

Law of Ukraine

ON PROTECTION OF RIGHTS TO TRADEMARKS FOR GOODS AND SERVICES

No.3689-XII

December 15, 1993

This Law shall regulate relations appearing in connection with getting and using the property right for trademarks for goods and services (hereinafter - trademark) in Ukraine.

Part I GENERAL PROVISIONS

Article 1. Definitions

For the purpose of this Law the terms below shall be used in the following meanings
Department - the State Committee of Ukraine for Intellectual Property (Ukrainian Derzhpatent) together with subordinated to it enterprises, establishments and organizations;

person - a citizen or legal person;

trademark - a sign for differentiation of goods and services of one person from similar goods and services of other persons;

certificate - the certificate of Ukraine for a trademark for goods and services;

registered trademark - trademark certified;

application - a number of documents required for issuing the certificate;

applicant - a person who submitted the application;

application priority (priority) - being the first to submit the application;

priority date - date of submitting the application to the Department or the respective organ of a state - participant to the Paris Convention on Protection of Production Property under Priority;

Register - the State Register for certificates of Ukraine for trademarks for goods and services.

Council of Appeal- collegial Committee of the Department for consideration of appeals against the Department's decisions concerning acquiring rights for intellectual property.

expertise institute - State institution, authorized by the Department (company, organization) aiming at consideration and performing the application expertise.

State system of legal protection of the intellectual property - Department together with a number of expertise, scientific, educational, informational and other state institutions of corresponding specialization that comprise the sphere of management of the Department.

Article 2. Department's authorities in the sphere of legal protection of trademarks and services.

1. To provide the state policy in the area of legal protection of trademarks and services the Department shall:

perform consideration and expert examination of applications and takes its decision on them;

issues certificates for trademarks and services and provides their state registration;

perform international cooperation in the area of legal protection of intellectual property and represent interests of Ukraine in the international organizations in issues concerning legal protection of trademarks and services according to the current legislation;

adopt normative and legal regulations within its authorities according to the established order;

arrange informational and publishing activity in the area of legal protection of intellectual property;

perform research on improving the legislation and organization of the activity in the area of legal protection of the intellectual property;

arrange retraining of personnel of the state system for legal protection of intellectual property;

depending on the area of their activity, assign particular duties that are established by this Law, Provision on the Department or other normative and legal regulations in the area of legal protection of intellectual property to the institutions that comprise the state system of legal protection of intellectual property;

perform other activities according to the Provision on the Department approved according to the established order.

2. Funding the Department's activities shall be performed at the expense of the state budget.

Article 3. International Agreements

1. Where the international agreements of Ukraine provide regulations contrary to the provisions of the Ukrainian legislation on trademarks, the provisions under the international agreements shall effect.

Article 4. Rights of Foreign Persons

1. Foreign persons have equal rights with the Ukrainian persons, as provided by this Law, in accordance with the international agreements of Ukraine, or on the principle of reciprocity.

2. Foreign or other persons who reside or are permanently located outside Ukraine, in their relations with the Department shall realize their rights through intermediaries registered in accordance with the Regulation for Representatives in Intellectual Property approved by the Cabinet of Ministers of Ukraine.

Part II TRADEMARKS LEGAL PROTECTION

Article 5. Conditions for Legal Protection

1. Legal protection shall be provided for the trademark which does not contradict to the economic interests, principles of humanism and moral, and which are not subject for refusal from legal protection, as provided by article 6 of this Law.

2. Object of a trademark may be signs in the form of words, pictures, volumetric signs, or their combinations in any colour, or a combination of colours.

3. The property right for a trademark shall be certified. The validity term of the certificate shall be 10 years since the date of submitting the application to the Department, and it shall be prolonged by the Department for another 10-year period at the request of the certificate's owner during the last year of the validity term. The procedure for prolongation of the validity term for the certificate shall be established by the Department.

The validity term of the certificate may be terminated ahead of the expiry date, where it is provided by article 18 of this Law.

4. The volume of the legal protection offered shall be set up by the trademark and list of goods and services in the certificate.

5. Any person, association of persons, or their legatees have the right for receiving the certificate in accordance with the procedure established by this Law.

6. The right for receiving the certificate shall be exercised by the applicant, whose application has an earlier date of submitting the application to the Department, where the priority is declared - an earlier date of priority, provided it was not withdrawn or refused.

Article 6. Grounds for Refusal from Legal Protection

1. In accordance with this Law the legal protection cannot be provided to trademarks containing

- national coat-of-arms, flags, and emblems;
- official names of countries;
- emblems, abbreviated or full names of international, intergovernmental organizations;
- official control, guarantee, or testing seals, stamps;
- awards.

These signs may be included into the trade mark as an element, provided the respective competent body agrees to this.

2. According to this Law the following signs cannot also get the legal protection

- those having no differentiated meaning;
- those being commonly used to specify goods and services of a certain type;
- those specifying the type, quality, number, property, value of goods and services, and also the place and time of production and realization;
- those being deceiving, which may mislead as to goods, or services;
- those being commonly used symbols, and terms.

Signs, specified in paragraphs 2, 3, 4, 6 of this item, may be included as elements, provided they do not have the dominative meaning in the trademark.

3. There cannot be registered trademarks which are identical, and hence cannot be distinguished from

trademarks previously registered, or applied for the registration in Ukraine on the name of other person, where they regard similar goods and services;

trademarks of other persons, provided these trademarks are legally protected without registration on the basis of the international agreements of Ukraine;

firm names known in Ukraine, and belonging to other persons, who got the right on them before the date of application was submitted to the Department regarding similar goods and services;

names of places of goods origin, except for those included into the trademark as elements, which are not protected, and registered on the name of the persons having the right to use these names;

certificate trademarks registered in the duly order.

4. According to the Law a sign, which was fairly used by 2 or more legal entities for naming similar goods up to January 1, 1992, cannot be registered as a trademark.

5. There shall not be registered as trademarks

production samples, rights on which in Ukraine belong to other persons;

names of known in Ukraine pieces of science, literature, art, or quotations, or heroes from them, pieces of art, or fragments without the agreement of copy right owners, or their legatees;

names, pseudonyms, and their derivatives, portraits of known in Ukraine persons without their agreement.

Part III. PROCEDURE FOR RECEIVING CERTIFICATE

Article 7. Application

1. Person who wants to get the certificate shall submit application to the Department.

2. On behalf of the applicant, the application may be submitted through a representative in intellectual property, or other authorized person.

3. The application shall regard one trademark.

4. The application shall be in Ukrainian, and include

application on registration of trademark;

picture of trademark under application;

list of goods and services, for which the applicant wants to register the trademark, put down in groups in accordance with the International Classification for goods and services for registration of trademarks.

5. The application shall specify the applicant's name and address.

6. Where the applicant asks for the protection of color, or a combination of colors, as a distinguishing sign of his trademark, he shall

apply on this and specify the color, or combination of colors, be protected;
provide a picture of the trademark in color in the application. The number of samples shall be specified by the Department.

7. Other requirements set up to the documents shall be established by the Department.

8. The application shall be supplemented with the document on payment of the tax for application. It shall be received by the Department within the two-month period since the date the application is submitted.

Article 8. Date of Submitting Application

1. Date of submitting the application shall be considered the date when the Department gets the materials including
application is a free form on the registration of the trademark in the Ukrainian language;

information providing a possibility to identify the applicant in Ukrainian;
a sign looking like, and may present a trademark;
information on the list of goods and services under the trademark.

2. Provided the Department considers that for the date of receiving the materials they do not meet the requirements, provided in item 1 of this article, it shall inform the applicant on that.

In order to introduce amendments to the materials there shall be given two months since the date the applicant gets the Department's notification. Provided duly amendments are introduced within this term, the date when the application was submitted shall be considered the date for the materials been received by the Department. In other case, the application shall not be considered as submitted, on which the applicant is notified.

3. The decision on setting up the date for submitting the application shall be sent by the Department to the applicant after the Department gets the payment for registration, as provided in item 8, article 7 of this Law. Where the requirements under item 8, article 7 if this Law are violated, the named decision shall not be sent, and the application is considered withdrawn.

Article 9. Priority

1. The applicant has the right for priority of application for the same trademark during six months since the date the preliminary application was submitted to the Department or the respective body of a country - participant of the Paris Convention on protection of production property, provided there is no priority claimed.

2. The priority of the trademark used in an exhibit shown at official or officially recognized international exhibitions held in the territory of a country - participant of the Paris convention, may be fixed at the date when the exhibition was opened, provided the application was sent to the Department within six months since the date specified.

3. Applicant, who would like to enjoy the right of priority, within three months since the date the application is submitted, shall submit to the Department an application on priority with reference to the date and registered number of the previous application, and also its copy translated into Ukrainian, or a document testifying to the exhibit show. Within the specified term the named materials may be changed. Where the materials are submitted untimely, the right for priority shall be considered as lost, on which the applicant is notified.

Article 10. Application Expertise

1. Application expertise shall be realized by the Department in accordance with this Law, and regulations established on its basis.

While performing the examination, the institute of expertise forwards to the applicant all memos, inquiries and conclusions. In this case the conclusions of the institute of expertise acquire the status of the decision of the Department once it is approved by the Department.

2. The applicant has the right at his own initiative, or on the request of the Department, or through his representative to take part in the consideration of questions arising during the expertise. The procedure for participation of the applicant, or his representative in the consideration of the specified questions shall be established by the Department.

3. The applicant has the right of private initiative to introduce amendments and details to the application. Amendments and supplements to the application shall not be taken into consideration, provided they come to the Department after the date of applicant's receiving the decision on the registration of a trademark, or refusal from it.

A fee is charged for submission of a request at applicant's initiative to make changes and amendments to the application, once he received a resolution on establishment of the date of submission of application.

4. Where the applicant submits additional materials, then during the process of expertise there shall be cleared out if they refer to the specified in the application list of goods and services.

Additional materials do not refer to the specified contents if they contain any features that should be included to the contents, which is considered as a trademark.

Additional materials of the part which does not refer to the contents of the trademark specified in the application submitted, or supplements the list of the applied goods and services are not considered during consideration of the application.

5. After the date of submitting the application is established, and the document on the payment of the tax is present, the Department shall carry out the expertise on formal principles, during which

the application shall be checked as to its keeping with the requirements of article 7 of this Law;

the document on payment of the tax is checked in accordance with the established requirements.

6. Where the application does not meet the requirements of article 7 of this Law, or the document on payment of the tax dose not meet the established requirements, the Department shall notify the applicant on that.

In order to introduce amendments to the materials, there shall be given two months since the date of receiving the notification from the Department. Provided this term is not observed, or the applicant does not duly ask for its extension, the Department shall forward to the applicant the decision on refusal.

7. Provided the application meet the requirements of article 7 of this Law and the document on payment of the tax is duly formed, the Department shall carry out the expertise of the application regarding its content, during which there shall be checked whether the submitted application meets the conditions for providing the legal protection.

8. During the application expertise regarding the content, the department shall have the right for receiving from the applicant additional materials required for the purpose of expertise.

The applicant has the right, within one month after receiving the request of the Department regarding some additional materials, to demand from the Department copies of the materials serving as ground for request of additional materials from him.

Additional materials shall be submitted by the applicant within two months since the date of receiving by him copies of the materials from the Department services as ground for additional materials been submitted to the Department.

Where the terms are violated, the application shall be considered cancelled.

9. For additional materials in part being beyond of the content of the application, there shall be valid the procedure set up by item 4 of this article.

10. Provided the expertise shows that the trademark meets the conditions of being under the legal protection, the Department shall send the applicant the decision on the registration of the trademark. Otherwise, the decision on refusal shall be sent to the applicant.

11. The applicant has the right to learn all the materials, specified in the decision of the Department. Copies of the materials shall be sent by the Department within one month.

12. Terms, provided by this article (except for item 8), which are missed by the applicant, may be renewed by the Department, provided there are grounded reasons for that.

Application on renewal of the term shall be in the Department within six months since the date of the missed term. The applicant is charged a tax for renewal of the term.

Article 11. Cancellation of Application

The applicant has the right to cancel the application any time before the date the decision of the registration of the trademark is taken.

Article 12. Publication on Issuing the Certificate

1. On the basis of the decision on the registration of the trademark, and with the document on the tax payment, the Department shall publish in the official bulletin the information of issuing a certificate.

The application is considered cancelled, where during three months since the date of the taken decision on the trademark, the document testifying to the fact the tax is paid is not submitted to the Department.

2. After the information on issuing the certificate for a trademark is published, every person has the right to get to know the materials concerning the application, with following the procedures established by the Department.

Article 13. Registration of Trademark

1. Along with the publication of the information on issuing the certificate the Department shall realize the state registration of the trademark, for which it shall put down the information concerned in the Register. Form of the Register and procedure for recording the information shall be set up by the Department.

2. After the information on a certificate is recorded in the Register, any person has the right to get to know with this information in keeping with the procedure established by the Department.

3. Information added to the Register can be corrected and (or) specified at the initiative of the certificate owner or the Department.

According to the established list of the possible changes the owner of the certificate can make changes to the Register at his own initiative. A tax is charged for making changes to the Register.

Article 14. Issuing the Certificate

1. The Department shall issue the certificate within one month after the state registration of the trademark. The certificate shall be given to a person who has the right for receiving it. Where the right for the certificate belongs to several persons, they shall receive one certificate.

2. The department shall establish the form of the certificate and the information contained in it.

3. The Department shall make necessary corrections in the issued certificate, on the request of its owner, with further information on that in the official bulletin.

Article 15. Appeal against Decision on Application

The applicant may appeal against a Department's decision concerning the application in the Department's Council of Appeal (hereinafter - Council of Appeal) during three months since the Department takes the decision or the copies of the requested documents are received.

Appeal against the decision of the Department concerning the application shall be considered by the Council of Appeal within four months since the date is submitted.

Based on the results of appeal consideration, the Council of Appeal takes decision which is approved by the Department and is submitted to the applicant.

Before the approval of the decision by the Council of Appeal, within a month after the date of its adoption, the Head of the Department can move an appeal against this decision, which must be considered within a month period. The decision of the Council of Appeal, taken after the appeal is ultimate and can be canceled only by the court.

The applicant may appeal against the decision of the Council of Appeal in the court within six months from the date of receiving the decision.

Part IV. RIGHTS AND DUTIES UNDER CERTIFICATE

Article 16. Rights under Certificate

1. Rights under the certificate shall be since the date of submitting the application, and under the condition the tax is paid.

2. The certificate shall give to its owner the exclusive right to use the trademark in accordance with his will.

Mutual relations while using the trademark, be certified for several persons, shall be established by the agreement between them. Where there is no such agreement, every of owners may use the trademark on his decision, but no one of them has the right for giving the permit (license) to use the trademark by other person, provided there is no agreement on that of all its owners.

Use of trademark shall mean its use for goods and services for which it was registered, in advertising, publications, posters, at exhibitions and fairs held in Ukraine, brochures, forms and other documents connected with the specified goods and services.

3. The certificate shall give to its owner the right to prevent from other persons to use the registered trademark without his permit, except for the cases, where the use of trademark is not under the regulation of this Law.

The fair use of this trademark by other persons, if they started to use it before January 1, 1992, cannot be referred to as the violation of the rights of the certificate owner, in case this certificate was received before item 4 of Article 6 of this Law entered into force.

4. The certificate owner, on the basis of the agreement, may transfer the right of property for a trademark to other person who inherits the right of property for the certificate.

The transfer of the property right for a trademark shall not be allowed, provided it may cause mislead as to goods or services, or a person who produces goods, or offers services.

5. The certificate owner has the right to give a permit (license) for the use of trademark on the basis of the license agreement.

License agreement shall contain the provision that quality of goods and services, produced or offered under the license agreement is not worse than the original goods and services, and that the original owner shall exercise control over the fulfilment of this agreement.

6. The agreement on transfer of the right of property for the trademark and the license agreement shall be valid, provided they are in written and signed by the parties. These agreements shall come into force after they are registered in the Department.

Transfer of the proprietary right to the trademark and the license agreement shall be valid for any of the parts after this information is published in the official bulletin and is added to the Register. The parts are charged a tax for adding the mentioned information and any changes related to it to the Register at their mutual initiative.

7. The certificate owner shall have the right to put, besides the trademark, a sign with the meaning that the trademark is registered in Ukraine.

8. The certificate owner who realises intermediary activities has the right on the basis of the agreement with the producer of goods or services to use, along with the latter's trademark, his trademark, or his trademark instead of the latter's one.

Article 17. Duties under Certificate

The certificate owner shall duly use his exclusive right under the certificate.

Provided the trademark is not used or hardly used in Ukraine during three years since the date of publication of the information concerned in the bulletin, or since the date when the use of the trademark was terminated, any person can apply to the court with the application on ahead-of-time termination of the certificate's validity.

While settling this question the court may take into consideration the proofs submitted by the certificate owner that the trademark was not used on not dependant on him reasons.

Part V TERMINATION OF CERTIFICATE'S VALIDITY AND ITS BEEN RECOGNIZED AS INVALID

Article 18. Termination of the Certificate's Validity

1. The certificate owner may refuse from the certificate any time completely or partially by submitting the application to the Department. The refusal shall come into force since the date of publication of the information in the Department's official bulletin.

2. The certificate's validity shall be terminated, provided the tax on the validity extension is not paid. The document on tax payment for every term of the validity extension shall be in the Department by the end of the current period of the certificate's validity.

The tax for the certificate's validity extension may be paid, but the document on the payment - be in the Department during six months after the established term expires. In this case the tax amount shall be 50% higher.

The certificate validity shall be terminated since the first day, when the tax is not paid.

3. The certificate validity shall be terminated by the court decision, where the trademark has transformed into a commonly used sign for goods and services of some type after the date the application was submitted.

Article 19. Recognising Certificate as Invalid

1. Certificate may be recognised as invalid in full or partially, where the registered trademark does not meet the conditions of the legal protection; the certificate contains element of the trademark, or list of goods and services which were not included into the application.

2. In the event the certificate or part of it is recognized invalid, the Department shall provide corresponding explanations in its official bulletin.

3. The certificate or part of it that is recognized invalid, is considered invalid from the date of receiving the application.

Part VI. PROTECTION OF RIGHTS

Article 20. Violation of Certificate's Owner's Rights

1. Any actions against the rights of the certificate's owner, contained in article 16 of this Law, shall be considered as violations of the certificate's owner's rights, which caused the responsibilities in accordance with the current legislation of Ukraine.

2. On the certificate's owner's demand such violation shall be terminated and the violator shall compensate the caused losses.

The certificate's owner may also demand removal for the violator's goods the illegally used trademark or other sign much similar to the trademark.

The same rights may be exercised by a person who received the license for the trademark from its owner, if different is not provided by the license agreement.

Article 21. Disputes Settled in Court

1. Disputes connected with the application of this Law shall be settled in court, arbitration court in keeping with the procedures, set up by the Ukrainian legislation in force.

2. Courts, within their competence, shall settle disputes on establishing the certificate's owner; concluding and fulfilment of license agreements; violations of property rights of the certificate's owner.

Courts shall settle also other disputes connected with the protection of rights, provided by this Law.

Article 22. Right for Re-Registration

Nobody, but the previous owner of the certificate shall have the right for the re-registration of the trademark, which shall be done during three years after the expiry date of the certificate in accordance with article 18 of this Law.

Part VII. FINAL PROVISIONS

Article 23. Taxes

Tax amounts and terms for issuing the certificates for the trademarks of goods and services shall be regulated by current legislation.

Funds received for issuing the certificates for the trademarks of goods and services will be used by the state budget of Ukraine.

Tax amounts pertaining to this Law, as well as terms and procedure of payment shall be established by the Cabinet of Ministers of Ukraine.

Funds received under this Law is transferred to the accounts of the institutes, authorized by the Department and comprising the state system of legal protection of intellectual property and depending on their specialization perform certain activities, established by this Law.

All earnings under this Law are target funds and according to the Decree of the Department shall be used by the Department only for the development and well functioning of the state system for legal protection of intellectual property, particularly, for performing the duties established by this Law, and other normative and legal regulations in the area of intellectual property.

Article 24. Registration of Trademark in Foreign Countries

1. Any person has the right for registration of the trademark in foreign countries.
2. During the registration of the trademark in foreign countries in accordance with the agreement on the registration of trademarks, the application shall be submitted through the Department.
3. Expenses connected with the registration of the trademark in foreign countries shall be paid by the applicant, or other person on the applicant's agreement.

President of Ukraine L.KRAVCHUK