an adequate register kept by the Office.

(4) The agreement under paragraph (2) of this Article which has not been filed in written form and certified shall not have legal effect.

(5) The Agreement on Transfer of Right that is not registered in the adequate register of the Office shall not have legal effect for third persons.

## **License agreement**

### Article 218

(1) The applicant for industrial property right and the patent-owner may by agreement fully or partially license the use of that right under the conditions prescribed with this law and with other regulations.

(2) The license agreement shall be filed in written form.

(3) If the patent application was filed by more than one person or more than one person is patent-owner, consent from all patent-owners shall be necessary for concluding a license agreement.

(4) If there is no consent for conclusion of an Agreement for License from paragraph (3) of this article, in relation to delegation of a right to use, the rules for ownership shall apply.

(5) License agreement which has not been filed in written form shall not have legal effect.

(6) The Agreement for License, upon request of one of the contractual parties shall be entered in the adequate Register in the Office

(7) License agreement which has not been entered in the adequate register shall not have legal effect for third persons.

## **Elements of license agreement**

### Article 219

The license agreement shall contain: file information, duration of license, scope of license, whether the license is exclusive and the amount of remuneration paid for the licensed right, where such remuneration has been agreed.

## **Declaring license agreement as nullity**

### Article 220

In the license agreement, any provision which poses limitations to the licensee that do not result from the right which is subject matter of the agreement or which is unnecessary for maintaining that right shall be declared as nullity.

## **PART EIGHT**

### **TERMINATION OF PATENT AND TRADEMARK IN CASE OF NON-USE**

#### **Termination of patent**

##### Article 221

(1) The Office may issue a decision for termination of patent if grant of compulsory license could not reach the goal for which it was granted, at request of an interested legal or natural person and according to previously acquired opinion of the administrative body competent in the area in which the patented invention should be exploited.

(2) The request for terminating the patent cannot be filed before expiring of two years from the date of grant of the first compulsory license.

(3) The request referred to in paragraph (2) of this Article shall be filed to the Office in a written form.

(4) Within 15 days from the receiving the request, the Office shall submit the request to the patent-owner and invite him to declare himself thereon within a prescribed period not longer than 60 days from receiving the notification.

(5) The contents of the request for termination of a patent due to non-use shall be prescribed by the regulation issued by the Director of the Office.

#### **Termination of trademark**

##### Article 222

(1) If the trademark-owner has not used the trademark for marking the goods or services it refers to without justified reasons for over 5 years continuous period from the date of entering the trademark in the trademark register or from the date when the trademark was last used, the Office may at request of an interested person issue a decision for termination of that trademark.

(2) In the procedure on the request for termination of a trademark, the trademark-owner shall have to prove that he is using the trademark.

(3) The right to collective mark may also be terminated if the trademark is not used under the general act or contract for collective trademark.

(4) The request referred to in paragraphs (1) and (3) of this Article shall be filed to the Office in written form.

(5) Within 15 days from the reception of the request, the Office shall submit it to the trademark-owner and invite him to declare himself within a prescribed period not longer than 60 days from the date of reception of the notification.

(6) The contents of the request for termination of the trademark due to non-use shall be prescribed by the regulation issued by the Director of the Office.

### **Decision for termination of right**

#### Article 223

(1) The patent and the trademark shall stop being valid the date when the decision of the Office for termination enters into force.

(2) The decision referred to in paragraph (1) of this Article shall be recorded into the appropriate register and published in the Official Gazette of the Office.

## **PART NINE**

### **DECLARING DECISION FOR GRANT OF INDUSTRIAL PROPERTY RIGHTS AS NULLITY**

#### **Declaring nullity**

#### Article 224

The Decision for grant of the right to industrial property shall be declared of nullity, if evidence is put forward that the conditions prescribed by this law for recognition of that right were not there.

#### **Proceeding proposal**

#### Article 225

(1) The decision for grant of industrial property right may be declared of nullity during the whole term of protection, ex officio, at proposal of an interested person or at proposal of the public prosecutor.

(2) The proposal for declaring a decision as nullity shall be filed to the Office in a written form.

(3) The proposal under paragraph (1) of this Article shall be accompanied by the necessary evidence.

(4) The Office shall submit the proposal to the right-owner within 15 days from the reception thereof and invite him to declare himself thereon within

prescribed period that cannot be longer than 60 days from the reception of the proposal.

(5) The contents of the Proposal for declaring the Decision as nullified shall be prescribed with the regulation issued by the Director of the Office.

#### Article 225-a

The Decision to declaration of nullity of a Decision for granting of the right to industrial property shall be entered in the adequate Register, and it shall be published in the Official Gazette of the Office.

### **Weaver of proposal**

#### Article 226

If the person filing the proposal for declaring as nullity the decision for grant of industrial property right renounces the proposal during the procedure, the Office may continue the procedure ex officio or on request of the owner of that right.

## **PART TEN**

### **REPRESENTATION**

#### Article 227

(1) In the procedure for protection of industrial property rights in front of the Office and in front of other State Administration bodies, the client may be represented by natural and legal persons entered in the register kept by the Office.

(2) In the register referred to in paragraph (1) of this Article the Office may enter:

- natural person who has graduated at the faculty of law or any technical faculty and passed the specialist examination in industrial property or special examination in the field regulated by this Law and taken in the Office;

- legal person who has at least one employee who has graduated at the faculty of law or any technical faculty and fulfils the conditions referred to in item 1 of this Paragraph.

(3) The conditions for taking the special examination for representatives for protection of the rights to industrial property; the organization, the contents and the Program for the special examination; the exam commission; the procedure for conduction of the exam; the contents, form, as well as the procedure after the application for entry in the representatives register maintained by the Office for protection of industrial property; the contents of the

Representatives Register; publication of data from the representatives register in the Official Gazette of the Office; certificate for regular representative; the contents, form, as well as the procedure after the request for recording changes in the representatives register; the period for application for renewal of the entry in the representatives register; the contents, form, as well as the procedure after the request for renewal of the entry in the representatives register and deleting from the representatives register, shall be prescribed by regulation issued by the Director of the Office.

## **PART TEN-a**

### **SUPERVISION**

#### **Supervision**

##### Article 227-a

The Ministry of Economy shall conduct supervision of the implementation of the provisions from this law and the regulations issued according to this law.

##### Article 227-b

Inspection supervision of the implementation of the provisions from this law, regarding trade and the use of the protected rights to industrial property shall be conducted by the State Market Inspectorate.

## **PART ELEVEN**

### **PENALTY PROVISIONS**

##### Article 228

(1) Fine in the amount of MKD 150,000 to MKD 300,000 shall be imposed to the legal person which:

1. performs unauthorized representation of foreign legal and natural persons (Article 16 of this Law);
2. performs unauthorized use of applied for protection or protected invention (Article 202 paragraphs (3) and (4) of this Law);
3. performs unauthorized use or imitation of applied for protection or protected industrial design (Article 202 paragraphs (3) and (4) of this Law);

4. performs unauthorized use or imitation of applied for protection or protected trademark (Article 202 paragraphs (3) and (4) of this Law);
5. If an unauthorized person uses the label ® for a trademark that has not been registered;
6. performs unauthorized use or imitation of a well-known trademark (Article 202 paragraphs (3) and (4) of this Law);
7. performs unauthorized use or imitation of protected geographical name (Article 202 paragraphs (3) and (4) of this Law);
8. at request of the right-owner, does not submit the documents and data regarding an infringement (Article 201 paragraph (2) of this Law and Article 214 of this law).

(2) For offences referred to in paragraph (1) of this Article, the competent employee in the legal person shall also be imposed a fine in the amount of MKD 25,000 to MKD 50,000.

(3) For offences referred to in paragraph (1) of this Article, the legal person shall be ruled the security measure prohibition of performing the activity in the period of six months to one year.

(4) Fine in the amount of MKD 10,000 to MKD 50,000 shall be imposed on the person who independently performs economic or professional activity without the capacity of legal entity if he performs any of the activities under Article 228 of this Law.

(5) Fine in the amount of MKD 10,000 to MKD 50,000 shall be imposed on natural person if he performs any of the activities under Article 228 of this Law.

(6) For offences referred to in paragraph (1) of this Article, the natural person shall be ruled the security measure prohibition of performing the activity in the period of six months to one year.

## **PART TWELVE**

### **TRANSITIONAL AND FINAL PROVISIONS**

#### **Issuing sub-law acts**

##### **Article 229**

(1) The regulations provided by in this Law shall be enacted by December 31<sup>st</sup> 2003

(2) The Regulation from article 66, paragraph (2) of this law shall be issued within a period of one year from the day of initiation of the application of this law.

## **Procedures in course**

### Article 230

(1) In the administrative procedures for recognition of the rights to industrial property for applications submitted before the implementation of this law, the provisions from this law shall apply, except for the applications upon which the Office has already undertaken certain activities before the implementation of this law.

(2) The procedures for infringement of industrial property rights which were not finished by the date of entry into force of this Law shall be finished under the provisions which were in force until the date of implementation of this Law.

(3) The procedures for declaring as nullity a decision for grant of industrial property rights which were not finished by the date of entry into force of this Law shall be finished under the provisions which were in force until the date of implementation of this Law.

(4) The procedures on patent applications for plant variety and hybrid which were not finished by the date of entry into force of this Law shall be finished under the provisions which were in force until the date of implementation of this Law.

(5) The provisions under Article 66 paragraph (2) of this Law for extension the term of validity of patents with supplementary certificate shall be applied to the applications filed to the Office after the date of implementation of this Law.

(6) The rights to plant variety and hybrid which are valid at the date of entry into force of this Law shall continue to be valid under the provisions which were in force until the date of implementation of this Law.

(7) The rights to model and design which are valid at the date of implementation of this Law shall continue to be valid under the provisions of this Law.

(8) The application for obtaining rights to industrial property by electronic means shall be applied from the moment of creation of conditions for implementation.

## **Continuity**

### Article 230-a

(1) On the day of enforcement of this Law, the Industrial Property Protection Office shall continue its operation as a State Office of Industrial Property.

(2) The Director of the Industrial Property Protection Office shall continue to perform the function of Director of the Office.

(3) The employees, equipment, fixtures and fittings, as well as other things, the archive, documents, operative means and other means from the Industrial Property Protection Office shall be transferred in the State Office of Industrial Property

### **Termination of validity**

#### Article 231

On the date of application of this Law, the validity of the Industrial Property Law (“Official Gazette of the Republic of Macedonia”, No. 45/93) shall terminate.

### **Entry into force**

#### Article 232

This Law shall enter into force on the eighth day of its publication in the “Official Gazette of the Republic of Macedonia” .