

# The Role of Trademarks in Kosovo: Steps Towards Harmonisation with the EU Normative Framework

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## **Abstract**

*The main aim of this paper is to analyse the treatment and importance of trademarks in Kosovo and the need to harmonise the legal framework of the Republic of Kosovo with that of the European Union. The inadequate legal framework, which led to inconsistencies between local and European legislation, caused numerous problems in practice, regarding the ineffective implementation and insufficient protection of these rights. To avoid these legal gaps and find adequate solutions to the identified problems, a new legal infrastructure was created with the entry into force of Law No. 08/L-075 on Trademarks in Kosovo, with the aim of promoting the economic development of the country by encouraging businesses, increasing investment, ensuring fair competition and protecting consumers. The amendment of this law comes as a necessity for its compliance with EU Directive 2015/2436 and Directive 2004/48/EC of the European Parliament and of the Council. Trademarks are of great importance, especially in the business sector, because further development of this legislation will create a safe environment for businesses, which will have an impact on the economic development of the country. In this paper, we have used comparative historical and case study methods. The result of this paper will contribute to further improvements of our trademark legislation, as well as to the legal doctrine in Kosovo that lacks such.*

**Keywords:** trademarks, industrial property, harmonisation, judicial protection.

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## **1. Introduction**

The legal framework governing intellectual property rights, particularly in the realm of trademark protection, has faced significant challenges in the Republic of Kosovo. The legislation of the Republic of Kosovo has been lacking in the regulation of rights in the field of trademarks, particularly in alignment with the EU's intellectual property acquis. The incomplete legal framework, due to the partial transposition of the EU acquis, has negatively impacted the protection and effective enforcement of trademark owners' rights. One of the most prominent problems has been the trend of selling counterfeit products by unauthorised individuals, discouraging the holders of these rights from engaging in innovative activities. The consequence of all this is the lack of awareness, education and information of consumers, who are offered counterfeit goods at more favourable prices and with more attractive offers than buying original products. Through these purchases, consumers contribute to an informal and unstable trade, which negatively affects the economic development of the country. The increase in sales of counterfeit products contributes to the rise of economic crime through the generation of illegal income from counterfeiting. Consequently, non-original products are offered on the market and low-quality services become available in Kosovo, while trademark owners are economically damaged and have no economic incentive to offer their products and services.

This paper presents a novel approach by examining the harmonisation of Kosovo's trademark legislation with the EU acquis. Unlike existing doctrinal approaches, this study not only highlights the legislative discrepancies but also provides a detailed analysis of the practical implications of these gaps.<sup>2</sup> The new Trademarks Law, which came into force in Kosovo on July 28, 2022, presents one of

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<sup>2</sup> See Law No. 08/L-075 on Trademarks, Official Gazette of the Republic of Kosovo, No. 18/22, available at <https://gzk.rks-gov.net/ActDetail.aspx?ActID=60331>, last accessed, May 1, 2024. See more about a comparative analyse in Duina, Francesco, and Crina Viju-

the main innovations. This law has brought significant changes aiming to harmonise local legislation with the European Union's trademark legislation, particularly with Directive (EU) 2015/2436<sup>3</sup> to approximate the laws of the Member States relating to trademarks and with Directive 2004/48/EC<sup>4</sup> on the enforcement of intellectual property rights. While the conditions and procedures for the registration and protection of trademarks in Kosovo have been in place for many years, the new legislation makes significant changes and in particular, brings Kosovo's rules closer to EU legislation and standards for trademarks. To avoid these legal gaps, Kosovo has signed the Stabilization and Association Agreement, through which the Republic of Kosovo is obliged to harmonise national legislation with that of the EU. The Stabilization and Association Agreement regarding general aspects of intellectual property in Article 77 states that „1. Pursuant to this Article and Annex VII, the Parties confirm the importance that they attach to ensuring adequate and effective protection and enforcement of intellectual, industrial and commercial property rights. 2. Kosovo shall take the necessary measures in order to guarantee no later than five years after the entry into force of this Agreement a level of protection of intellectual, industrial and commercial property rights similar to that existing in the EU, including effective means of enforcing such rights. 3. Kosovo undertakes to abide by the multilateral conventions on intellectual, industrial and commercial property rights referred to in Annex VII. The SAC may decide to oblige Kosovo to abide by specific multilateral Conventions in this area“.<sup>5</sup>

Trademark legislation in Europe is based on several important legal instruments such as Directive 2015/2436 of the European Parliament and the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks, Directive 2004/48/EC on the enforcement of intellectual property rights and Regulation 2007/1001<sup>6</sup> of the European Parliament and the Council on the EU trademarks. These directives eliminate disparities between national laws that can hinder the free movement of goods and services and distort competition. „The Directive covers the most important aspects of trademark law, such as what can constitute a trademark, distinctiveness, absolute and relative grounds for refusal, scope of protection, exhaustion of rights, licensing, genuine use, cancellation, and revocation. As a result of the transposition of the First Directive into national law, the substantive provisions of national trade mark laws are practically identical throughout the EU“.<sup>7</sup>

This EU legal framework aims to advance and modernize the current legislation to make trademark registration systems across the EU more accessible and efficient for economic entities, both in terms of lower costs and in terms of swift protection and legal certainty. Although, trademark legislation in the EU has been largely harmonized in both theory and practice, it still relies on national courts to enforce this law.<sup>8</sup> Additionally, trademarks are also protected by other international instruments such as the Paris Convention for the Protection of Industrial Property, the Madrid Agreement for the International Registration of Trademarks along with its protocol, the TRIPS<sup>9</sup>

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Miljusevic (eds), *Standardizing the World: EU Trade Policy and the Road to Convergence* (New York, 2023; online edn, Oxford Academic, 20 Apr. 2023), <https://doi.org/10.1093/oso/9780197681886.001.0001>, accessed 28 Oct. 2024.

<sup>3</sup> Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (recast) (text with EEA relevance). For details, see the European Union's website at <https://eur-lex.europa.eu/eli/dir/2015/2436/oj>, last accessed May 1, 2024.

<sup>4</sup> Corrigendum to Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (OJ L 157, 30.4.2004), available at <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A32004L0048R%2801%29>, last accessed May 2, 2024.

<sup>5</sup> The Stabilization and Association Agreement between Kosovo on one side and the European Union and the European Atomic Energy Community on the other side is the first international contractual agreement between Kosovo and the EU, signed on October 27, 2015, in Strasbourg. It was ratified by the Assembly of the Republic of Kosovo on November 2, 2015, with the approval of Law No. 05/L-069 on the ratification of the Stabilization and Association Agreement between Kosovo on one side and the European Union and the European Atomic Energy Community on the other side. Available at <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=celex%3A2016A0316%2801%29>, last accessed May 7, 2024.

<sup>6</sup> Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, available at <https://eur-lex.europa.eu/eli/reg/2017/1001/oj>, last accessed May 7, 2024.

<sup>7</sup> Charles Gielen, "Trademark Dilution in the European Union," in *Trademark Dilution and Free Riding: Elgar Intellectual Property Law and Practice Series*, ed. Daniel R. Bereskin (Edward Elgar Publishing, 2023), p. 223.

<sup>8</sup> Katja Weckström, *A Contextual Approach to Limits in EU Trade Mark Law* (Helsinki: IPR University Center 8, 2011), p. 14.

<sup>9</sup> The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) is an international agreement on intellectual

Agreement, etc.<sup>10</sup> In Kosovo, a significant contribution to strengthening trademark legislation has been made by competent bodies such as the Agency for Industrial Property (API), the Ministry of Trade and Industry, Customs, the Police, the Market Inspectorate, the Prosecution, the Judiciary, and the Ministry of Justice, which are responsible for drafting legislation and protecting trademarks. Unlike the aforementioned bodies, the API is also competent for registering trademarks as well as for monitoring legislative developments at the European and international levels with the aim of ensuring the harmonisation of applicable industrial property legislation in the Republic of Kosovo.

## 2. Main objectives and the significance of the study

This study has as its objective the treatment and importance of trademarks in Kosovo and the need to harmonise the laws of the Republic of Kosovo with those of the European Union. This paper also aims to highlight the study of trademark legislation elaborated through cases from the judicial practice of Kosovo and aims to provide solutions to these legal gaps encountered during practice. Also, through this paper, the new Law of Trademarks in Kosovo is analysed in a comparative way in relation to the EU trademark legislation.

With the entry into force of the new Law on Trademarks, our legislation was brought closer to that of the EU.

Also, as a result of this law, the first multimedia trademark in Kosovo was registered for the first time.

The provisions of this law regarding civil legal protection define more concrete steps for subjects who have the right to request the protection of their rights to prevent the continuation of the violation.

### 2.1. Literature review

The focus of this study is the literature used in the legal treatment of trademarks. In Kosovo, the legal framework for trademarks has evolved, influenced by international standards and the need to integrate into the global economy. The literature review examines the legal infrastructure, challenges, and developments in trademarks law in Kosovo compared to the EU's trademarks legislation. Actually, trademarks are regulated by Law no. 08/L-075 on trademarks, which was adopted in 2022, by the Assembly of the Republic of Kosovo, repealing the previous legislation, which was not fully compatible with the normative framework of the EU. This law aligns with European Union standards, reflecting Kosovo's aspirations for EU integration. Although, trademarks are also protected internationally through international legal instruments, unfortunately, Kosovo is not a member of the World Intellectual Property Organization (WIPO) and not a signatory to several international agreements, such as the Paris Convention for the Protection of Industrial Property and the Madrid Protocol for the International Registration of Marks. Regardless of the evolution of the legal framework, enforcement remains a significant challenge in practice<sup>11</sup>. The judicial system in Kosovo faces challenges, including frequent cases of trademark infringement. Recent amendments to trademark laws aim to enhance clarity and strengthen enforcement mechanisms.

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property rights at the international level, established between all member countries of the World Trade Organization (WTO). This Agreement constitutes Annex 1C of the Marrakesh Agreement Establishing the World Trade Organization, which was signed on April 15, 1994, and entered into force on January 1, 1995. The TRIPS Agreement was negotiated during the Uruguay Round of the General Agreement on Tariffs and Trade (GATT) from 1986 to 1994. Available at [https://www.wto.org/english/docs\\_e/legal\\_e/27-trips.pdf](https://www.wto.org/english/docs_e/legal_e/27-trips.pdf), last accessed May 7, 2024.

<sup>10</sup> Lavinia Brancusi, *EU trade mark law and product protection: a comparative analysis of trade mark functionality* (New York: Routledge 4 Park Square, Milton Park, Abingdon, Oxon OX14 4RN, 2024), p. 21.

<sup>11</sup> See more in Viktor Muraviov, Nataliia Mushak, Tetiana Tarakhonch, „International agreements of the European Union and acquis of the Union”, *Juridical Tribune - Tribuna Juridica*, Volume 10, Special Issue, October 2020, pp. 49-71.

## 2.2. Methodology

The research methodology in this paper comprises several important elements in the treatment and importance of trademarks:

- the historical method is of great importance in terms of providing knowledge about the origin of trademarks and their evolutions. It offers us insights to understand from which time the use of trademarks has dated and the evolution of legislation during the time, that regulates it;
- the comparative method aims to identify similarities and differences between the trademark legislation in Kosovo with that of the EU, and the need for harmonisation with EU law.
- case study, with the application of this method, we have conducted a thorough exploration of trademark infringement, through judicial practices and applying this method contributes to refining existing theories or developing new hypotheses.

## 2.3. Results and discussion

With the enactment of the new Law on Trademarks, the legal framework in this area has been improved compared to the previous legislation, which was less harmonized with EU trademarks law. However, although this law has been harmonized to a considerable extent with EU law, differences still exist between Kosovo's trademark laws and those of the EU. There are areas where Kosovo's legislation lags behind compared to EU directives.

The steps towards harmonizing Kosovo's legislation with that of the EU have been of significant importance. The benefits of aligning Kosovo's trademark legislation with EU standards facilitate trade and investment in EU member states, contribute to economic growth and development, strengthen legal protection for trademark holders in Kosovo, enhance consumer confidence and protection and create opportunities for Kosovo businesses to compete in the EU market<sup>12</sup>. By aligning Kosovo's trademarks laws with the EU's directives and regulations, enhancing the capacity of national institutions to enforce trademarks efficiently, fostering collaboration with international bodies and neighbouring countries to combat the trade of counterfeit goods, increasing consumer awareness about the negative impacts of counterfeit goods and the importance of purchasing original products, Kosovo can achieve a more robust and efficient trademark protection system, fostering a healthier economic environment and better aligning with European standards.

## 2.4. Definition and types of trademarks in Kosovo

A trademark is a distinctive sign of a particular kind that identifies goods or services offered by individuals or companies to consumers. Through their use, we protect and distinguish our products and services from those of competitors. These rights are the subject of intellectual property and their protection is also guaranteed through the Constitution of the Republic of Kosovo in accordance with Article 46, paragraph 5.<sup>13</sup>

Law No. 08/L-075 on Trademarks, in Article 5, specifies that "A trademark may be any mark, in particular words, including personal names or drawings, letters, numbers, colours, the shape of goods or their packaging, or the sounds-voices, provided that such marks can: 1.1 distinguish the goods or services of an economic entity from those of another economic entity; and 1.2. are represented in the register in such a way as to enable the competent authorities and the public to clearly and precisely define the object of protection recognized to its holder".<sup>14</sup>

*"According to its nature, the right to a trademark is an absolute and exclusive right with*

<sup>12</sup> See more details about it in Cristina Elena Popa Tache, „Ranking of Treatment Standards in International Investments”, *International Investment Law Journal*, Volume 1, Issue 1, February 2021, pp. 79-87.

<sup>13</sup> See, Constitution of the Republic of Kosovo, article 46.5, available at [https://mapl.rks-gov.net/wp-content/uploads/2017/10/1.CONSTITUTION\\_OF\\_THE\\_REPUBLIC\\_OF\\_KOSOVO.pdf](https://mapl.rks-gov.net/wp-content/uploads/2017/10/1.CONSTITUTION_OF_THE_REPUBLIC_OF_KOSOVO.pdf), last accessed May 7, 2024.

<sup>14</sup> Law No.08/L-075 on Trademarks, article 5, Official Gazette of the Republic of Kosovo, No. 18, available at <https://gzk.rks-gov.net/ActDetail.aspx?ActID=60331>, last accessed May 7, 2024.

*limited territorial effects. It is an absolute right because the holder of this right can oppose any person who tries to use their trademark to mark their goods or services in economic circulation. It is an exclusive right because only the holder of that right has the exclusive right to mark goods or services in economic circulation. It is a right with limited territorial effect because this right is limited by the authority of a state that does not recognize and protect this right. It is a right that is not limited in time because, unlike other rights such as patents, designs, and models, where the usage period is limited, this right can exist indefinitely provided that the maintenance fee is paid, it is used in economic circulation, and the holder of this right continues to exist (does not cease)*.<sup>15</sup>

In Kosovo, trademarks are classified into several categories based on their nature and use. The main types of trademarks in Kosovo include Word Marks that consist only of words, numbers, or letters used to distinguish goods or services of one enterprise from another, Figurative Marks include graphical or visual elements such as logos, symbols, or designs, Combined Marks include a combination of verbal and figurative elements, such as a logo containing text, 3D Marks (three-dimensional) that consist of three-dimensional shapes or designs, Color Marks consist of a single colour or a combination of colours, Sound Marks consist of specific sounds or melodies, Collective Marks are used by members of an association to identify their goods or services, Certification Marks are used to certify that goods or services meet certain standards and Service Marks are used to identify and distinguish services rather than goods.<sup>16</sup>

### 3. Registration of trade marks and the rights acquired from their registration

The registration of trademarks in Kosovo is carried out through the Office of Industrial Property, established on November 19, 2007. By registering a trademark, its owner gains exclusive rights as defined by specific law. *Trade mark law grants exclusive rights to control certain uses of signs in the marketplace. Exclusivity depends upon the recognition of property rights in those signs which indicate the commercial origin of goods or services*.<sup>17</sup> According to the Law on Trademarks of Kosovo, the registered trademark owner has the right to prohibit all third parties without their consent from using it in commercial activities related to goods or services, to prevent the placement of an identical or similar sign to the trademark on packaging, labels, or any other object where the mark can be placed, the right to have their trademarks cited in dictionaries, and the right to object to the unauthorized use of the trademark by a commercial representative when the trademark is registered in their name without their authorization and to request the transfer of the trademark in their name.

According to the new Law on Trademarks in Kosovo, the right of priority is granted to the applicant for the registration of a trademark, who has submitted a regular application for the registration of the trademark in the Republic of Kosovo, from any state that is a party to the Paris Convention or the Agreement Establishing the World Trade Organization, for the same trademark with goods or services that are identical or contain those for which the application has been submitted. They may be entitled to the right of priority of the first application, provided that they apply for the registration of the trademark in the Republic of Kosovo within six (6) months from the date of the first application.<sup>18</sup>

**Judicial Protection of Trademarks.** *”The legal protection of famous trademarks in the international in multilateral level is twofold: First, under the Paris Convention, an international treaty that establishes uniform criteria for the protection of industrial property among the signatory states. Second, under the Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS”), which operates under the auspices of the World Trade Organization and sets minimum*

<sup>15</sup> Adnan Jashari, *E drejta afariste: kontraktore* (Tetovë: Universiteti i Evropës Juglindore, 2016), p. 547.

<sup>16</sup> Luljeta Plakolli-Kasumi, *Trademark Protection and Enforcement* (Pristina: USAID, 2008), 53.

<sup>17</sup> Dev Gangjee, „Trade marks and Allied Rights“, in *The Oxford Handbook of Intellectual Property Law*, ed. Rochelle Dreyfuss and Justine Pila (Oxford: Oxford University Press, 2018), 642.

<sup>18</sup> See, Law No. 08/L-075 on Trademarks, Official Gazette of the Republic of Kosovo, available at <https://gzk.rks-gov.net/ActDetail.aspx?ActID=60331>, last accessed May 7, 2024.

*criteria for the protection of intellectual property*".<sup>19</sup>

Trademarks play an important role in market economies. The primary goal of trademark protection is to stimulate and ensure fair competition on one hand, and to protect consumers on the other hand. Infringement of trademarks occurs as a result of actions taken by unauthorized persons without the consent of the trademark owner in cases where one of their rights is violated. Therefore, as a consequence, the right of the trademark owner arises to prohibit third parties from using them without permission. Protection of trademarks in case of infringement is pursued through administrative, criminal and civil procedures. To pursue this legal protection, the holder of this right may file a lawsuit in court, through the development of a contentious procedure to protect his rights arising from trademarks against responsible parties for infringement. The exclusive competence to resolve such disputes lies with the Commercial Court of Kosovo. Through the lawsuit, the trademark owner requests the court to verify the infringement of the trademark and to order the cessation of such actions in the future, through which his rights are violated. Additionally, he has the right to claim compensation for unjust enrichment and lost profits. The court is obliged to specify in the dispositive of the judgment with which products the trademark is violated which must be withdrawn from the market.<sup>20</sup>

**Court Cases.** In the Basic Court in Pristina, the plaintiff NTP "B", filed a lawsuit due to trademark infringement against the defendant N.SH. "U". In his lawsuit, he emphasized that the business activity involves the production and import of diapers in accordance with legal provisions and has registered the mentioned trademark, both in word and figurative form. Despite this fact, the defendant has produced and packaged identical diapers and paper or cellulose bearing the mark "N", which is protected as a trademark in the Republic of Kosovo. The plaintiff proposed to the court to approve his lawsuit and verify that the defendant, through the production and packaging of diapers with the mark "N", has infringed his trademark, ordering him to cease such infringement in the future and compensate for the damage caused as a result of this infringement. He also requested the court to force the defendant to withdraw all his products from the market that constitute trademark infringement and to prohibit the defendant from using the word "N" in any form. He emphasized that his product and the defendant's product have marked similarities and may cause confusion among consumers. After evaluating the factual situation, the court found that the plaintiff's lawsuit for trademark protection is well founded. According to the court and the comparison of product samples, it concluded that the products could cause confusion among the public and consumers because both products are of the same nature, have the same purpose of use and are in competition with each other. Therefore, the court considers that the use of the letter "N" in the defendant's product is similar to the plaintiff's trademark. The similarities are at a level that could cause confusion among the public. A consumer might purchase the defendant's product thinking it is the plaintiff's trademark-protected product, a situation that could disadvantage not only the plaintiff but also the consumer.<sup>21</sup> Regarding confusion, the EU Council Regulation No. 40/49 of 1993 on Community Trade Marks emphasized that for the existence of similarities, it is not necessary for confusion to be created, but the possibility of causing confusion among consumers is sufficient.<sup>22</sup> Legal remedies for the protection of trademarks are also provided through international instruments such as the TRIPS Agreement and EU Directives, which foresee the obligation of states to ensure effective legal remedies for the protection of rights arising from trademarks. According to the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), Article 16 paragraph 1 states: "The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical

<sup>19</sup> Stylianos Malliaris, „Protecting Famous Trademarks: Comparative Analysis of the US and EU Diverging Approaches – The battle between legislatures and the judiciary who is the ultimate judge?“, *Chicago – Kent Journal of Intellectual Property* (2010): 48, [https://studentorgs.kentlaw.iit.edu/ckjip/wp-content/uploads/sites/4/2013/03/04\\_9JIntellProp452010.pdf](https://studentorgs.kentlaw.iit.edu/ckjip/wp-content/uploads/sites/4/2013/03/04_9JIntellProp452010.pdf).

<sup>20</sup> Gëzim Llulluni et al., *Praktika e Gjykatës së Apelit e fokusuar në çështjet e kthyerë në rishqyrtim*, (Prishtinë: Akademia e Drejtësisë dhe Programi i Kombeve të Bashkuara për Zhvillim dhe Bashkëpunim, 2019), p. 282.

<sup>21</sup> Case I.EK. nr. 257/17, Judgement of the Basic Court of Pristina, August 3, 2018.

<sup>22</sup> See for details, Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community trade mark, available at <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=celex%3A31994R0040>, last accessed May 7, 2024.

or similar to those in respect of which the trademark is registered where such use would result in the likelihood of confusion. In case of the use of an identical sign for identical goods or services, the likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use<sup>23</sup>. In contrast, the EU legislature suggested that protection "should be absolute in the case of identity between the mark and the sign and the goods or services, and the owner would have the right to prevent all unauthorized third parties from using the mark in such double identity situations."<sup>24</sup> Under the new Trademark Law, concerning the protection of trademarks during judicial proceedings, the defendant can now request that the plaintiff demonstrate the use of the trademark alleged to be infringed. The plaintiff must prove that, during the five-year period prior to the filing date of the infringement lawsuit, the trademark has been put to market for the goods or services for which it is registered. In the absence of such evidence, the lawsuit will be dismissed. The new law also includes provisions that clarify the time limits for initiating court proceedings.

In the judgment K.E. no.2378/2022, the Commercial Court of the Republic of Kosovo (RKS) in the legal matter of the plaintiff 'The Coca-Cola Company,' headquartered in the USA, against the defendant N.P.T 'Plus Market,' rejected the proposal of 'Coca-Cola Company,' which had requested that the defendant be ordered to cease all activities infringing the plaintiff's registered trademark rights, particularly the importing, exporting, and marketing in the RKS market of products without the authorization and consent of the trademark holder. Additionally, they sought an order for Kosovo Customs to confiscate and destroy all imported 'Coca Cola,' 'Fanta,' and 'Sprite' products brought in by the defendant. The Commercial Court of Kosovo, based on the lawsuit and the proposal for an interim measure from 'Coca-Cola Company' against the company N.P.T 'Plus Market,' rejected the proposal for the interim measure, which sought to prohibit 'Plus Market' from importing Coca Cola, Fanta, and Sprite products produced in Albania or any other country. This decision represents the first positive precedent for the implementation of the new Trademark Law, which came into force on July 7, 2022. Unlike the previous law, the new law stipulates that the trademark owner, in this case, Coca-Cola Company, cannot prohibit the use of the trademark on products that the owner has placed in any state in the Western Balkans region or a state with which the Republic of Kosovo has a free trade agreement. Through, this interpretation and correct application of the new law, local companies are given the opportunity to develop and become independent, having the possibility to import products of the same trademark produced in another country in the region or with which Kosovo has a free trade agreement.<sup>25</sup>

#### **4. The role of trademarks in Kosovo: steps towards harmonisation with the EU's normative framework**

The new Law on Trademarks, which entered into force in Kosovo on July 28, 2022, has brought significant changes aiming to harmonise domestic legislation with that of the European Union on trademarks, particularly with EU Directive 2004/48/EC concerning the enforcement of intellectual property rights and the Directive 2015/2436 on the approximation of the laws of Member States relating to trademarks. The new legislation introduces substantial changes and specifically aligns Kosovo's rules more closely with EU legislation and standards for trademarks. This law has introduced several important changes regarding the protection of trademarks in Kosovo, which will significantly impact the position of trademark owners. The changes can be categorized into two groups: firstly, those related to the trademark application procedure, such as eliminating the requirement for graphical representation of the trademark, the need for the literal interpretation of class titles and expanding the list of absolute and relative grounds for refusal. Secondly, changes

<sup>23</sup> Agreement on Trade-Related Aspects of Intellectual Property Rights – TRIPS Agreement, article 16.1, available at [https://www.wto.org/english/docs\\_e/legal\\_e/27-trips.pdf](https://www.wto.org/english/docs_e/legal_e/27-trips.pdf), last accessed May 7, 2024.

<sup>24</sup> Rochelle Dreyfuss & Justine Pila, *The Oxford Handbook of Intellectual Property Law*, Oxford, Kingdom: Oxford University Press, 2018, p. 656.

<sup>25</sup> Case No. 2378/2022, Judgment of the Commercial Court of the Republic of Kosovo, October 18, 2022.

related to the implementation of trademarks, such as the requirement for citing trademarks in dictionaries etc.

The changes in the trademarks application procedure include the elimination of the requirement for graphical representation of the trademark, which is no longer necessary when filing a trademark application. This means that now a trademark can be any sign capable of being represented in any form distinguishing the goods or services of one owner from those of others, and can be represented in a manner that enables competent authorities and the public to clearly and accurately determine the object of protection. Applicants must now specify the list of goods and services precisely for which protection is sought, as it is no longer acceptable to apply only for class headings in the list of goods and services. It is now mandatory to specify the goods and services for which protection is sought, enabling competent authorities to determine the scope of the requested protection on that basis alone.<sup>26</sup> The law has detailed absolute grounds for refusal or invalidity of trademarks, thus expanding the circumstances under which the registration of a trademark that does not meet the conditions described in this law may be refused. Authorities will not register a sign if it conflicts with existing indications of origin, geographical indications, traditional terms for wine, traditional guaranteed specialties, or plant varieties.<sup>27</sup> Regarding relative grounds for refusal, a novelty is the introduction of bad faith as a relative basis for refusal or invalidity of a trademark. The registration of a trademark may be refused or an already registered trademark may be declared invalid if the applicant applied for a trademark in bad faith.<sup>28</sup> The exclusive right of the trademark owner extends by adding several other situations where they have the right to prohibit the use of their trademark. This includes situations where it is used as a trade name of an economic entity or as part of a trade name, the use of a sign in advertising, and the use of a mark on packaging, labels, tags, security features, or authenticity devices and their placement in the market. The most significant change that will impact the future economic environment in Kosovo and the scope of competencies of trademark owners is the introduction of broad exceptions to the principle of national exhaustion of trademark rights. Under the new law, owners of trademarks cannot prevent the importation of genuine goods bearing their trademarks once they have been placed on any of the following markets:

- Republic of Kosovo;
- a member state of the European UNION;
- a member state of the European Economic Area;
- a state in the Western Balkans region;
- a state with which Kosovo has a free trade agreement or trade facilitation agreement.<sup>29</sup>

Now, trademarks can be enforced in an administrative procedure by filing a complaint with the Market Inspectorate against an infringer. Other changes regarding trademark enforcement include: the deadline for appeals against API decisions has been extended from 15 days to 30 days from the date of receipt of the decision. Additionally, data protection obligations have been specified for the API. Provisions for civil judicial protection define more concrete steps for entities entitled to seek protection of their rights to prevent continued infringement; the fine amounts in punitive provisions have been changed. The court may order the infringer to pay the trademark holder €5,000 to €10,000 for a single infringement case. Under certain circumstances, the court may replace an order for the seizure and destruction of infringing goods with monetary compensation to the injured party. In accordance with the EU Enforcement Directive, the new law stipulates that orders in infringement cases must be fair, equitable, proportionate, and enforceable. The new law also includes provisions clarifying time limits for initiating court procedures.

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<sup>26</sup> Law No.08/L-075 on Trademarks, article 5, available at <https://gzk.rks-gov.net/ActDetail.aspx?ActID=60331>, last accessed May 7, 2024.

<sup>27</sup> *Ibid*, article 6, Official Gazette of the Republic of Kosovo, available at <https://gzk.rks-gov.net/ActDetail.aspx?ActID=60331>, last accessed May 7, 2024.

<sup>28</sup> *Ibid*, article 7.

<sup>29</sup> *Ibid*, article 14.

## 5. Conclusions

With the entry into force of the new Law on Trademarks in Kosovo, we can say that the local legislation has been harmonized to a considerable extent with most of the EU acquis in the field of industrial property. The results of the new Law on Trademarks lie in the efforts to transpose Directive 2015/2436/EU and Directive 48/2004/EU on the enforcement of Industrial Property rights, which are partially harmonized in the Law on Trademarks. Such an effort comes from the fact that Kosovo is obliged to align the national legislation with the EU acquis in accordance with the obligations of the SAA ‘the level of protection of intellectual, industrial and commercial property rights similar to that existing in the EU, including effective means for the implementation of such rights’. By aligning and harmonizing the existing legislation of Kosovo, the objective of guaranteeing the protection of industrial property rights, including the effective means of implementing these rights, would be achieved according to the Program for the Implementation of the Stabilization-Association Agreement, contributing to the fulfilment of articles 77 and 78 of the SAA.

The non-harmonisation of national legislation with that of the European Union would negatively affect the fulfilment of Kosovo’s obligations arising from the Stabilization and Association Agreement. This could also cause problems in bilateral relations with other countries and jeopardize the country’s eventual membership in international intellectual property organizations. As a result of the harmonisation of this law with EU norms, the Agency for Industrial Property, within the Ministry of Industry, Entrepreneurship and Trade, for the first time in Kosovo has registered a multimedia brand. This marks an important step towards the advancement of the innovative climate and the protection of intellectual property in the country. This innovation constitutes an important legal change because the new Law on Trademarks, harmonizing with the latest European standards, has expanded the definition of trademarks to include not only traditional signs, but also the new form, thus allowing the registration of multimedia brands. Unlike the old law, which limited trademarks to graphic form, the new law has opened the way for the registration and protection of multimedia trademarks. This priority of the law in harmony with modern technological and commercial developments will help create a more innovative and dynamic environment for businesses and consumers in Kosovo. This legal change fulfils the common goal of creating a more favourable environment for innovation and business development in Kosovo.

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