

## **LAW OF UKRAINE**

### **On the Amendment of Certain Legislative Acts of Ukraine on Intellectual Property**

The Supreme Rada shall resolve:

I. That the changes should be made in the legislation of Ukraine:

1. In Civil Procedural Code of Ukraine:

part 2 of Article 10 after the words "in order to prevent disclosure" shall be added with words: "of the confidential information of the parties";

In part 1 of Article 48 words "up to one non-taxable income" shall be replaced with words "up to ten non-taxable incomes".

2. In Criminal Code of Ukraine

1) In Article 176:

in Part 1, paragraph 2, the words "four hundred" shall be replaced with the words "one thousand";

in Part 2, paragraph 2, the words "from two hundred to eight hundred" shall be replaced with the words "from one thousand to two thousand"..

2) In Article 177:

in paragraph 1 words "qualified indications of origin of a good" shall be deleted.

in paragraph 2 the words "four hundred" shall be replaced with the words "nine hundred";

in Part 2 the words "from two hundred to eight hundred" shall be replaced with the words "from one thousand to one thousand and five hundred".

3) Article 229 shall be worded as follows:

"Article 229. Illegal Use of a Trademark Mark for Goods and Services, a Trade Name or a Qualified Indication of Origin of a Product

1. Illegal use of somebody else's mark for goods and services, a company (registered) name, a qualified indication of origin of a good, markings of a good, if it is connected with the receipt of proceeds in large amounts, -

shall be punishable by a penalty in the amount ranging from four hundred to one thousand non-taxed minimum individual incomes or by correctional service for a duration of two hundred and forty hours, subject to seizure of illegally produced goods and equipment and materials designated for production thereof.

2. The same acts, if committed for the second time or connected with the receipt of proceeds in especially large amounts, -

shall be punishable by a penalty in the amount ranging from one thousand to two thousand non-taxed minimum individual incomes or by correctional service for up to two years, or by imprisonment of up to three years, subject to seizure of illegally produced goods and equipment and materials designated for production thereof.

Note. Proceeds shall be deemed to have been received in large amounts if such proceeds total from three hundred to one thousand non-taxed minimum individual incomes, and proceeds shall be deemed to have been received in especially large amounts if such proceeds total one thousand and more non-taxed minimum individual incomes.

3. Part 2 of Article 20 of the Criminal Procedural Code after the words "in order to prevent disclosure" shall be added with the words "confidential information of participants of the court procedures".

4. In Law "On the Protection of Rights to Industrial Designs" (Vidomosty Verkhovnoi Rady (Bulletin of the Supreme Rada) of Ukraine, 1994, No.7, page 34, 2001, No.8, p.37)

1) in paragraph 7 of Article 1 word "citizen" should be replaced with the word "natural"

2) in Article 5:  
in Section 1 words "public interests" should be replaced with words "public order";  
section 3 must be added with a paragraph as follows:  
"objects whose design is such as only to serve the relevant technical function";  
section 4 must be excluded;  
in section 6 words "depicted in photographs" must be replaced with words "presented in the images"

3) in Article 6:  
in section 1 words "capable of industrial application" should be excluded;  
section 2 must be added with words: "provided they are not revoked";  
section 4 should be excluded.

4) in Article 10 words "not rejected" should be replaced with words "where a decision has not been taken to reject the application for a patent"

5) in Article 11:  
paragraph 3 of section 4 shall be put forth as follows:

"a set of images of the product (its model, drawing), making it possible to imagine it in full detail";  
section 8 should be added with a sentence as follows: "The term can be prolonged but for no longer than six months. A fee is charged for such prolongation";

6) in Article 12:  
paragraph 1 of section 2 shall be worded as follows:  
"If the Institution establishes that the materials of the application do not meet the requirements of section 1 of this article as of the time of receipt of such materials a notice must be sent to the applicant";  
section 4 must be added with words "the relevant notice must be sent to the applicant";

7) Article 13 must be added with section 7 as follows:  
"7. Priority can be established by the date of the arrival of additional materials to the Institution, if they are put forward as a separate application, submitted within three months after the receipt by the applicant of the notification of the Institution saying that additional materials cannot be taken into consideration in the course of considering the application since they go beyond the nature of the industrial design as presented in the application";

8) in Article 14:  
in section 3:  
in paragraph 1 the first sentence after the word "application" must be added with a word "changes", the second sentence must be added after the word "these" with a word "changes", the words "about the rejection of the application" must be replaced with words "decision to reject the application for a patent";  
paragraph 2 after the words "upon the initiative of the applicant" must be added with words "changes"  
in section 6:  
in paragraph 1 words "and the applicant must be informed thereof" must be replaced with words "a notice must be sent to the applicant";  
in paragraph 3 words "decision to reject the application" must be replaced with words "decision to reject the application for a patent"  
in section 9:  
paragraph 2 must be added with a sentence as follows: "a fee is charged for the prolongation of the missed deadline"  
the section must be added with a paragraph as follows:  
"terms provided for in this article for the applicant can be prolonged as established in the legislation but for no longer than six months. A fee is charged for the application to prolong the term";

9) in Article 16:  
Section 1 must be added with the following paragraphs:

"The term can be prolonged but for no longer than six months. A fee is charged for the prolongation of the term"

The term for the payment of the state duty for the issue of the patent, if missed by the applicant, can be prolonged in the course of two months after the completion of the missed term where the term is missed for reasonable reasons. A fee is charged for the prolongation of the term";

Section 2 must be added with a sentence as follows: "A fee is charged for the prolongation of the term"

10) section 2 of Article 17 shall be put forward as follows:  
"2. After the information has been included in the Register any person can submit a request for an excerpt from the Register. A fee must be paid for the issue of such an excerpt";

11) Article 18 shall be added with section 4 as follows:  
"4. At the request of the patent holder the Institution shall issue a copy of the patent in accordance with the procedure established by the Institution. A fee is charged for the issue of the copy";

12) paragraph 1 of Article 19 shall be re-worded as follows:  
"The applicant may submit an objection to the decision of the Institution on the application within three months after the receipt of such decision or copies of the materials sent at the request of the applicant. Such objection must be submitted in accordance with the established procedures. A fee is charged for the submission of such application. A document certifying the payment of the fee must be submitted along with the objection. If the fee has not been paid, it is considered that the objection has not been submitted"

13) in Article 20:

paragraph 3 of section 2 shall be worded as follows:

"The use of an industrial design is production, offer for sale, sale, import, export, storage, other introduction into the commercial circulation of the product in accordance with the purposes indicated above of a product where the patented industrial design is used in the production thereof";

section 5 must be added with paragraphs as follows:

"In accordance with the license contracts on the exclusive or non-exclusive license the patent holder (licenser) shall transmit the right to use the industrial design to another person (licensee) who is obliged to pay charges to the licenser and commit other actions envisaged in the contract.

In accordance with a exclusive license contract the licenser shall transmit to the licensee the right to use the industrial design in certain amount, in the designated territory and in the course of a certain time period, retaining the right to use the industrial design where such use is not covered in the license.

Licensee who obtained from the licenser the right to use the industrial design in accordance with an industrial design exclusive license contract (holder of the exclusive license) may issue a license for the use of the industrial design within the time limits established in the license and within the scope of rights transferred in accordance with the license

In accordance with a non-exclusive license contract a licenser shall transmit the right to use the industrial design to a licensee, retaining the right to use the industrial design, including the right to issue licenses to other persons";

Paragraph 2 of section 6 shall be replaced with the following paragraphs:

"Transfer of the property right for an industrial design and issue of a license for the use of an industrial design shall be considered valid for any other person from the moment of registration of information thereof in the Institution.

Information on the transfer of property rights for an industrial design and issue of a license for the use of an industrial design shall be published in the official bulletin.

The Institution shall establish the procedures for the registration and publication of such information.

Relevant fees shall be charged for the registration of information on the transfer of the property right for the industrial design and issue of licenses for the use of an industrial design and for making amendments to the licenses initiated by the parties of the contract";

14) Article 21 shall be reworded as follows:

"Article 21. Compulsory Alienation of Rights

1. Under martial law and under state of emergency the Cabinet of Ministers of Ukraine may authorize the use of an industrial design by the person designated by the Cabinet of Ministers. Permission of the patent holder is not required if such patent holder refused to issue a license for the use of an industrial design.

However:

- 1) the scope and length of such use shall be restricted, depending on the purpose of such uses;
- 2) the right to use shall be re granted on the basis of a non-exclusive license contract;
- 3) the right to use, issued in accordance with a non-exclusive license contract, cannot be transferred to third parties. This rule does not apply to the situations where the right is transferred along the business practice where such use takes place or along with the relevant part of the enterprise.

- 4) use is permitted primarily for the satisfaction of needs of the domestic market;
- 5) a notice must be sent to the patent holder about the issue of the permit to use an industrial design;
- 6) permission for use must be canceled, if the circumstances causing the martial law or the state of emergency, cease to exist;
- 7) the relevant compensation must be paid to the patent holder.

2. Decision of the Cabinet of Ministers of Ukraine on the issue of the permission for the use of an industrial design, the time limits and conditions of such permission, amount and procedures for the payment of a compensation to the patent holder can be appealed in accordance with the procedures established in the legislation";

15) the last paragraph of section 2 of Article 22 must be added with words "with the following notification of the patent holder in the nearest time and with payment of the relevant compensation";

16) subsection "c" of section 1 of Article 25 must be deleted;

17) Article 26 shall be reworded as follows:

"Article 26. Infringements of the Rights of Patent Holder

Infringement of the rights of the patent holder is commission by any person of acts infringing the rights of the patent holder, as envisaged in Article 20 of this Law";

18) the Law must be added with Articles 26<sup>1</sup>, 26<sup>2</sup> and 26<sup>3</sup> as follows:

"Article 26<sup>1</sup>. Procedures for the protection of rights

Protection of property and personal non-property rights of the patent holder shall be performed in accordance with the procedures established in the civil, administrative and criminal legislation.

Article 26<sup>2</sup>. Methods of Civil Protection of Rights

1. The patent holder has the right to request the protection of his/her/its rights from the court and other bodies in accordance with the established procedures and their competence.

2. In case of violation of rights of the patent holder, envisaged in Article 20 of the Law, failure to comply with conditions of use the patented industrial design as established in the license contract, or of a threat of infringement of rights and other infringements the patent holder has the right to:

- 1) require the recognition and restoration of his rights;
- 2) submit suits on the restoration of infringed rights and (or) termination of activities infringing the rights of the patent holder;
- 3) submit suits requiring the payment of moral (non-property) damages;
- 4) submit suits requiring reimbursement of losses or payment of compensation;
- 5) demand termination of preparatory activities for the violation of rights of the patent holder, including the suspension of the customs procedures, in accordance with the procedures established in the Customs Code of Ukraine, if there is a suspicion that goods produced in violation of the rights to the patented industrial design may be brought out of or in the territory of Ukraine;
- 6) demand seizure of goods if the patented industrial design was used in the production of such goods;
- 7) demand the publication in printed mass media of information on the infringement of the rights of the patent holder and judicial decisions thereupon. Such demands may be

submitted in accordance with the judicial procedures, as well as in accordance with other procedures;

8) demand other actions provided for in the law and related to the protection of rights of the patent holder.

3. By consent of the patent holder and if the licensing contract does not provide otherwise, the person authorized by the licensing contract to use the patented industrial design may also demand that the infringed rights be restored.

4. A court can take decisions or issue rulings about:

1) compensation of the moral (non-property) damages, caused by the violations of rights of the patent holder. The decision or ruling must indicate the sum of the compensation;

2) compensation of losses caused by the infringements of the rights of the patent holder;

3) collection from the infringer of the income received as a result of the infringement;

4) payment of compensation, indicated by a court, instead of compensation of losses or collection of the income;

5) publication of information on the infringement in mass media, if in the course of judicial proceedings it is established that rights of the patent holder are infringed or if there are actions constituting a threat of infringement of the rights of the patent holder.

5. In the calculation of the losses that must be compensated to the patent holder whose rights are infringed, in case of compensation of moral (non-property) damages (section 4 of this article ) the court must proceed from the nature of the infringement, of property and moral damages, caused to the patent holder, and from the income that it might have received. The losses caused to the patent holder, whose rights are infringed, may include court expenses and expenditures related to the payment for services of a lawyer.

In the establishment of the sum of the compensation that must be paid instead of the compensation of losses or collection of income (section 4 of the Article), the court must establish the sum of the compensation with due consideration given to the gravity of the infringement and (or) intentions of the defendant.

6. A court can take a decision requiring the payment of a fine for the amount of 10 per cent of the sum that the defendant must pay to the plaintiff in accordance with the court decision. The sum of the fine must be added to the accounts of the State Budget of Ukraine.

7. The court can take a decision to seize or confiscate all products found to be produced in violation of rights of the patent holder. The rule also applies to the technical documents, other information on the material media and means necessary to produce the relevant industrial design.

The court may decide that seized products must be transferred to the patent owner at his/her/its request. If the patent owner does not require such transfer, the seized products must be destroyed or can be used for charity purposes.

Technical documents, other information on the material media and means necessary to produce the patented industrial design must also be destroyed, if the court finds that these materials and equipment were used for the production of the industrial design in question.

#### Article 26<sup>3</sup> Provisional Measures Taken to Preserve the Evidence or to Ensure the Suit in Cases of Infringement of the Rights of the Patent Holder for the Industrial Design

1. Until the consideration of the case on the merits is completed, and where there are sufficient reasons to believe that the defendant is an infringer of the rights of the patent holder, the judge has the right to issue a ruling prohibiting any actions by the defendant defined in part 2

of Article 20 of this law as use of an industrial design. Such prohibition may retain effect until the court takes a decision or issues ruling.

2. Where there are sufficient data on the infringements of rights of the patent holder or there are reasons to believe that the evidence will be destroyed, or if any delay may cause irreparable damages to the patent holder, the patent holder may request that provisional measures be taken by a court in order to preserve the evidence or prevent infringement of rights. Such measures can be requested both before and after the submission of the suit.

3. The court may take provisional measures including:

- 1) inspection of the premises where the activity related to the infringements of rights of the patent holder has taken place ;
- 2) seizure of goods, if there are sufficient reasons to believe that such products were produced or put into commercial circulation in violation of rights of the patent holder;
- 3) provisional suspension of transactions with bank accounts and seizure of documents that may serve as evidence of activities infringing the rights of the patent holder or threatening a violation of such rights.

4. The request of application of provisional measures must be considered in two days term in the presence of the person who has submitted the request.

The decision of a court to apply the provisional measure must be executed by the State Execution Service immediately in the presence of the person who requested such measure.

5. Before the adoption of the ruling on the application of provisional measures, indicated in section 3 of this Article, the court may require that the person who submitted the request should supply evidence that he/she/it is the owner of the rights to the industrial design and that these rights are infringed or such infringement is imminent, as well as give to the person who submitted the request a judicial ruling requiring the submission of a security (money that must be added to the deposit account of the court by the person who submitted the request or other natural or juridical persons) or other bank guarantee sufficient to protect the defendant.

The amount of the security or the bank guarantee must be determined by a court with due consideration of the circumstances of the case but it must not be less than the amount of damages claimed.

6. After the application of provisional measures envisaged in section 3 of this article, the court shall inform the parties whom it concerns. The court must in the course of 10 days establish the date of a judicial meeting, where it is decided whether the measures must be confirmed, modified or canceled. The person who has requested the application of provisional measures must no later than in two working days submit a suit to the court. A court hearing on the basis of this must take place within calendar 15 days from the day of submission of the suit. Otherwise the provisional measures must be canceled or suspended.

The security must be returned to the person who has submitted the suit if the court refuses to accept the application or if the court fulfils the demands of the plaintiff in full or in part. If the demands of the plaintiff are not fulfilled, the security or bank guarantee is used to implement the decision to repay the damages caused by the application of provisional measures to the defendant.

7. Where provisional measures were canceled or if in the course of consideration of the case it is found that no infringement has taken place and no threat thereof exists, the defendant may require the reimbursement of any damages caused by such measures in accordance with the procedures established by law".

19) in Article 27:

in section 1 word "arbitration" must be replaced with a word "commercial";  
section 2 must be added with the following paragraphs after paragraph 8:  
recognizing the patent invalid;  
issue of a compulsory license";  
Accordingly, paragraph 9 shall be deemed paragraph 11.

20) section 2 of Article 29 shall be considered ineffective.

5. The Law of Ukraine "On Protection of Rights to Trademarks for Goods and Services" (Vidomosti Verkhovnoi Rady (Bulletin of the Supreme Rada) of Ukraine, 1994, No. 7, page 36; 1999, No. 32, page 266; 2001, No. 8, page 37; 2002, No. 7, page 51) shall be amended as follows:

1). In Article 1:

to change in paragraph 3 the word "a citizen" with the word "natural";  
to supplement paragraph 12 with the words "and recognition of a mark for goods and services as widely known in Ukraine;"  
to supplement the Article with new paragraphs as follows:

"widely known mark" shall mean a mark which has become widely known in Ukraine among relevant layers of the population with respect to goods and/or services of a certain person and which is protected pursuant to Article 6 bis of the Paris Convention for the Protection of Industrial Property;

"international registration" shall mean an international registration of a mark which is accomplished pursuant to the Madrid Agreement Concerning the International Registration of Marks or the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks".

2). To substitute in Section 2 of Article 4 the word "realize" with the word "accomplish".

3). In Article 5:

To restate Section 1 as follows:

"1. Legal protection shall be provided to a mark that does not fall under grounds as enumerated in this Law whereby legal protection is refused, pursuant to the procedure provided in this Law or in accordance with international agreements and treaties of Ukraine, in particular in Article 6 bis of the Paris Convention for the Protection of Industrial Property, the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.";

To supplement Section 2 with the words: "as well as acoustic signals, odors, colors and combinations of colors.";

4). In Article 6:

to supplement paragraph 1 of Section 1 with the words "or are any imitation of";  
to supplement paragraph 4 of Section 1 with the words "as well as religious emblems and symbols;"  
to supplement paragraph 4 of Section 2 before the word "indicate" with words "are descriptive, in particular";



to delete paragraph 5 of Section 2;  
to change in paragraph 7 of Section 2 the words “in paragraphs 2, 3, 4, 6 of this Section” for the words “in this Section”;  
to supplement Section 2 with a new paragraph as follows:  
“Provisions set fourth in this Section shall not apply in respect of indications which in fact have acquired a differentiating capacity as a result of use thereof.”;

To restate sections 3, 4 and 5 as follows:

“3. Indications may not be registered as marks which:  
are misleading or are such that may be misleading with respect to a good, a service or a person who produces the good or provides the service;  
are inconsistent with public order, principles of humanity and morals;  
are or contain a reference to a place of origin of wines or alcoholic beverages which are protected on the basis of international agreements and treaties of Ukraine, if such indications are intended for wines or alcoholic beverages that do not originate from the said places;  
represent the form of a good that is determined exclusively or mainly by the nature or designation of the good.”

“4. Indications may not be registered as marks for similar goods and services which are identical or similar to such an extent that they may be confused with:  
registered marks or marks filed for registration in Ukraine in the name of other persons;  
marks of other persons which are protected on the basis of international agreements and treaties, to which Ukraine is a party;  
international names of pharmaceutical preparations (substances), which are not patentable.  
Registration as a mark of an indication, which is similar to marks specified in paragraphs 2 and 3 of this Section herein, for similar goods and/or services may be carried out if a consent to registration of this mark has been given by the holder of rights to the mark.

5. Indications may not be registered as marks for whatever goods which are:  
identical or similar to such an extent that such indications could be confused with marks of other persons which are recognized as widely known in Ukraine as of the date of application for the registration of such mark, or if priority has been claimed, as of the date of priority;  
names of places of origin or geographical indications of origin of goods unless they are included, as elements that are not protected, in a mark that is registered in the name of the person who has a right to use such names of places of origin or geographical indications of origin of goods;  
Supplement the Article with Sections 6, 7 and 8 as follows:

“6. Indications may not be registered as marks for similar goods which reproduce company names of other persons which are known in Ukraine.

7. Indications may not be registered as marks which reproduce:  
industrial samples the right to which belongs in Ukraine to other persons;  
last names, first names, pseudonyms and derivatives thereof, portraits and facsimiles of persons known in Ukraine without their or their successors’ consent;  
certification marks (marks of conformity) that are registered in the prescribed manner;

names of plant varieties, the right to which belongs in Ukraine to other persons.

8. Indications may not be registered as marks in the name of an agent or representative of the person who owns this mark in one of the state parties to an international agreement or treaty of Ukraine, without permission of the owner of this mark, unless the agent or representative provides evidence confirming his/its authority to register the mark;  
to supplement the Article with a new Section as follows:

5). To supplement Section 3 in Article 8 with the words “whereof notice shall be provided to the applicant.”

6). In Article 10:

in Section 3:

in paragraph 1, to supplement the first sentence after the word “application”, with the word “amendments”; to restate the second sentence as follows: “Amendments, rectification and clarifications shall not be taken into account if they have been provided to an expert organization upon accomplishment of state registration of a mark or upon receipt by the applicant of a decision refusing to register the mark”;

to supplement paragraph 2 after the word “applicant”, with the word “amendments”;

in Section 4:

to supplement paragraph 1 with a sentence as follows: “If additional materials go beyond the essence of an indication disclosed in an application and a list of goods and services specified in the application, the expert organization shall notify the applicant thereof”;

to supplement paragraph 3 with the words: “with a determination of a priority date on the basis of the date on which additional materials were filed, if such an application has been completed within two months from the date of notification of the applicant by the expert organization.”;

in paragraph 2 of Section 6 to substitute the words “refusal of application” with the words “refusal of registration of mark”;

to restate Section 7 as follows:

“7. If an application complies with the requirements of Article 7 of this Law and a document on payment of a fee for filing an application has been completed correctly, the applicant shall be provided a conclusion based on results of a preliminary examination.

If, within one month from the date on which a conclusion was provided to the applicant, the expert organization has not received objections against the results of the preliminary examination, the conclusion shall be deemed to have been confirmed with the applicant, and the expert organization shall conduct an expert examination on the merits of the application, in which course conformity of the applied-for indication with conditions for the provision of legal protection shall be verified.”;

To substitute in paragraph 1 of Section 8 the words “qualifying expert examination” with the words “expert examination on the merits of the application”;

In Section 10:

To substitute in paragraph 1 the words “qualifying expert examination” with the words “expert examination on the merits of the application”;

To substitute in paragraph 2 the words “decision on refusal of application” with the words “notice on a possibility of refusal to register the mark”;

To supplement the Section with paragraphs as follows:

“The applicant shall be entitled, within two months from the date of notice on a possibility of refusal to register the mark, to furnish to the expert organization a reasoned answer with arguments in favor of mark registration or a petition to prolong the period within which such an answer must be provided.

If the applicant’s arguments have been recognized as justified, a decision on registration of the mark shall be provided to the applicant.

If the period within which the answer must have been provided is not complied with or arguments provided by the applicant have not been recognized as justified, a decision on refusal to register the mark shall be provided to the applicant.”;

To delete In Section 12 the following words and numeral: “(with the exception of set forth in Section 8)”;

To supplement the Article with Section 13 as follows:

“13. Periods specified for applicants in this Article hereof may be prolonged in a prescribed manner, but not more than by 6 months. Fees shall be paid for the filing of a petition for the prolongation of the periods.”;

7). Substitute in Article 11 the words “the provision to him/her of a decision to register the mark” with the words “the state registration of the mark or the provision to the applicant of a decision to refuse the registration of the mark”;

8). To supplement the Law with Article 11<sup>1</sup> as follows:  
“Article 11<sup>1</sup>. Separation of Application

1. On a request from the applicant, the examining Institution shall separate the application on condition that the list of goods and/or services in application contain several goods and/or services.

2. In order to separate the application, the applicant shall file a petition for such separation, an application containing a list of separated goods and/or services (separated application) in compliance with Sections 1 through 7 of Article 7, and pay the fees for the filing of the petition as prescribed by Section 8 of Article 7 of this Law.

The application separated in such a manner shall preserve the date of filing or the date of priority of the initial application.

3. If within a period of three months form the date of filing by the applicant of the request to separate the application, the separated application is not filed, or the filing fees are not paid, the separation request shall be deemed withdrawn”;

9). In Article 12:

To supplement Section 1 with paragraphs as follows:

“The specified period may be prolonged, but not more than by 6 months. Fees shall be paid for the filing of a petition for the prolongation of the period.

In the event of failure by the applicant to pay the state duty for the issuance of certificate, the period for such payment may be renewed within two months after the expiry of the period, on condition of existence of valid reasons for such failure. Fees shall be paid for the renewal of the period”;

To supplement Section 2 with a sentence as follows: “Fees shall be paid for the perusal of the application materials”.

10). To restate Section 2 of Article 13 as follows:

“2. Upon entry in the Registry of the information on registration of a mark, any person shall be entitled to file a petition for the provision of an extract from the Registry regarding the registered mark. Fees shall be paid for the provision of an extract from the Registry”;

11). To supplement Article 14 with Section 4 as follows:

“4. At the request of a certificate owner, the Institution shall issue a duplicate certificate in the prescribed manner. Fees shall be paid for the issuance of certificate duplicates”.

12). To supplement paragraph 1 of Article 15 with a sentence as follows:  
Fees shall be paid for appeals of decisions with the Appellate Chamber. The document certifying the payment of fees must be attached to the appeal. In the absence of such payment, the appeal shall be deemed not submitted”;

13). To supplement the Law with Article 15<sup>1</sup> as follows:  
“Article 15<sup>1</sup>. Widely Known Mark

A mark may be recognized as a widely known mark in Ukraine by decision of the Appellate Chamber or by court decision.

An application for the recognition of a mark as a widely known mark in Ukraine shall be filed with the Appellate Chamber. The Appellate Chamber shall consider the application for the recognition of a mark as a widely known mark in Ukraine in a manner prescribed by the Institution. Fees shall be paid for the filing of application for the recognition of a mark as a widely known mark in Ukraine.

The Appellate Chamber shall take a decision based on the results of consideration of the application for the recognition of a mark as a widely known mark in Ukraine, subject to confirmation by an Order of the Institution, and shall provide the decision to the applicant.

The decision of the Appellate Chamber may be appealed in court.

Information on recognition of a mark as widely known in Ukraine shall be published in the Official Bulletin.

5. The holder of rights to a mark that is recognized as widely known in Ukraine shall have equal rights with owners of certificates which rights are provided for in this Law.

14). In Article 16:

To restate paragraph 3 in Section 2 as follows:

“Recognized as use of a mark shall be the application of the mark on goods, in rendering services regarding which the mark was registered, as well as in commercials including advertisements in the world information network Internet, on packaging of goods, in printed publications, on signs, during display of exhibits at exhibitions and fairs held in Ukraine, in prospectus, on accounts, official letterheads and other documentation related to the commercial circulation of the goods and services concerned. Recognized as use of a mark shall be also the use of the mark in a shape different from the registered shape if the differentiating nature of the mark is not affected by the use of the mark in such different shape”;

To delete paragraph 2 in Section 3;

To add in paragraph 1 of Section 4 the words “with respect to all or parts of goods” after the words “the right of ownership to a mark” ;

To supplement Section 5 with paragraphs as follows:

“Under a licensing agreement for an exclusive or non-exclusive license, the owner of a certificate (licensor) shall transfer a right to use a mark to another person (licensee) who assumes an obligation to make payments to the licensor and to take such other actions as are provided in this agreement.

Under an agreement for an exclusive license, the licensor shall transfer to the licensee a right to use a mark in a certain scope, within a specified locality and for an agreed-upon period, while retaining the right to use the mark in the part that is not transferred to the licensee.

The licensee, who has been granted a right by the certificate owner to use the mark under the agreement for an exclusive license (the holder of the exclusive license), may give a license authorizing the use of the mark within the term of the issued license and within the scope of rights transferred to him.

Under an agreement for a non-exclusive license, a licensor shall transfer a right to use a mark to a licensee, while retaining the right to use the mark, including a right to give licenses to other persons.”;

To substitute for paragraph 2 in Section 6, other paragraphs as follows:

“A transfer of the right of ownership to a mark and a grant of a license authorizing the mark’s use shall be effective for any other person as from the date of registration of the information thereon in the Institution.

Information on the transfer of the right of ownership to the mark and the grant of the license authorizing the use of the mark shall be published in the Official Bulletin.

Procedures governing the registration and publication of the mentioned information shall be prescribed by the Institution.

Applicable fees shall be paid for registration of information on transfers of rights of ownership to marks and grants of licenses authorizing the use of marks and for the introduction of changes therein, at the initiative of parties to agreements.”

15). In Article 17:

To restate paragraph 2 as follows:

“In the event the mark is not used for goods and/or services for which it was registered, or is used not for all of the goods and/or services for which it was registered by the owner of the certificate or other person with the consent of the owner during a period of three years following the assumption of the right to the mark, or from the date on which the use of the mark was suspended, any person will have the right to lodge an appeal with a court of justice (a commercial court) demanding the early termination of validity of the certificate, in full or in respect of a part of goods and/or services”;

To substitute in paragraph 3 the word “commercial” for the word “arbitration”;

To supplement paragraph 3 with the words: “In particular, in connection with any limitations imposed on imports or other requirements established by law”;

To supplement the Article with a paragraph as follows:

“Provisions of this section shall also apply to marks afforded legal protection in Ukrainian territory under international agreements and treaties to which Ukraine is a party”.

16). To substitute in Section 3 of Article 18 the word “commercial” for the word “arbitration”.

17) To restate Article 20 as follows:

1. Violations of rights of the owner of the mark as provided by this Law shall be the use without the mark owner’s permission:

- a) of an indication identical to a mark, which is afforded legal protection in Ukraine, for identical goods and/ or services;
- b) of an indication similar to a mark, which is afforded legal protection in Ukraine, for identical or similar goods and/or services, if there is a likelihood of misleading consumers as a result of such use;
- c) of an indication identical or similar to a mark that is recognized as widely known in Ukraine for any goods and/or services, if there is a likelihood of misleading consumers as a result of such use or if such use may cause harm to the reputation of the widely known mark.

2. Actions described in Section 1 of this Article shall include:

- a) application of an indication similar to a mark, which is afforded legal protection in Ukraine, for any goods packaging thereof; offering such goods and packaging for sale; sale, as well as storage and importation of such goods into the customs territory of Ukraine for the indicated purposes;
- b) offering or rendering services with the use of an indication similar to a mark, which is afforded legal protection in Ukraine;
- c) application of an indication similar to a mark, which is afforded legal protection in Ukraine, to any elements of decoration, or to packaging, or to means of differentiation such as labels, tabs etc.
- d) offering for sale, as well as storage and importation into the customs territory of Ukraine of any elements of decoration, packaging, or means of differentiation of goods for the stated purposes if there is a threat that such elements of decoration, packaging, or means of differentiation shall be illegally used for goods or during the rendering of services.

3. The use, without permission of the owner of rights to the mark, of indications identical or similar to a mark which is afforded legal protection in Ukraine, in commercials including commercials in the global information network "Internet", in commercial correspondence for commercial purposes, as well as commitment of any such actions as create a threat of infringement on the owner's rights to the mark can also be recognized as violations of rights to the mark.

4. The following shall not be regarded as violations of rights of the owner of a mark:

- a) use of a mark, which is afforded legal protection in Ukraine, on goods, which have been put into circulation directly by the mark owner or upon his/its permission;
- b) use by a person, who is granted a right to use the name of a place of origin or a geographic indication of origin of a good pursuant to law, of the indication that is identical or similar to the mark that consists only of the name of the place of origin or the geographic indication of origin of goods;
- c) good faith use of one's own name or address;
- d) use of indications that are descriptive with respect to goods or services."

18). To supplement the Law with the following articles 20<sup>1</sup>, 20<sup>2</sup> i 20<sup>3</sup>:

"Article 20<sup>1</sup>. Procedures for the Protection of Rights

Rights of a trademark owner shall be protected in accordance with the procedures provided for in civil, administrative and criminal legislation.

Article 20<sup>2</sup>. Methods of Civil Protection of Rights of the Trademark Owner

1. The trademark owner has the right to request the protection of his/her/its rights from the court and other bodies in accordance with the established procedures and their competence.

In case of violation of rights of the trademark owner, envisaged in Article 20 of the Law, failure to comply with conditions of use the trademark as established in the license contract, or of a threat of infringement of rights and other infringements the trademark owner has the right to:

- a) require the recognition and restoration of his rights;
- b) submit suits on the restoration of infringed rights and (or) termination of activities infringing the rights of the trademark owner;
- c) submit suits requiring the payment of moral (non-property) damages;
- d) submit suits requiring reimbursement of damages (financial damages), including lost profit, or garnishment of income, obtained by an infringer as a result of his/her/its violation of rights of the trademark owner, or payment of compensation;
- e) demand termination of preparatory activities for the violation of rights of the trademark owner, including the suspension of the customs procedures, in accordance with the procedures established in the Customs Code of Ukraine, if there is a suspicion that goods produced in violation of the rights to the trademark may be brought out of or in the territory of Ukraine;
- f) demand the withdrawal from commercial circulation of goods, elements of decoration of goods, packaging, or means of differentiation marked with indication that resembles the mark which is afforded legal protection in Ukraine, to such an extent that it could be confused with the mark which is afforded legal protection in Ukraine;
- g) demand the publication in printed mass media of information on the infringement of the rights of the trademark owner and judicial decisions thereupon. Such demands may be submitted in accordance with the judicial procedures, as well as in accordance with other procedures;
- h) demand other actions provided for in the law and related to the protection of rights of the trademark owner.

2. By consent of the trademark owner and if the licensing contract does not provide otherwise, the person authorized by the licensing contract to use the trademark may also demand that the infringed rights be restored.

3. A court can take decisions or issue rulings about:

- a) compensation of the moral (non-property) damages, caused by the violations of rights of the trademark owner. The decision or ruling must indicate the sum of the compensation;
- b) compensation of losses caused by the infringements of the rights of the trademark owner;
- c) collection from the infringer of the income received as a result of the infringement;
- d) payment of compensation, indicated by a court, in the amount ranging from 10 to 50000 minimum salaries, instead of compensation of losses or collection of the income;
- e) publication of information on the infringement in mass media, if in the course of judicial proceedings it is established that rights of the trademark owner are infringed or if there are actions constituting a threat of infringement of the rights of the trademark owner.

In the calculation of the losses that must be compensated to the trademark owner whose rights are infringed, in case of compensation of moral (non-property) damages (section "d" of this article) the court must proceed from the nature of the infringement, of property and moral damages, caused to the trademark owner, and from the income that it might have received. The

losses caused to the trademark owner, whose rights are infringed, may include court expenses and expenditures related to the payment for services of a lawyer.

In the establishment of the sum of the compensation that must be paid instead of the compensation of losses or collection of income (subsection "d" of the section), the court must establish the sum of the compensation, within the limits established in subsection "d" of this section, and with due consideration given to the gravity of the infringement and (or) intentions of the defendant.

4. A court can take a decision requiring the payment of a fine for the amount of 10 per cent of the sum that the defendant must pay to the plaintiff in accordance with the court decision. The sum of the fine must be added to the accounts of the State Budget of Ukraine in accordance with the established procedures.

5. The court can take a decision to seize or confiscate all goods or elements of decoration of goods, packaging, or means of differentiation marked with indication that is identical or similar to the trademark which is afforded legal protection in Ukraine to such an extent that it could be confused with a mark that is afforded legal protection in Ukraine, where they are found to be infringing the rights of the trademark owner. The rule also applies to materials and equipment that was used for the illegal marking of the said goods or for the manufacture of elements of decoration of goods, packaging, labels, tabs or other means of differentiation featuring indication that is identical or similar to the trademark which is afforded legal protection in Ukraine, to such an extent that it could be confused with the mark which is afforded legal protection in Ukraine.

By decision of the court, the seized goods, elements of decoration of goods, packaging, or means of differentiation may be transferred to the mark owner at his/her/its demand. If the mark owner does not demand such a transfer, the seized goods or means of differentiation shall be destroyed or may be used for charitable purposes.

Materials and equipment that were used for the illegal marking of the said goods or for the manufacture of elements of decoration of goods, packaging, or means of differentiation shall also be destroyed, if the court has found that these materials and equipment have been used for the illegal marking of goods or for the manufacture of elements of decoration of goods, packaging, or means of differentiation."

#### Article 20<sup>3</sup>. Provisional Measures Taken to Preserve the Evidence or to Ensure the Suit in Cases of Infringement of the Rights to the Trademark

1. Until the consideration of the case on the merits is completed, and where there are sufficient reasons to believe that the defendant is an infringer of the rights of the trademark owner, the judge has the right to issue a ruling prohibiting any actions by the defendant defined in section 2 of Article 16 of this law as use of a trademark. Such prohibition may retain effect until the court takes a decision or issues ruling.

2. Where there are sufficient data on the infringements of rights of the trademark owner or there are sufficient reasons to believe that the evidence will be destroyed, or if any delay may cause irreparable damages to the trademark owner, the trademark owner may request that provisional measures be taken by a court in order to preserve the evidence or prevent infringement of rights. Such measures can be requested both before and after the submission of the suit.

3. The court may take provisional measures including:

- 1) inspection of the premises where the activity related to the infringements of rights of the trademark owner has taken place ;
- 2) seizure of goods marked with indication that resembles the mark which is afforded legal protection in Ukraine, to such an extent that it could be confused with the mark which is afforded legal protection in Ukraine;



- 3) seizure of elements of decoration of goods, packaging, or means of differentiation marked with indication that is identical or similar to the trademark which is afforded legal protection in Ukraine to such an extent that it could be confused with a mark that is afforded legal protection in Ukraine;
- 4) seizure of materials and equipment intended exclusively for the manufacture of goods, elements of decoration of goods, packaging, or means of differentiation involving violation of mark owner's rights
- 5) provisional suspension of transactions with bank accounts and seizure of documents that may serve as evidence of activities infringing the rights of the trademark owner or threatening a violation of such rights.

4. The request of application of provisional measures must be considered in two days term in the presence of the person who has submitted the request.

The decision of a court to apply the provisional measure must be executed by the State Execution Service immediately in the presence of the person who requested such measure.

5. Prior to the adoption of the ruling to apply provisional measures, indicated in section 3 of this Article, the court may require that the person who submitted the request should supply evidence that he/she/it is the owner of the rights to the trademark and that these rights are infringed or such infringement is imminent, as well as give to the person who submitted the request a judicial ruling requiring the submission of a security (money that must be added to the deposit account of the court by the person who submitted the request or other natural or juridical persons) or other bank guarantee sufficient to protect the defendant.

The amount of the security or the bank guarantee must be determined by a court with due consideration of the circumstances of the case but it must not be less than the amount of damages claimed.

6. After the application of provisional measures envisaged in section 3 of this article, the court shall inform the parties whom it concerns. The court must in the course of 10 days establish the date of a judicial meeting, where it is decided whether the measures must be confirmed, modified or canceled. The person who has requested the application of provisional measures must no later than in two working days submit a suit to the court. A court hearing on the basis of this must take place within calendar 15 days from the day of submission of the suit. Otherwise the provisional measures must be canceled or suspended.

The security must be returned to the person who has submitted the suit if the court refuses to accept the application or if the court fulfils the demands of the plaintiff in full or in part. If the demands of the plaintiff are not fulfilled, the security or bank guarantee is used to implement the decision to repay the damages caused by the application of provisional measures to the defendant.

7. Where provisional measures were canceled or if in the course of consideration of the case it is found that no infringement has taken place and no threat thereof exists, the defendant may require the reimbursement of any damages caused by such measures in accordance with the procedures established by law".

19). In Article 21:

To change in Section 1 the word "arbitration" for "commercial";

To restate Section 2 as follows:

"2. Within their competence, courts shall consider cases involving:

- 1) invalidation of a certificate;
  - 2) pre-term termination of the term of a certificate or international registration;
  - 3) determination or restoration of rights of the owner of a certificate or of the owner of a mark that is protected in Ukraine on the basis of international agreements and treaties, to which Ukraine is a party;
  - 4) execution and performance of licensing agreements;
  - 5) violations of rights of certificate owner or of the owner of a mark that is protected in Ukraine on the basis of international agreements and treaties, to which Ukraine is a party;
  - 6) recognition of a mark as Well Known in Ukraine.
- Courts shall also consider other disputes connected with the protection of rights that are provided for in this Law.

20). To restate Section 2 in Article 24 as follows;

“2. An application for an international registration of a mark or an application for extension of protection that arises as a result of international registration (application for “territorial expansion of the international registration”), shall be filed through the Institution under the prescribed procedures. Applicable fees shall be paid for the filing of applications.”

6. To introduce the following changes to the Law of Ukraine “On Protection of Rights to Layout-Designs of Integrated Circuits (LDIC)” (Vidomosti Verkhovnoi Rady (Bulletin of the Supreme Rada) of Ukraine, 1998, No. 8, page 28; 1999, 2001, No.8, page 37):

In the Article 4:

To exclude the words from Paragraph 1 of Item 3 “in case if not more than two years passed from this date until the date of submitting an application to the Agency”;

to exclude the words "and issue of a certificate" from paragraph 2;

2) In the Article 9:

Item 11 should read as follows:

“A fee shall be paid for submission of an application to register the LDIC. A document confirming the payment of such fee should be submitted together with the application to the Agency simultaneously or within two months from the date the Agency received the application. The above mentioned time period may be extended, but for up to six months. A fee should be paid for such extension.”

3) In the Article 11:

In the paragraphs 4 and 8 of Section 2 replace the words “State duty for” with the words “fee for submitting an application for”;

Section 3:

words "State duty" in paragraph 1 to replace with "fee for submitting an application for the registration of IMC design";

in paragraph 2:

words "the applicant shall be sent a" in the second sentence to replace with words "the Agency receives";

to supplement the paragraph with the following sentence: "The noted period may be extended, but up to six months. A fee shall be paid for the extension."

To add the following paragraph to the Section:

"The Applicant has a right, on his own initiative, to amend the application materials before the date of adoption of a decision on the registration of the applied-for IMC Design. A fee shall be paid for submission of an application on introducing changes into the application materials";

words "the Institution shall notify the applicant thereof, and the application shall be deemed to have been refused" in Section 4 to replace with words "the Agency adopts a decision on denial in the registration";

in Section 5 to remove words "refusal of an application", to replace words "a decision" by the words "adoption of a decision";

in Section 5 to remove words "refusal of an application", to replace words "a decision" by the words "adoption of a decision";

to supplement Section 6 with the following sentence: "A fee shall be paid for submission of an application on introducing changes".

4) Article 12 should read as follows:

"Article 12. Registration of Layout-Design of IC.

1. After adoption of a decision on registration of the applied-for LDIC, the Agency performs a registration of the applied-for LDIC and for such purposes makes a relevant record in the Register.

The Register form and procedure for keeping the Register shall be established by the Agency.

2. State Registration of LDIC shall take place after submission of the document confirming the payment of state duty for the registration of LDIC. The applicant should mail such document to the expertise institution within three month from the date of receiving of the decision on registration of the applied-for LDIC. The above mentioned time period may be extended, but for the period not exceeding six months. A fee shall be paid for submission of an application on extension of such time period.

If in three months after receiving by the applicant of a decision on the registration of LDIC the document confirming the payment of the State duty has not been received by the expertise institution, the registration shall not take place and the application shall be considered as called back, and a relevant notification shall be submitted to the applicant.

3. After the information on the LDIC is recorded in the Register, any person has a right to apply for copying a passage out of the Register on the registered LDIC. A fee shall be charged for providing a copy of the passage.

4. The Agency or the certificate holder may initiate the changes and /or clarifications into the Register information.

The Patent Holder may initiate changes into the Register in accordance with the established list of possible changes. A fee shall be paid for introducing changes into the Register.

5. If the applicant missed the term for submitting a document on the payment of State duty for the registration of LDIC, this term may be extended during two months from the date of expiration of a missed term, provided there are valid reasons. A fee shall be paid for extending the term.

6. The LDIC is registered at the responsibility of the applicant for its protectability.

5) to supplement Section 2 of Article 13 with the following sentence: "A fee shall be paid for reviewing the information on the application";

6) to supplement Article 14 with the following Section 4:

"4. The Agency may issue a duplicate of the certificate at the request of the certificate holder. A fee shall be paid for the issue of a duplicate of the certificate";

7) paragraph 1 of Article 15 to supplement with the following sentence: "A fee shall be paid for submitting a negation to the Appeal Chamber. The document confirming the payment of a fee should be submitted together with the negation. If no fee is paid, negation shall be considered not submitted";

8) in Article 16:

to supplement Section 3 after paragraph 4 with the following paragraphs:

In accordance with the License Agreement on Exclusive or Nonexclusive License the LDIC Holder (Licensor) transfers the right to use LDIC to another person (Licensee), who takes the responsibility of making payments to the Licensor and of performing other actions specified in this Agreement.

In accordance with the Agreement on Exclusive License, the Licensor may transfer the right to Licensee to use the LDIC within a certain scope, on a determined territory and for the specified time period, keeping the right to use LDIC within the scope of non-transferred rights.

The Licensee, who obtained from the Licensor the right to use LDIC, according to the Exclusive License Agreement (owner of the exclusive license), may issue licenses for the use of LDIC for the time period of the obtained License and within the scope of the transferred rights.

In accordance with the Nonexclusive License Agreement, the Licensor transfers the right to use LDIC to the Licensee, but keeps the right to use LDIC, including the right to issue License to the third parties.

In this context, paragraph 5 - 11 should be respectively considered as paragraphs 9 - 15;  
in Section 5:

paragraph 2 should read as follows:

"The transfer of property rights to LDIC and granting of the license to use LDIC shall be effective for any other person from the date of registration of such information in the Agency".

to supplement the Section with the following paragraphs:

"Information on transfer of the property right to LDIC and on granting a license to use LDIC shall be published in the Official Bulletin.

The Agency establishes the procedure for registration and publication of the above-mentioned information.

The relevant fees shall be paid for the registration of information on transfer of property right to LDIC and for granting the license to use LDIC, as well as for introducing changes thereto initiated by the parties";

9) to supplement the last paragraph of Section 1, Article 17 with the following sentence: "with notification to the right holder of LDIC in the shortest period of time and with further relevant reimbursement to him";

10) Article 19 should read as follows:

"Article 19. Use of the Registered LDIC without Consent of the Rights Holder.

1. In case of martial law or state of emergency, the Cabinet of Ministers of Ukraine has the right to permit the certain person to use the registered LDIC without consent of the Patent Holder if he refuses to issue a license. In such case:

1) the scope and the duration of such use shall be limited by the goal, with which such use was allowed;

2) the right of user shall be provided in accordance with the provisions of the Agreement on Nonexclusive License;

3) the right of user granted on the basis of the Agreement on Nonexclusive License shall not be transferred, except the cases when it is transferred together with that part of an enterprise of business activity, within which this use is being conducted;

4) the use is allowed, first of all, for satisfying the needs of domestic market;

5) the owner of the registered LDIC shall be informed about the permit to use it;

6) permit for the use shall be cancelled in case the causes of the state of emergency cease to exist;

7) the corresponding compensation should be paid to the owner of the registered LDIC.

2. Decision of the Cabinet of Ministers on providing a permit to use the registered LDIC, the time period and conditions for issue thereof, amount of compensation and the procedure for paying it to the owner of the registered LDIC may be appealed in order established by the legislation";

11) Article 21 should read as follows:

"Article 21. Infringement of Rights of the Registered LDIC Owner.

Any person's action infringing the rights of the owner of registered LDIC provided for by Article 16 of this Law shall be considered an infringement of rights of the registered LDIC owner".

12) to supplement the Law with Articles 21<sup>1</sup>, 21<sup>2</sup>, 21<sup>3</sup> with the following wording:

" Article 21<sup>1</sup>. Procedures for the protection of rights.

Protection of property and personal non-property rights of the owner of the registered LDIC shall be performed in accordance with the procedures established in the civil, administrative and criminal legislation.

Article 21<sup>2</sup>. Methods of Civil Protection.

1. The owner of the registered LDIC has the right to request the protection of his/her/its rights from the court and other bodies in accordance with the established procedures and their competence.

2. In case of violation of rights of the owner of the registered LDIC, envisaged in Article 16 of the Law, failure to comply with conditions of use the registered LDIC as established in the license contract, or of a threat of infringement of rights and other infringements the owner of the registered LDIC has the right to:

- 1) require the recognition and restoration of his rights;
- 2) submit suits on the restoration of infringed rights and (or) termination of activities infringing the rights of the owner of the registered LDIC;
- 3) submit suits requiring the payment of moral (non-property) damages;
- 4) submit suits requiring reimbursement of losses or payment of compensation;
- 5) demand termination of preparatory activities for the violation of rights of the owner of the registered LDIC, including the suspension of the customs procedures, in accordance with the procedures established in the Customs Code of Ukraine, if there is a suspicion that goods produced in violation of the rights to the registered LDIC may be brought in or out of the territory of Ukraine;
- 6) demand seizure of goods if the registered LDIC was used in the production of such goods;
- 7) request the withdrawal from the product of LDIC where such LDIC was used illegally, and where this is impossible, request the destruction of the product. This rule refers also to the photo templates of the LDIC, technical documentation, other information on a material carrier and means necessary for producing this specific LDIC;
- 8) demand the publication in printed mass media of information on the infringement of the rights of the owner of the registered LDIC and judicial decisions thereupon. Such demands may be submitted in accordance with the judicial procedures, as well as in accordance with other procedures;
- 9) demand other actions provided for in the law and related to the protection of rights of the owner of the registered LDIC.

3. If other is not stipulated by the Licensing Agreement, and in line with it, a person who possesses the right to use a registered LDIC, may request a renewal of the infringed rights, provided there is a consent of the owner of a registered LDIC.

4. A court can take decisions or issue rulings about:

- 1) compensation of the moral (non-property) damages, caused by the violations of rights of the owner of the registered LDIC. The decision or ruling must indicate the sum of the compensation;
- 2) compensation of losses caused by the infringements of the rights of the owner of the registered LDIC;
- 3) collection from the infringer of the income received as a result of the infringement;
- 4) payment of compensation, indicated by a court, instead of compensation of losses or collection of the income;
- 5) publication of information on the infringement in mass media, if in the course of judicial proceedings it is established that rights of the owner of the registered LDIC are infringed or that there are actions constituting a threat of infringement of the rights of the owner of the registered LDIC.

5. In the calculation of the losses that must be compensated to the owner of the registered LDIC whose rights are infringed, in case of compensation of moral (non-property) damages (section 4 of this article) the court must proceed from the nature of the infringement, of property and moral damages, caused to the owner of the registered LDIC, and from the income that it might have received. The losses caused to the owner of the registered LDIC, whose rights are infringed, may include court expenses and expenditures related to the payment for services of a lawyer.

In the establishment of the sum of the compensation that must be paid instead of the compensation of losses or collection of income (section 4 of the article), the court must establish the sum of the compensation with due consideration given to the gravity of the infringement and (or) intentions of the defendant.

6. A court can take a decision requiring the payment of a fine for the amount of 10 per cent of the sum that the defendant must pay to the plaintiff in accordance with the court decision. The sum of the fine must be added to the accounts of the State Budget of Ukraine.

7. The court can take a decision to seize or confiscate all products found to be infringing the rights of the owner of the registered LDIC. The rule also applies to the photo patterns of IC design balls, the technical documents, other information on the material media and means necessary to produce this specific LDIC.

The court may decide that seized products must be transferred to the owner of the registered LDIC at his/her/its request. If the owner of the registered does not require such transfer, the seized products must be destroyed or can be used for charity purposes.

Photo patterns of IC design balls, Technical documents, other information on the material media and means necessary to produce the registered LDIC must also be destroyed, if the court finds that these materials and equipment were used for the production of the LDIC in question".

#### Article 21<sup>3</sup>. Provisional Measures Taken to Preserve the Evidence or to Ensure the Suit in Cases of Infringement of the Rights of the Owner of a Registered LDIC

1. Until the consideration of the case on the merits is completed, and where there are sufficient reasons to believe that the defendant is an infringer of the rights of the owner of the registered LDIC, the judge has the right to issue a ruling prohibiting any actions by the defendant defined in part 2 of Article 20 of this law as use of LDIC. Such prohibition may retain effect until the court takes a decision or issues ruling.

2. Where there are sufficient data on the infringements of rights of the owner of the registered LDIC or there are sufficient reasons to believe that the evidence will be destroyed, or if any delay may cause irreparable damages to the owner of the registered LDIC, the owner of

the registered LDIC may request that provisional measures be taken by a court in order to preserve the evidence or prevent infringement of rights. Such measures can be requested both before and after the submission of the suit.

3. The court may take provisional measures including:

- 1) inspection of the premises where the activity related to the infringements of rights of the owner of the registered LDIC has taken place;
- 2) seizure of goods, if there are sufficient reasons to believe that such products were produced or put into commercial circulation in violation of rights of the owner of the registered LDIC;
- 3) seizure of materials and equipment intended for the production of goods in violation of the rights of the owner of the registered LDIC;
- 4) provisional suspension of transactions with bank accounts and seizure of documents that may serve as evidence of activities infringing the rights of the owner of the registered LDIC or threatening a violation of such rights.

4. The request of application of provisional measures must be considered in two days term in the presence of the person who has submitted the request.

The decision of a court to apply the provisional measure must be executed by the State Execution Service immediately in the presence of the person who requested such measure.

5. Before the adoption of a on the application of provisional measures, indicated in section 3 of this Article, the court may require that the person who submitted the request should supply evidence that he/she/it is the owner of the rights to LDIC and that these rights are infringed or such infringement is imminent, as well as give to the person who submitted the request a judicial ruling requiring the submission of a security or other bank guarantee sufficient to protect the defendant.

The security shall be money that must be added to the deposit account of the court by the person who submitted the request or other natural or juridical persons or supply of an equivalent bank guarantee sufficient to protect the defendant.

The amount of the security or the bank guarantee must be determined by a court with due consideration of the circumstances of the case but it must not be less than the amount of damages claimed.

6. After the application of provisional measures envisaged in section 3 of this article, the court shall inform the parties whom it concerns. The court must in the course of 10 days establish the date of a judicial meeting, where it is decided whether the measures must be confirmed, modified or canceled. The person who has requested the application of provisional measures must no later than in two working days submit a suit to the court. A court hearing on the basis of this must take place within calendar 15 days from the day of submission of the suit. Otherwise the provisional measures must be canceled or suspended.

The security must be returned to the person who has submitted the suit if the court refuses to accept the application or if the court fulfils the demands of the plaintiff in full or in part. If the demands of the plaintiff are not fulfilled, the security or bank guarantee is used to implement the decision to repay the damages caused by the application of provisional measures to the defendant.

7. Where provisional measures were canceled or if in the course of consideration of the case it is found that no infringement has taken place and no threat thereof exists, the defendant may require the reimbursement of any damages caused by such measures in accordance with the procedures established by law".



7. To introduce the following changes into the Law of Ukraine “On Protection of Rights to Indications of Origin of Goods” (Vidomosti Verkhovnoi Rady (Bulletin of the Supreme Rada) of Ukraine, 1999, No. 32, page 267; 2001, No. 8, page 37):

1) In Article 1:

To supplement paragraph 7 with the sentence as follows: “It may also be a geographic name used to indicate a good, or a part thereof”;

To replace in paragraphs 11 and 12 the words “as an indication in the name of a good” by the words “for indication of a good”;

To replace the word “this” with the word “registered” in paragraph 20;

2) To replace the words “with the exception of such as are established by international treaties and agreements to which Ukraine is a party ” in part 1 of Article 5 by the words “in accordance with the international treaties and agreements to which Ukraine is a party, the obligatory character of which has been established by the Supreme Rada”;

3) To supplement part 1 of Article 6 after paragraph 1 with a paragraph as follows:

“The simple indication of origin of a good shall mean any verbal or pictorial (graphical) indication which directly or indirectly indicates the specific geographic location of origin of the good. It may be also the name of a geographic place which is used as the name of the good or as a part thereof.”

In connection with the above-mentioned changes, Paragraphs 2 and 3 shall be regarded as Paragraphs 3 and 4;

4) In Article 7:

To delete Part 2;

In Subsection c of Section 3 to replace the words “in the location indicated by this geographic indication” by the words “in the specified location identified by the geographic indication”.

5) In Subsection b of Section 1 of Article 8 to replace the words “public interests” by the words “public order”;

6) To supplement Section 9 of Article 11 with the sentence as follows: “Fees shall be paid for the perusal of the application materials”;

7) In Article 15:

To supplement part 1 with paragraphs as follows:

“The period for payment of state duty may be extended, but no more than by six months. Fees shall be paid for the filing of a petition requesting such extension of the period for payment.

The period for payment of state duty missed by the applicant may be renewed within a period of two months from the date of expiry of the missed period, conditional on the existence of valid reasons. Fees shall be paid for the renewal of the missed period”;

To supplement the Article with part 5 as follows:

“5. On certificate owner’s demand, the Institution shall issue a duplicate certificate in accordance with the procedure established by the Institution. Fees shall be paid for the issuance of a duplicate certificate”;

8) To delete the word “illegal” in Subsection b of section 4 of Article 17;

9) In part 2 of Article 20:

In paragraph 1 to replace the words “may be recognized as invalid by court if it” by the words “and the certificate for the right to use the right to use a qualified indication of origin of goods, may be recognized as invalid by court if registration”;

To delete the word “registration” in paragraph 2;

10) In Article 21:

To delete the word “Protection” in the title of the Article;

To replace the second and third sentences in Subsection a of section 3 by a sentence as follows: “Pursuant to the decision of the court to terminate the registration of a qualified indication of origin of goods, the right to use this qualified indication of origin of goods shall terminate from the date of termination of the registration of the qualified indication of origin of goods;”

11) The title of Chapter VI and Articles 23, 24 and 25 shall read as follows

“CHAPTER VI

PROTECTION OF RIGHTS

Article 23. Violation of Certificate Holder Rights.

1. The following shall be violations of rights of the holder of the certificate:

a) The use of the registered qualified indication of origin by a person who does not have the right to use it;

b) use on a good of the registered qualified indication of origin of goods, if such a good does not originate from the geographical location as registered for such indication, even if the indication of the place of origin of the good is used in the translation or is accompanied by the words: "kind", "type", "style", "make", "imitation", etc.;

c) use of the registered qualified indication of origin of goods or another similar indication for similar goods that differ from those described in the Register, if such use misleads consumers with regard to the origin of such goods and their specific qualities or other characteristics, as well as use for dissimilar goods, if such use harms the reputation of the registered indication or constitutes the illegitimate use of its reputation;

d) use of the registered qualified indication of origin of goods as a generic name for a good;

e) importation into Ukraine’s customs territory with commercial purposes, without permission from the holder of the certificate, of goods marked with such qualified indication of origin of goods as has been accorded legal protection in Ukraine;

f) use of the qualified indication of origin in the worldwide computer network “Internet”, including in the name of a domain, for commercial purposes, without permission from the holder of the certificate;

g) commitment of any other actions that pose a threat of violation of rights of the holder of the certificate.

2. The following shall not be deemed to be violations of rights of the holder of the certificate:

- a) use of the registered qualified indication of origin of goods specified in clauses b and c in part 5 of Article 17 hereof by any person who has legally acquired a good marked with such qualified indication of origin from the holder of the certificate, and again introduces the product into circulation;
- b) use of the qualified indication of origin of goods by a person who does not have a certificate for the use thereof, but has used it in the bona fide manner till the registration date. If such person does not file an application for registration of the right to use this indication with the Institution within twelve months after the date of registration of this qualified indication of origin, then the subsequent use of such indication shall be deemed to be a violation of the rights of the certificate holder.

#### Article 24. Procedures for the Protection of Rights of the Certificate Holder

Protection of rights of the certificate holder shall be performed in accordance with the procedures established in the civil, administrative and criminal legislation.

#### Article 25. Methods of Civil Protection of Rights of the Certificate Holder

1. The certificate holder has the right to request the protection of his/her/its rights from the court and other bodies in accordance with the established procedures and their competence.

In case of violation of rights of the trademark owner, envisaged in Article 17 of the Law, or of a threat of infringement of rights the certificate holder has the right to:

- a) require the recognition and restoration of his rights;
- b) submit suits on the restoration of infringed rights and (or) termination of activities infringing the rights of the trademark owner;
- c) submit suits requiring the payment of moral (non-property) damages;
- d) submit suits requiring reimbursement of damages (financial damages), including lost profit, or garnishment of income, obtained by an infringer as a result of his/her/its violation of rights of the trademark owner, or payment of compensation;
- e) demand termination of preparatory activities for the violation of rights of the trademark owner, including the suspension of the customs procedures, in accordance with the procedures established in the Customs Code of Ukraine, if there is a suspicion that goods produced in violation of the rights to the trademark may be brought out of or in the territory of Ukraine;
- f) demand the withdrawal from commercial circulation of goods, elements of decoration of goods, packaging, or means of differentiation marked with indication that resembles the mark which is afforded legal protection in Ukraine, to such an extent that it could be confused with the mark which is afforded legal protection in Ukraine;
- g) demand the removal of the illegitimately affixed qualified indication of the origin of goods from a product or its packaging and, where this is impossible, to demand the destruction of such goods;
- h) demand the publication in printed mass media of information on the infringement of the rights of the certificate holder and judicial decisions thereupon. Such demands may be submitted in accordance with the judicial procedures, as well as in accordance with other procedures;
- j) demand other actions provided for in the law and related to the protection of rights of the trademark owner.

2. Pursuant to their competence, courts shall consider cases involving:

determination or restoration of rights of the certificate holder;  
violation of property rights of the certificate holder;  
importation into the customs territory of Ukraine of unlawfully marked goods.

Courts shall also consider other cases connected with the protection of rights that are afforded by this Law.

3. A court can take decisions or issue rulings about:

a) compensation of the moral (non-property) damages, caused by the violations of rights of the trademark owner. The decision or ruling must indicate the sum of the compensation;  
b) compensation of losses caused by the infringements of the rights of the trademark owner;  
c) collection from the infringer of the income received as a result of the infringement;  
d) payment of compensation, indicated by a court, in the amount ranging from 10 to 50000 minimum salaries, instead of compensation of losses or collection of the income;  
e) publication of information on the infringement in mass media, if in the course of judicial proceedings it is established that rights of the certificate holder are infringed or if there are actions constituting a threat of infringement of the rights of the trademark owner.

4. In the calculation of the losses that must be compensated to the certificate holder whose rights are infringed, in case of compensation of moral (non-property) damages the court must proceed from the nature of the infringement, of property and moral damages, caused to the trademark owner, and from the income that it might have received. The losses caused to the certificate holder, whose rights are infringed, may include court expenses and expenditures related to the payment for services of a lawyer.

In the establishment of the sum of the compensation that must be paid instead of the compensation of losses or collection of income, the court must establish the sum of the compensation, with due consideration given to the gravity of the infringement and (or) intentions of the defendant.

5. A court can take a decision requiring the payment of a fine for the amount of 10 per cent of the sum that the defendant must pay to the plaintiff in accordance with the court decision. The sum of the fine must be added to the accounts of the State Budget of Ukraine in accordance with the established procedures.

6. The court can take a decision to seize or confiscate all goods, where they are found to be infringing the rights of the certificate holder. The rule also applies to materials and equipment that was used for the illegal marking of the said goods.

By decision of the court, the seized goods may be transferred to the certificate holder at his/her/its demand. If the mark owner does not demand such a transfer, the seized goods shall be destroyed or may be used for charitable purposes.

Materials and equipment that were used for the illegal marking of the said goods shall also be destroyed, if the court has found that these materials and equipment have been used for the illegal marking of goods."

Article 25<sup>1</sup>. Provisional Measures Taken to Preserve the Evidence or to Ensure the Suit in Cases of Infringement of the Rights of the Certificate Holder

1. Until the consideration of the case on the merits is completed, and where there are sufficient reasons to believe that the defendant is an infringer of the rights of the certificate holder, the judge has the right to issue a ruling prohibiting any actions by the defendant defined in section 5 of Article 17 of this law as use of a qualified indication of origin of goods. Such prohibition may retain effect until the court takes a decision or issues ruling.

2. Where there are sufficient data on the infringements of rights of the certificate holder or there are sufficient reasons to believe that the evidence will be destroyed, or if any delay may cause irreparable damages to the certificate holder, the certificate holder may request that provisional measures be taken by a court in order to preserve the evidence or prevent infringement of rights. Such measures can be requested both before and after the submission of the suit.

3. The court may take provisional measures including:

- a) inspection of the premises where the activity related to the infringements of rights of the certificate holder has taken place ;
- b) seizure of goods marked with indication that is identical or similar to a registered qualified indication of origin of goods to such an extent that it could be confused with the registered qualified indication of origin of goods concerned;
- c) seizure of elements of decoration of goods, packaging, or means of differentiation marked with indication that is identical or similar to a registered qualified indication of origin of goods to such an extent that it could be confused with the registered qualified indication of origin of goods concerned;
- d) seizure of materials and equipment intended exclusively for the manufacture of goods, elements of decoration of goods, packaging, or means of differentiation involving violation of rights of the certificate holder;
- e) provisional suspension of transactions with bank accounts and seizure of documents that may serve as evidence of activities infringing the rights of the certificate holder or threatening a violation of such rights.

4. The request of application of provisional measures must be considered in two days term in the presence of the person who has submitted the request.

The decision of a court to apply the provisional measure must be executed by the State Execution Service immediately in the presence of the person who requested such measure.

5. Prior to the adoption of the ruling to apply provisional measures, indicated in section 3 of this Article, the court may require that the person who submitted the request should supply evidence that he/she/it is the owner of qualified indication of origin of goods and that these rights are infringed or such infringement is imminent, as well as give to the person who submitted the request a judicial ruling requiring the submission of a security (money that must be added to the deposit account of the court by the person who submitted the request or other natural or juridical persons) or equivalent bank guarantee sufficient to protect the defendant.

The amount of the security or the bank guarantee must be determined by a court with due consideration of the circumstances of the case but it must not be less than the amount of damages claimed.

6. After the application of provisional measures envisaged in section 3 of this article, the court shall inform the parties whom it concerns. The court must in the course of 10 days establish the date of a judicial meeting, where it is decided whether the measures must be confirmed, modified or canceled. The person who has requested the application of provisional measures must no later than in two working days submit a suit to the court. A court hearing on the basis of this must take place within calendar 15 days from the day of submission of the suit. Otherwise the provisional measures must be canceled or suspended.

The security must be returned to the person who has submitted the suit if the court refuses to accept the application or if the court fulfils the demands of the plaintiff in full or in part. If the demands of the plaintiff are not fulfilled, the security or bank guarantee is used to implement the decision to repay the damages caused by the application of provisional measures to the defendant.

7. Where provisional measures were canceled or if in the course of consideration of the case it is found that no infringement has taken place and no threat thereof exists, the defendant may require the reimbursement of any damages caused by such measures in accordance with the procedures established by law".

5. In the Law of Ukraine "On Protection of Rights to Inventions and Utility Models" (Vidomosti Verkhovnoi Rade (Bulletin of the Supreme Rada) of Ukraine, year 2000, No.37, p. 307; 2001, No.8, p.37):

1) in Article 1:  
in paragraph 16 words "and examination for local novelty" shall be omitted;  
paragraphs twenty one and twenty-two shall be omitted;

2) in Article 6:  
in part one words "which do not contradict to public interests" shall be replaced with the words "using of which do not contradict to public order",

part three shall read as follows:

"3. According to this Law the following shall not be legally protected:

discoveries, scientific theories and mathematical methods;

schemes, rules or methods of organizing production [process];

methods for conducting intellectual calculations and games;

computer software as such;

kinds of vegetables, breeds of animals, or strictly biological methods of growing plants and animals, except for microbiological methods and products cultivated with these methods."

Paragraph five of part four shall be added with the following sentence: "A fee shall be paid for submitting petition";

3) in part three of part one of Article 14 words "up to six months from the date of receiving of international application" shall be replaced with the words "in established order, but no longer than for three months";

4) Article 15 shall be added with part eight that shall read as follows:  
"8. Priority can be identified according to the date of receiving of additional materials by Institution under condition they are submitted by applicant as a separate application, submitted within three months after applicant received Institution's notice on impossibility of additional materials consideration during application consideration as they pass the limits of the invention (utility model) essence presented in the submitted application;

5) in Article 16:

part ten shall be worded as follows:

“10. If application for issuing of declaratory patent for invention is in line with the requirements of Article 12 of this Law and the document on payment for application fee submission is submitted, the resolution on issuing declaratory patent shall be sent to the applicant”;

in part twelve:

paragraph two shall be supplemented with the following sentence: “A fee shall be paid for petition to publish information on application ahead of established time”;

paragraph three shall be supplemented with the following sentence: “A fee shall be paid for reviewing the information on the application”;

6) Article 18 shall be supplemented with the following:

“A fee shall be paid for turning application for patent on invention into application for declaratory patent on invention and vice-versa.

A fee shall be paid for turning application for issuing patent (declaratory patent) on invention into application for declaratory patent on utility model and vice-versa”;

7) Article 20 shall be added with the following part:

“A fee shall be paid for substitution of the applicant conducted on his/her initiative”;

8) in Article 22:

part two shall read as follows:

“2. State registration of the patent (declaratory patent) on invention and declaratory patent on utility model shall be conducted if the document for payment of state duty for its issuance and document for payment of fee for publishing of the description attached to the patent are available. These documents shall be received by examination institution within three months after the applicant received resolution on issuing patent.

State registration of the patent shall not be conducted and application shall be considered withdrawn in case the document for payment of state duty for its issuance and document for payment of fee for publishing of the description attached to the patent are not received by examination institution within three months after the applicant received resolution on issuing patent.

The above mentioned term might be extended but no longer than for six months. A fee shall be paid for submitting petition on this term extension.

Under valid reasons the deadline of state duty payment for issuing patent and payment of fee for publishing description to the patent missed by the applicant might be recovered within two months upon its expiration. A fee shall be paid for recovering the deadline”;

paragraph one of part three shall read as follows:

“3. After information on patent (declaratory patent) on invention and declaratory patent on utility model is in the Register, any person is eligible to submit petition as for receiving

abstracts from the Register as for the patent (declaratory patent). A fee shall be paid for receiving abstracts from the Register”;

9) part three of Article 23 shall be added with the following sentence: “A fee shall be paid for making oneself acquainted with application materials”;

10) Article 25 shall be added with part four that shall read:

“4. On patent owner’s demand the Institution shall issue a duplicate of the patent in the order established by the Institution. A fee shall be paid for issuing duplicate of the patent”;

11) in Article 28:  
part six shall be added with the following paragraph:  
“A property right to invention (utility model) can be inherited”;

in part seven:

paragraphs two and three shall be worded:

“According to the license agreement on exclusive or non-exclusive license the patent owner (licensor) might transfer right to use invention (utility model) to another person (licensee) who shall conduct payments to licensor and take other actions provided for by this agreement.

According to agreement on exclusive license, the licensor might transfer the right to use invention (utility model) in certain scope, on certain territory and for the time agreed remaining with the right to use invention (utility model) in part not transferred to licensee;

to supplement the part after paragraph three with the following paragraph:

“The licensee, who according to agreement on exclusive license received the right to use invention (utility model) (owner of the exclusive license) shall be eligible to issue license for use of invention (utility model) within the term of the license and within the scope of rights transferred to him/her”.

Due to this, paragraph four shall be regarded as paragraph five;

in part eight:

paragraph two shall be replaced with the following paragraphs:

“Transfer of the ownership right to invention (utility model) and granting license on using an invention (utility model) shall be valid for any other person from the date of registration of information on this in the Institution.

Information on transfer of the ownership right to invention (utility model) and granting license on using invention (utility model) shall be published in official bulletin”;

the part after paragraph three shall be supplemented with the following:

“The Institution shall determine the order for registration and publishing of the mentioned information.

Proper fees shall be paid for registration and publishing of the mentioned information on transfer of the ownership right to invention (utility model) and granting license on using invention (utility model), as well as for introducing changes to them, initiated by the parties of agreement”;



12) in Article 30:

in paragraph one of part one the words “or not used in full” shall be omitted;

part three shall be worded as follows:

“3. The Cabinet of Ministers of Ukraine shall have a right to allow using an invention (utility model) to the person determined by it without patent (declaratory patent) owner consent or in case of his/her refusal to provide such consent under martial law and emergency state. In such a case:

- 1) scope and term of using shall be limited according to the aim this using is allowed for;
- 2) using right shall be granted according to agreement on non-exclusive license;
- 3) using right granted according to agreement on non-exclusive license shall not be transferred unless it is transferred along with the part of enterprise or business practice it is used in;
- 4) using shall be allowed primarily to meet needs of the domestic market;
- 5) a notice on invention (utility model) shall be sent to the owner of the patent;
- 6) permission for using shall be cancelled as soon as conditions caused its issuance are over;
- 7) proper compensation shall be paid to the patent owner.

The Cabinet of Ministers resolution on granting permission for using invention (utility model), its terms and conditions, size and order of compensation payment to the patent owner can be appealed against in the order established by the law”;

13) in part two of Article 31:

paragraph five shall be added with the words: “with informing patent owner in the shortest term and the following compensation payment”;

the last paragraph shall be omitted;

14) Article 34 shall be worded as follows:

“Article 34. Violation of Rights of the Patent Owner

Any actions by any person to violate the rights of the patent owner provided for by Article 28 of this Law shall be considered as the patent owner’s rights violation”;

15) the Law shall be supplemented with Articles 34<sup>1</sup>, 34<sup>2</sup>, 34<sup>3</sup> of the following content:

"Article 34<sup>1</sup>. Procedures for the protection of rights

Protection of property and personal non-property rights of the patent holder shall be performed in accordance with the procedures established in the civil, administrative and criminal legislation.

Article 34<sup>2</sup>. Methods of Civil Protection of Rights

1. The patent holder has the right to request the protection of his/her/its rights from the court and other bodies in accordance with the established procedures and their competence.

2. In case of violation of rights of the patent holder, envisaged in Article 28 of the Law, failure to comply with conditions of use the patented invention (utility model) as established in the license contract, or of a threat of infringement of rights and other infringements the patent holder has the right to:

- 1) require the recognition and restoration of his rights;
- 2) submit suits on the restoration of infringed rights and (or) termination of activities infringing the rights of the patent holder;
- 3) submit suits requiring the payment of moral (non-property) damages;
- 4) submit suits requiring reimbursement of losses or payment of compensation;
- 5) demand termination of preparatory activities for the violation of rights of the patent holder, including the suspension of the customs procedures, in accordance with the procedures established in the Customs Code of Ukraine, if there is a suspicion that goods produced in violation of the rights to the patented invention (utility model) may be brought out of or in the territory of Ukraine;
- 6) demand seizure of goods if the patented invention (utility model) or method or product containing patented invention was used in the production of such goods;
- 7) demand confiscation of the illegally used patented invention (utility model) and where this is impossible, demand the destruction of the product;
- 8) demand the publication in printed mass media of information on the infringement of the rights of the patent holder and judicial decisions thereupon. Such demands may be submitted in accordance with the judicial procedures, as well as in accordance with other procedures;
- 9) demand other actions provided for in the law and related to the protection of rights of the patent holder.

3. Where the patent covers the method of obtaining a product, it is the suspected infringer who is obliged to prove in the course of consideration of the case that the method of obtaining the product identical to the one produced in accordance with a method covered by the patent.

In the absence of evidence to the contrary, it must be considered that the said identical product produced without permission of the patent holder was obtained in accordance with the method covered by the patent if at least one of the following two conditions is met:

- the product obtained in accordance with the method covered by a patent is new;
- there are reasons to believe that the method covered by the patent was used in obtaining the said identical product and the patent holder is not able to establish the method used in obtaining such identical product.

4. By consent of the patent holder and if the licensing contract does not provide otherwise, the person authorized by the licensing contract to use the patented invention (utility model) may also demand that the infringed rights be restored.

5. A court can take decisions or issue rulings about:

- 1) compensation of the moral (non-property) damages, caused by the violations of rights of the patent holder. The decision or ruling must indicate the sum of the compensation;
- 2) compensation of losses caused by the infringements of the rights of the patent holder;
- 3) collection from the infringer of the income received as a result of the infringement;
- 4) payment of compensation, indicated by a court, instead of compensation of losses or collection of the income;
- 5) publication of information on the infringement in mass media, if in the course of judicial proceedings it is established that rights of the patent holder are infringed or if there are actions constituting a threat of infringement of the rights of the patent holder.

6. In the calculation of the losses that must be compensated to the patent holder whose rights are infringed, in case of compensation of moral (non-property) damages (section 5 of this article) the court must proceed from the nature of the infringement, of property and moral damages, caused to the patent holder, and from the income that it might have received. The

losses caused to the patent holder, whose rights are infringed, may include court expenses and expenditures related to the payment for services of a lawyer.

In the establishment of the sum of the compensation that must be paid instead of the compensation of losses or collection of income (section 5 of the article), the court must establish the sum of the compensation with due consideration given to the gravity of the infringement and (or) intentions of the defendant.

7. A court can take a decision requiring the payment of a fine for the amount of 10 per cent of the sum that the defendant must pay to the plaintiff in accordance with the court decision. The sum of the fine must be added to the accounts of the State Budget of Ukraine.

8. The court can take a decision to seize or confiscate all products found to be produced in violation of rights of the patent holder. The rule also applies to the technical documents, other information on the material media and means necessary to produce the relevant invention (utility model).

The court may decide that seized products must be transferred to the patent owner at his/her/its request. If the patent owner does not require such transfer, the seized products must be destroyed or can be used for charity purposes.

Technical documents, other information on the material media and means necessary to produce the patented invention (utility model) must also be destroyed, if the court finds that these materials and equipment were used only for the production of the invention (utility model) in question.

#### Article 34<sup>3</sup>. Provisional Measures Taken to Preserve the Evidence or to Ensure the Suit in Cases of Infringement of the Rights of the Holder of the Patent for the Invention (Utility Model)

1. Until the consideration of the case on the merits is completed, and where there are sufficient reasons to believe that the defendant is an infringer of the rights of the patent holder, the judge has the right to issue a ruling prohibiting any actions by the defendant defined in part 2 of Article 28 of this law as use of an invention (utility model). Such prohibition may retain effect until the court takes a decision or issues ruling.

2. Where there are sufficient data on the infringements of rights of the holder of the patent for the invention (utility model) or there are reasons to believe that the evidence will be destroyed, or if any delay may cause irreparable damages to the holder of the patent for the invention (utility model), the patent holder may request that provisional measures be taken by a court in order to preserve the evidence or prevent infringement of rights. Such measures can be requested both before and after the submission of the suit.

3. The court may take provisional measures including:

- 1) inspection of the premises where the activity related to the infringements of rights of the patent holder has taken place ;
- 2) seizure of goods, if there are sufficient reasons to believe that such products were produced or put into commercial circulation in violation of rights of the patent holder;
- 3) seizure of materials and equipment, intended for the production of goods in violation of rights of the holder of the patent for the invention (utility model);
- 4) provisional suspension of transactions with bank accounts and seizure of documents that may serve as evidence of activities infringing the rights of the patent holder or threatening a violation of such rights.

4. The request of application of provisional measures must be considered in two days term in the presence of the person who has submitted the request.

The decision of a court to apply the provisional measure must be executed by the State Execution Service immediately in the presence of the person who requested such measure.

5. Before the adoption of the ruling on the application of provisional measures, indicated in section 3 of this Article, the court may require that the person who submitted the request should supply evidence that he/she/it is the owner of the rights to the invention (utility model) and that these rights are infringed or such infringement is imminent, as well as give to the person who submitted the request a judicial ruling requiring the submission of a security (money that must be added to the deposit account of the court by the person who submitted the request or other natural or juridical persons) or other bank guarantee sufficient to protect the defendant.

The amount of the security or the bank guarantee must be determined by a court with due consideration of the circumstances of the case but it must not be less than the amount of damages claimed.

6. After the application of provisional measures envisaged in section 3 of this article, the court shall inform the parties whom it concerns of such measures. The court must in the course of 10 days establish the date of a judicial meeting, where it is decided whether the measures must be confirmed, modified or canceled. The person who has requested the application of provisional measures must no later than in two working days submit a suit to the court. A court hearing on the basis of this must take place within calendar 15 days from the day of submission of the suit. Otherwise the provisional measures must be canceled or suspended.

The security must be returned to the person who has submitted the suit if the court refuses to accept the application or if the court fulfils the demands of the plaintiff in full or in part. If the demands of the plaintiff are not fulfilled, the security or bank guarantee is used to implement the decision to repay the damages caused by the application of provisional measures to the defendant.

7. Where provisional measures were canceled or if in the course of consideration of the case it is found that no infringement has taken place and no threat thereof exists, the defendant may require the reimbursement of any damages caused by such measures in accordance with the procedures established by law".

16) in part one of Article 35 word "arbitration" shall be replaced with the word "commercial".

In the Law of Ukraine "On Copyright and Related Rights" (Vidomosti Verkhovnoyi Rady (Bulletin of the Supreme Rada) of Ukraine, 2001, #43, p. 214):

1) Article one shall be added with the following paragraphs:  
"usual family circle – relatives, who according to the legislature of Ukraine might be first priority legatees;  
state system for legal protection of intellectual property – an Institution and totality of expert, scientific, educational, informational and other public institutions of proper specialty within the field of the Institution's competence (administration)";

2) in subsection eleven of section one, Article 8 words "if they are not protected by the laws of Ukraine on legal protection of the objects of industrial property" shall be omitted;

3) paragraphs three and four of section five, Article 11 shall read as follows:  
"Certificate shall be granted on registration of the copyright to work. Fees shall be paid for granting certificate and preparation by the Institution to state registration of copyright and

agreements having to do with the right of the author to the work. The Cabinet of Ministers of Ukraine shall determine the list, amounts, terms of and procedures for payment of fees.

Duties provided for this Law shall be paid to accounts of the institutions of the state system for legal protection of intellectual property protection empowered by the Institution. According to the Institution's resolution, they shall be used exclusively for support of the activities of the state system for legal protection of the intellectual property in the field of copyright";

4) subsection five of section one, Article 21 shall read as follows:

"5) reproduction in catalogues, exhibited in exhibitions available for the public, auctions, fairs or collections, for coverage of these events without using these catalogues with commercial purposes";

5) subsection "b" of section 1, Article 22 shall be omitted;

6) subsection "b" of section 2, Article 23 shall be omitted;

7) paragraph one of section one, Article 24 after words "legally possesses" shall be added with the words "legally produced";

8) in Article 25:

subsection "g" of section one shall be omitted;

section two shall read as follows:

"2. Works and performances, recorded to phonograms and videograms, their copies, as well as audiovisual works and their copies can be played in home conditions exclusively for personal purposes or for the usual family circle without author's (authors'), performers, producers of the phonograms, videograms, consent but with payment of remuneration to them. Specialties of the remuneration payment for such cases shall be determined by Article 42 of this Law";

9) section nine of Article 28 shall read as follows:

"9. Term of validity of the copyright determined in parts two through seven of this article shall be counted from the date of event it is related to, but it shall be counted (shall be considered as the one that begins) from January 1 of the year, following the year when the mentioned event took place";

10) in section one of Article 49:

section "b" shall be worded as follows:

"b) to collect, distribute and pay the collected remuneration for using objects of copyright and/or related rights to the subjects of copyright and/or related rights, they manage rights thereof, as well as to other subjects of rights according to this Law";

section "g" shall be omitted.

## II. Final Provisions

1. This Law shall come into effect on the day of its being published. It shall apply to legal relations emerging after its coming into effect.

2. To determine that:

until legislation is harmonized with this Law other laws and normative acts shall be effective in parts that do not contradict to this Law;

applications for issuing patents on industrial designs and certificates for trademarks for goods and services, that were not processed by the time the Law comes into effect, shall be processed in accordance with the procedures established by this Law.

Whether the industrial designs meet the conditions of patentability and whether trademarks for goods and services meet the conditions for providing legal protection shall be determined according to the legislation effective on the date of submission of the application;

In case the industrial design does not meet the conditions of patentability and the trademark does not meet the conditions for providing legal protection, established by the legislation effective on the date of submission of the application, patents for industrial designs and certificates for trademarks for goods and services can be invalidated in accordance with the procedures established by this Law.

3. Cabinet of Ministers of Ukraine within six months after coming of this Law into effect shall:

- harmonize its normative acts with this Law;

- ensure the revision and cancellation by the bodies of executive power of the normative acts contradicting to this Law;

- provide for the adoption of normative acts necessary for implementation of this Law.