

UKRAINE

Trademark Law

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Section I GENERAL PROVISIONS

Article 1. Definitions

In the present Law, the terms listed below shall be used in the following meaning:

"the Institution" is the central body of executive power on issues of the legal protection of intellectual property;

"person" is a natural person or legal entity;

"mark" is a sign by which goods and services of persons differ from goods and services of other persons;

"certificate" is a certificate of Ukraine of a mark for goods and services;

"registered mark" is a mark for which the relevant certificate has been issued;

"application" is a body of documents required for the issuing a certificate;

"applicant" is a person who has filed an application or has acquired the rights of an applicant pursuant to other procedure established by the law;

"priority of the application (priority)" is the precedence in the filing of the application;

"date of the priority" is the date of the filing of the application to the Institution or to a relevant body of a Member State of the Paris Convention for the Protection of Industrial Property, under which the priority has been claimed;

"Register" is the State Register of Certificates of Ukraine of Marks to Goods and Services;

"Appellate Chamber" is a collegial body of the Institution for the examination of objections to decisions of the Institution on the acquisition of rights for objects of intellectual property and on other matters covered by its competence by the present Law;

"institution of expert examination" is a State institution (enterprise, organization) authorized by the Institution to consider and conduct expert examination of applications;

"State system of the legal protection of intellectual property" is the Institution and a number of expert examination, scientific, educational, informational and other State institutions of relevant specialization that belong to the sphere of management of the Institution;

"domain name" is a name used for the addressing of computers and resources in the Internet network;

"ICGS" is International Classification of Goods and Services for the Purposes of the Registration of Marks.

Article 2. Authorities of the Institution in the Sphere of the Protection of Rights to Marks for Goods and Services

1. The Institution provides the implementation of the State policy in the sphere of the protection of rights to marks for goods and services. To this end, the Institution shall:

- organize the reception of applications, conducting expert examination thereof, and makes decisions on them;
- issues certificates of marks for goods and services and provides the State registration of certificates;
- provides the publication of official data about marks for goods and services;
- implements the international cooperation in the sphere of the legal protection of intellectual property and represents interests of Ukraine on the matters of the protection of rights to marks for goods and services in international organizations in accordance with the legislation in force;
- adopts legislative and regulatory acts within the scope of its authorities in the order established;
- organizes the informational and publishing activities in the sphere of the legal protection of intellectual property;
- organizes research works on the improvement of the legislation and on the organization of activities in the sphere of the legal protection of intellectual property;
- organizes the work on the retraining of the personnel of the State system of the legal protection of intellectual property;
- commissions institutions, which belong to the State system of the legal protection of intellectual property, in accordance with their specialization, to fulfill specific tasks determined by the present Law, the Provisions of the Institution and other legislative and regulatory acts in the sphere of the legal protection of intellectual property;
- performs other functions according to the Provisions of the Institution, approved in the order established.

2. Activity of the Institution shall be financed at the expense of funds of the State budget of Ukraine.

Article 3. International Agreements

If any international agreement of Ukraine has imposed rules other than those provided by the legislation of Ukraine on marks, the rules of international agreement shall be applied.

Article 4. Rights of Foreign and Other Persons

1. Foreign and stateless persons shall have the rights equal with the rights granted to persons of Ukraine by the present Law in accordance with international agreements of Ukraine or on the basis of the principle of reciprocity.

2. Foreign and other persons residing or having a permanent location outside Ukraine shall exercise their rights in the relations with the Institution through representatives registered under the Provisions regarding Representatives on Matters of Intellectual Property, approved by the Cabinet of Ministers of Ukraine.

Section II LEGAL PROTECTION OF MARKS

Article 5. Conditions for Granting the Legal Protection

1. The legal protection shall be granted to a mark that does not contradict the public order, principles of humanity and morality and is not subject to the grounds for the refusal of the legal protection as established by the present Law.

2. The object of a mark may be any sign or any combination of signs. Such signs may be, among other, words, including personal names, letters, numerals, pictorial elements, colors and combinations of colors, as well as any combination of such signs.

3. The right of property to a mark shall be certified by a certificate. The validity period of the certificate is 10 years from the date of filing an application to the Institution and may be extended by the Institution for 10 years each time at the request of the proprietor of the certificate, provided that the respective fee is paid under the procedure established in paragraph 2 of Article 18 of the present Law. The procedure for extending the validity period of the certificate shall be determined by the Institution.

The certificate validity shall be terminated before the expiration of the specified validity period under the conditions prescribed in Article 18 of the present Law.

4. The scope of the granted legal protection shall be defined by the image of the mark and by the list of goods and services, which were entered in the Register, and shall be certified by the certificate that contains the copy of the image of the mark entered in the Registry and the list of goods and services.

5. Any person, associations of persons, or their legal successors shall be entitled to the right to obtain a certificate in the order established by the present Law.

6. The applicant, whose application has the earlier date of the filing to the Institution, or, if the priority has been claimed, the applicant, whose application has the earlier date of priority, provided that the application is not deemed to be have been withdrawn, has not been withdrawn, or the Institution has not made a decision to refuse the registration of the mark, when the possibilities to appeal that decision have been

exhausted, shall be entitled to the right to obtain a certificate.

Article 6. Grounds for Refusal of the Legal Protection

1. According to the present Law, the legal protection shall not be granted for marks that represent or imitate:

- State armorial bearings, flags, and other State emblems, and other State symbols;
- official names of States;
- symbols and abbreviated or full names of international intergovernmental organizations;
- official signs and hallmarks indicating control and warranty, assay marks, seals;
- decorations and other distinctions of honor.

Such symbols may be included in a mark as elements that are not protected, provided that the consent of the relevant authorized body or the proprietors of the signs was obtained. The authorized body regarding the name of the State is a collegial body established by the Institution.

2. According to the present Law, the legal protection shall not be granted for marks that:

- are usually devoid of any distinctive character and have not obtained such a character as a result of their use;
- consist exclusively of signs that are commonly used as the signs of goods and services of a certain kind;
- consist exclusively of signs or data that are descriptive while using for goods and services defined in the application or with respect to them, in particular signs or data that indicate kind, quality, composition, quantity, properties, purposes, value of goods and services, the place and time of manufacturing or sale of goods or rendering of services;
- are deceptive or liable to mislead as to goods, services, or the person that produces a good or renders a service;
- consist exclusively of signs that constitute commonly used symbols and terms;
- solely reflect the form caused by the natural state of goods, or by the necessity to obtain a specific technical result, or the form that imparts a significant value to a good.

The signs mentioned in paragraphs two, three, four, five and six of this paragraph may be used in a mark as elements that are not protected if these signs are not dominative in the image of a mark.

3. Signs shall not be registered as marks if they are identical or

misleadingly similar to such an extent that they can be confused with:
- marks that were earlier registered or filed for the registration in Ukraine on behalf of another person for identical or similar goods and services;

- marks of other persons if these marks are protected without registration according to the international agreements to which Ukraine is a party, in particular the marks recognized as well-known marks according to Article 6bis of the Paris Convention for the Protection of Industrial Property;

- trade names that are known in Ukraine and belong to other persons who have acquired the right to the said names before the date of filing the applications to the Institution with respect to identical or similar goods and services;

- qualified indications of the origin of goods (including alcohols and alcohol drinks) that are protected according to the Law of Ukraine "On the Protection of Rights to Indication of the Origin of Goods"; the said signs may be used only as non-protected elements of marks of the persons who have the right to use the said indications;

- conformity marks (certification marks) that have been registered in the order established.

4. Signs shall not be registered if they reproduce:

- industrial designs, the rights to which in Ukraine belong to other persons;

- titles of scientific, literary, and artistic works known in Ukraine or quotations and characters from the said works as well as the artistic works and their fragments without the consent of copyright holders or their legal successors;

- surnames, first names, pseudonyms and their derivatives, portraits and facsimiles of persons known in Ukraine without their consent.

Section III PROCEDURE FOR OBTAINING A CERTIFICATE

Article 7. Application

1. A person who wishes to obtain a certificate shall file an application to the Institution.

2. The application may be filed, on the instructions of the applicant, via a representative on intellectual property matters or other person empowered to act for the applicant.

3. The application shall relate to one mark.

4. The application shall be submitted in Ukrainian and contain the following:

- the request for the registration of a mark;
- an image of the sign being claimed;
- a list of goods and services for that the applicant requests to register the mark which are grouped according to the ICGS.

5. In the request for the registration of the mark, the applicant(s) and his address shall be indicated.

6. If the applicant requests to protect a color or a combination of colors as a distinguishing feature of a mark, the applicant shall:

- make a declaration to this effect and specify in the request the color or combination of colors to be protected;
- present color images of the mark at issue in the request; the Institution shall specify the number of copies of such image.

7. Other requirements for application documents shall be determined by the Institution.

8. The filing of an application shall be subject to the payment of the respective fee, amount of which shall be determined with consideration to the number of the ICGS classes covered by the goods and services indicated in the application. A document confirming the payment of the fee shall be received by the Institution with the application or within two months from the date of the filing of the application. This period may be extended for no more than 6 months, provided that the relevant request is submitted before the expiration of the period and the respective fee for the filing the request has been paid.

Article 8. The Date of Filing an Application

1. The date of filing an application shall be the date when the Institution has received documents that contain at least:

- a petition drawn up in any form for registration of the mark, written in Ukrainian;
- information about the applicant and the address of the applicant, written in Ukrainian;
- a sufficiently clear image of the mark being claimed;
- a list of goods and services for which the mark is being claimed.

2. The date of filing an application shall be determined according to paragraphs 10 and 11 of Article 10 of the present Law.

3. After the date of the filing an application is determined, any person shall be entitled to the right to get familiarized with the application materials under the procedure determined by the Institution. The familiarization with the application materials is subject to the payment of the respective fee.

Article 9. Priority

1. An applicant has the right to claim the priority of a previous application on the same mark within 6 months from the date of filing the previous application to the Institution or the relevant body of a Member State of the Paris Convention for the Protection of Industrial Property, provided that the priority on the earlier application was not claimed.

2. The priority of a mark, which was used in the exhibit shown at official or officially recognized international exhibitions at the territory of a Member State of the Paris Convention for the Protection of Industrial Property, may be determined by the date of opening the exhibition provided that the Institution has received the application within 6 months from the said date.

3. An applicant who wishes to make use of the right for the priority shall file the petition for the priority, with the reference to the date of filing the previous application and the application number, and a copy of the application in Ukrainian or a document that confirms the demonstration of the mark at an exhibition within 3 months from the date of filing the application to the Institution, provided that this application has been filed or the exhibition was held in a Member State of the Paris Convention for Protection of Industrial Property. The

mentioned documents may be amended within the said period. If these documents were not submitted with the time specified, the right to the application priority shall be deemed to have been lost, of which the notification shall be sent to the applicant.

Article 10. Expert Examination of Application

1. Expert examination of an application shall have the status of scientific and technical expert examination and consists of the formal expert examination and qualification expert examination (expert examination on the merits). The expert examination shall be conducted by an institution of expert examination according to the present Law and rules, determined by the Institution on the basis of the present Law.

2. The institution of expert examination carries out informational activity necessary for expert examination of applications and acts as the center of the international exchange of publications according to the Convention concerning the International Exchange of Publications, adopted on December 3, 1958, by the General Conference of the United Nations Educational, Scientific and Cultural Organization (UNESCO).

3. The final results of the expert examination of the application that is not considered withdrawn or was not withdrawn are presented in a grounded expert's reports, which shall come into effect after its approval by the Institution. On the ground of such a report, the Institution shall make a decision on the registration of the mark for all the goods and services listed in the application or on the refusal of the registration of the mark for all the goods and services listed in the application, or on the registration of the mark for a certain part of the goods and services listed in the application and on the refusal of the registration of the mark for the remaining part of the goods and services listed in the application. The applicant shall be notified about the decision of the Institution.

The applicant shall be entitled to the right to require copies of the materials, which were opposed to the application, within a month after receiving the decision of the Institution. These copies shall be sent to the applicant within a month.

4. The applicant shall be entitled to the right, on his or her own initiative or on by invitation of the institution of expert examination, to participate personally or through his or her representative in discussion of matters arising in the course of expert examination according to the procedure

established by the Institution.

5. The applicant shall be entitled to the right to correct errors in the application, change his or her name and address, address for service and name and address of his or her representative in it as well as to make changes pertaining to a shortening of the list of goods and services. The applicant may make changes in the application that are connected with the change of the person of the applicant subject to the consent of all other applicants stated in the application. The person who wishes to be one of the applicants also may make these changes by the consent of all the other applicants.

The said corrections and changes shall be deemed to be valid, provided that they were received by an institution of expert examination no later than the document confirming the payment of the relevant State fee for granting a certificate.

A request for correction of a mistake or making of any of changes specified above is subject to the payment of the respective fee, provided that a mistake is not obvious or technical, and the change was caused by circumstances dependent on the applicant.

6. The institution of expert examination may require the applicant to submit additional materials if the expert examination is impossible without these materials or if any grounded doubts arise as to the veracity of the information or elements contained in the materials of the application. The applicant shall be entitled to the right to request copies of the materials, which were opposed to the application, within one month after receiving of the notification or conclusion of the institution of expert examination with the requirement to submit the additional materials. The additional materials shall be submitted by the applicant within 2 months from the date of the receipt of the notification or conclusion of the institution of expert examination or the copies of the materials, which were opposed to the application. The period for submitting the additional materials may be extended, but for no more than 6 months, provided that the relevant request is submitted and the fee is paid before the expiration of the said period. This term missed because of valid reasons shall be renewed provided the relevant request is submitted and the fee is paid within 6 months after its expiration. If the applicant fails to submit the additional materials within the term determined, the application shall be deemed to have been withdrawn, of which the notification shall be sent to the applicant.

7. If the applicant has submitted the additional materials, in the course of expert examination it shall be determined, whether these materials do not go beyond the scope of the substance of the sign, disclosed in the application, and the list of goods and services stated in the application. The additional materials shall be deemed to be going beyond the scope of the substance of the sign, disclosed in the application, if they contain features that shall be included to the sign that is claimed as a mark. The additional materials in the part that goes beyond the scope of the substance of the sign disclosed in the application or supplements the list of goods and services presented in the application shall not be taken into consideration in the course of the expert examination and may be filed by the applicant as an separate application after receiving the relevant notification of the institution of expert examination.

8. Any person shall be entitled to the right to submit to the institution of expert examination a grounded objection to the application in respect to the unconformity of the sign presented in the application with the requirements of granting the legal protection according to the present Law. Submission of the objection is subject to the payment of the respective fee.

The institution of expert examination shall consider the objection provided that it has been received not later than five days prior to the date of making a decision on the application. The institution of expert examination shall send the copy of the objection to the applicant.

The applicant shall be entitled the right to notify the institution of expert examination of his opinion on the objection within two months after receiving the copy of the objection. The applicant may decline the objection and leave the application unchanged, make amendments to the application, or withdraw the application.

The results of the consideration of the objection shall be presented in the decision of the Institution on the application. The copy of such a decision shall be sent to the person submitted the objection.

9. In the course of the formal expert examination:

- the date of filing an application is determined according to Article 8 of the present Law;
- the application is examined for conformity with the formal requirements of Article 7 of the present Law and the regulations issued by the Institution in compliance with the present Law;
- the document for payment of the respective fee for filing the application is examined for conformity with specified requirements.

10. If the application materials meet the requirements of Article 8 of the present Law and the document for payment of the respective fee for filing an application is presented, the applicant is notified on the determined date of filing an application.

11. If the application materials do not meet the requirements of Article 8 of the present Law, the applicant is immediately notified. If the applicant removes the nonconformity within 2 months from the date of receiving the notification, the date on which the institution of expert examination received the corrected application materials is considered to be the date of filing the application. Otherwise, the application shall be deemed to have not been filed, of which the notification shall be sent to the applicant.

12. If the application meets the requirements of Article 7 of the present Law and the fee payment document meets the specified requirements, the relevant notification shall be sent to the applicant.

13. If the requirements of Paragraph 8 of Article 7 of the present Law are not met, the application is considered withdrawn, about which the notification shall be sent to the applicant.

14. If the application does not meet the formal requirements of Article 7 of the present Law and of the regulations issued by the Institution in compliance with the present Law, or if the fee payment document does not meet the specified requirements, a notification shall be sent to the applicant with propositions to remedy irregularities.

If irregularities concern the grouping of goods and services, the notification shall contain the list of goods and services grouped by the institution of expert examination and if necessary, the amount of the additional payment for filing the application shall be indicated in this notification. When certain goods or service is presented in the application as a term, which does not provide the possibility to classify it as a certain class of ICGS, the applicant is notified accordingly with the demand to replace this term or remove it. If the applicant fails to fulfill the request, the said term would not be included to the list of goods and services grouped by the institution of expert examination.

Applicant shall remedy the irregularities indicated in the notification within the period fixed in the Paragraph 6 of this Article for additional materials.

15. In the course of the qualifying expert examination, the claimed sign shall be examined on the conformity with the conditions for granting the legal protection defined by the present Law. In this case, a database of the institution of expert examination, including the materials of applications, as well as external information sources and relevant official publications are used.

16. If there are reasons to consider that the claimed sign does not meet fully or partially the requirements for granting the legal protection, the institution of expert examination shall send to the applicant the grounded preliminary conclusion with the proposition to give a motivated answer to support the registration of mark.

The applicant shall give the answer within the period determined in Paragraph 6 of this Article for additional materials, and this answer is taken into consideration when the conclusion of the expert examination on the application is being prepared.

Article 11. Withdrawal of an Application

The applicant has the right to withdraw an application at any time before the date of paying the State fee for granting a certificate.

Article 11bis. Division of an Application

1. The applicant has the right to divide the application into two or more applications (divisional applications) by dividing the goods and services listed in the application so that each of the divisional applications shall not contain the goods and services that relate to the goods and services listed in the other divisional applications.

2. The division of the application shall be accomplished by filing the applicant's request on making relevant changes in the application and the divisional application (applications), provided that the respective fees are paid for filing the request and the application.

3. The date of filing the divisional application shall be the same as the date of filing the divided application. The priority date of the divisional application shall be the same as the priority date of the divided application if there is a reason for that.

Article 12. Publication on Granting a Certificate

On the basis of the decision on registration of a mark and provided that the documents confirming payment of the State fee for granting a certificate

and the fee for publication on granting a certificate are available, data concerning granting a certificate determined under the specified procedure, are published in the official bulletin. The applicant shall pay the said fees after the date of receiving the decision on registration of a mark. If within 3 months after the date of receiving the decision on registration of a mark the documents for the payment of fees for granting a certificate and for publication on granting a certificate in the amount and under the procedure defined by the legislation were not submitted to the institution of expert examination, the publication would not be provided, and the application would be considered withdrawn.

The period for submitting these documents may be extended for no more than 6 months provided that the relevant request is submitted and the fee in connection with the request is paid before the date of the expiration of this period. This period missed due to valid reasons shall be renewed provided that the relevant request is submitted and the fee is paid within 6 months from the expiration of this period.

Article 13. Registration of a Mark

1. At the same time with the publication of the data concerning granting a certificate, the Institution provides the State registration of a mark. For this purpose, the Institution enters the relevant data in the Register. The Institution shall determine the form of the Register and the procedure for maintaining the Register.

2. After entering the data in the Register, any person has the right to access to this information under the procedure specified by the Institution and to obtain an abstract of the data concerning a certificate from the Register upon his request, provided that the fee for submission of the said request is paid.

3. Errors in the data entered in the Register shall be corrected upon the initiative of the proprietor of the certificate or the Institution. Changes to the Register may be introduced on the initiative of the proprietor of the certificate according to the specified list of permitted changes. Introduction of changes to the Register with respect to the certificate is subject to the payment of the respective fee.

Article 14. Granting a Certificate

1. The Institution shall grant the certificate within a month from the date of the State registration of the mark. The certificate shall be granted to a person that has the right to obtain the certificate. If several persons

have the right to obtain the certificate, they shall obtain a single certificate.

2. The form of the certificate and the contents of the certificate data shall be specified by the Institution.

3. The granted certificate may be corrected by the Institution on the request of the proprietor of the certificate for removing obvious errors with the following notification in the official bulletin of the Institution.

4. If a certificate was lost or damaged, the proprietor of the certificate may be granted a duplicate of the certificate under the procedure determined by the Institution. Granting a duplicate of the certificate is subject to the payment of the respective fee.

Article 15. Appellation against the Decision on an Application

1. The applicant may appeal to the court or the Appellate Chamber against the Institution decision on the application within 2 months from the date of receiving the Institution decision or copies of documents required according to the Paragraph 3 of Article 10 of the present Law.

2. If the Institution decision on the application was appealed to the court after the State registration of the mark, the court shall consider simultaneously the issue on the validity of the relevant certificate.

3. The right to appeal the Institution decision in the Appellate Chamber would be lost after the payment of the State fee for granting a certificate.

4. The appeal against the Institution decision in the Appellate Chamber is accomplished by submitting the objection on the Institution decision under the procedure determined by the present Law and the regulations of the Appellate Chamber approved by the Institution. Submission of the objection is subject to the payment of the respective fee. If the fee is not paid within the period fixed in Paragraph 1 of this Article, the objection is considered not submitted, and the applicant is notified accordingly.

5. After receiving by the Appellate Chamber the objection and the document for payment of the fee for submitting the objection, the processing of the application shall be terminated until the decision of the Appellate

Chamber is approved.

6. The objection against the Institution decision on the application shall be considered according to the Appellate Chamber regulations within 2 months from the date of receiving the objection and the document for payment of the fee for submitting the objection, within the framework of the reasons presented in the objection by the applicant and during the discussion of the objection. The period for consideration of the objection may be extended on the initiative of the applicant, but for no more than 2 months, provided that the relevant request is submitted and the fee is paid with respect to the request.

7. On the results of the consideration of the objection, the Appellate Chamber shall make a grounded decision that shall be approved by the order of the Institution and sent to the applicant.

If the objection was fully or partially satisfied, the fee for submitting the objection would be returned to the applicant.

8. Before approving the Appellate Chamber decision, within a month from the date of making the decision, the Head of the Institution may present a grounded written protest against this decision, and this protest shall be considered within a month. The decision of the Appellate Chamber made on the protest is final and may be cancelled only by the court.

9. The applicant may appeal to the court against the Appellate Chamber decision approved by the Institution within 2 months from the date of receiving the decision.

Section IV RIGHTS AND OBLIGATIONS DERIVING FROM CERTIFICATE

Article 16. Rights Deriving from a Certificate

1. The rights deriving from a certificate are effective from the date of filing the application. The validity period of the certificate may be extended provided that the respective fee has been paid.

2. The proprietor of the certificate shall be entitled the right to use the mark and exercise other rights provided by the present Law.

3. The relationships between persons who are co-proprietors of a certificate in the use of the mark shall be defined by an agreement between them. If such agreement is not available, each proprietor of the certificate may use the mark at his or her own discretion, but none of them has the right to grant a permission (a license) for the use of the mark and to transfer the property right for the mark to another person without the consent of the other proprietor of the certificate.

4. The following shall be considered to be the use of a mark:

- applying the mark on any goods for which the mark is registered, the package containing the goods, the signboard connected with the goods, a label, tab, tag or another item attached to the goods;
- storing such a goods with the mentioned application of the mark for the following offering for selling;
- offering the goods for selling, selling, import (coming-in) and export (coming-out);
- using the mark while offering or rendering any service for which the mark is registered;
- using the mark in business documentation or in advertising, and in the Internet network.

A mark is considered to be the used one if it was presented in the form of a registered mark or in the form that differs from the registered mark only by minor elements if such a presentation does not change the features of the mark on the whole.

5. Any proprietor of a certificate has the exclusive right to prohibit without his permission, unless otherwise stated in the present Law, the use by other persons:

- the registered mark with respect to the goods and services listed in the certificate;
- the registered mark with respect to the goods and services concerning

the goods and services listed in the certificate if such a use may result in a deception in relation to the person manufacturing the goods or rendering services;

- the sign that is similar to the registered mark with respect to the goods and services listed in the certificate if the result of such a use is a risk of confusing the said sign with the mark;
- the sign that is similar to the registered mark with respect to the goods and services that are akin to those listed in the certificate if the result of such a use is a risk of the deception in relation to the person manufacturing the goods or rendering services or a confusion of the said sign with the mark.

6. The exclusive right of a proprietor of a certificate to prohibit the use of the registered mark by other persons without his permission does not extend to:

- exercising of any right acquired before the date of filing the application or, if the application priority was claimed, before the priority date;
- the use of the mark for the goods introduced into the commercial turnover under this mark by the proprietor of the certificate or by his permission, provided that the proprietor of the certificate has no essential reasons to prohibit such a use in connection with the following selling of the goods, in particular in case when the condition of goods changed or the quality of the goods lowered after its introducing into the commercial turnover;
- the non-commercial use of the mark;
- all forms of broadcasting and commentaries in news;
- conscientious use of the names or addresses by them.

7. The proprietor of the certificate may transfer, by an agreement, the property right to the mark to any person fully or with respect to certain part of the goods and services listed in the certificate.

Transfer of the property right to the mark shall not be allowed, if it may cause a deception of a consumer with respect to goods and services or to the person manufacturing goods or rendering services.

8. The proprietor of the certificate has the right to grant a permission (license) to use the mark to any person by a licensing agreement.

The licensing agreement shall contain a provision providing that the quality of goods or services manufactured or rendered according to the licensing agreement will not be lower than the quality of goods and services provided by the proprietor of the certificate, and that the proprietor

of the certificate will provide the control under the fulfillment of the said requirement.

9. An agreement for transferring the property right to the mark and a licensing agreement are valid if they were concluded in writing and signed by the contracting parties.

Each contracting party has the right to notify an indefinite circle of persons about transferring the property right to the mark or granting a license for using the mark. Such a notification is provided by publishing the information in the official bulletin of the Institution in the volume and under the procedure determined by the Institution with simultaneous entering this data in the Register.

Publication of the information about transferring the property right to the mark completely and about granting a license to use the mark as well as of the changes to the data proposed by the contracting party is subject to the payment of the respective fee.

In the case of publishing information about transferring the property right to the mark with respect to a part of the goods and services listed in the certificate, the Institution shall grant a new certificate to the person to which the said right was transferred, provided that the document for the payment of the State fee for granting a new certificate is available.

10. The proprietor of the certificate shall be entitled to the right to put a precautionary marking alongside of the mark that indicates that the mark is registered in Ukraine.

11. The proprietor of the certificate that carries out mediatory activity shall be entitled to the right to use his own mark alongside of the mark of the persons manufacturing goods or rendering services or instead of their mark on the basis of an agreement with them.

Article 17. Obligations Deriving from a Certificate

The proprietor of the certificate shall use the rights deriving from a certificate in good faith.

Section V TERMINATION OF VALIDITY AND INVALIDATION OF A CERTIFICATE

Article 18. Termination of the Certificate Validity

1. The proprietor of the certificate may at any time renounce the certificate fully or partially on the bases of a declaration submitted to the Institution. The renunciation shall be effective from the date of publishing the relevant information in the official bulletin of the Institution.

2. The certificate validity is terminated in the case of default of the payment of the fee for extending the certificate validity period. The Institution before the expiration of the current certificate validity period shall receive the document for the payment of the fee for each extension, provided that the payment was made within the last 6 months of the said period.

The fee for extension of the certificate validity period may be paid and the payment document may be submitted to the Institution within 6 months after the expiration of the specified period. In this case, the amount of the fee is increased by 50 per cent.

The certificate validity is terminated from the first day of the validity period for which the fee has not been paid.

3. The certificate validity shall be terminated by the court in connection with the transformation of the mark into a sign that became commonly used as a sign for goods and services of a certain type after the date of filing the application.

4. If a mark is not used in Ukraine fully or with respect to a part of goods and services listed in the certificate within three years from the date of publishing the information on granting the certificate or from other date after the publication, any person has the right to appeal to the court with a declaration for fully or partially pre-term termination of the certificate validity.

In this case, the certificate validity may be terminated fully or partially unless the proprietor of the certificate gives valid reasons for such a nonuse. In particular, the said valid reasons are the following:

- conditions that block the use of the mark independently of the will of the proprietor of the certificate, such as the limitation of import of goods or other requirements for goods and services that are determined by the legislation;
- the possibility of deception with respect to the person manufacturing the goods or rendering services, while the person that appealed to the

court or another person uses the mark for the goods and services in connection with which the demand for terminating the certificate validity was made. For the purposes of this Paragraph the use of the mark by other person is also considered to be the use of the mark by the proprietor of the certificate if the proprietor of the certificate provides control cover the use of the mark by the said person.

Article 19. Invalidation of Certificate

1. A certificate may be fully or partially invalidated by the court in the following cases:

- a) The registered mark does not meet the requirements for granting the legal protection.
- b) The certificate contains elements of the mark reproduction and the list of goods and services that were not presented in the filed application.
- c) The certificate was granted in the result of the filing an application with the infringements of rights of other persons.

2. If the certificate is considered to be fully or partially invalid, the Institution shall inform about it in its official bulletin.

3. The certificate or a part of the certificate that have been considered to be invalid, are considered to be those that are out of effect from the date of filing the application.

Section VI PROTECTION OF RIGHTS

Article 20. Infringement of Rights of Certificate Proprietor

1. Any offence against rights of the proprietor of a certificate that are defined in Article 16 of the present Law, including the actions that shall be agreed upon with the proprietor of the certificate but are carried out without his consent as well as a preparation for such actions, shall be considered to be an infringement of the rights of the proprietor of the certificate, which shall entail liability according to the legislation of Ukraine currently in force.

The use of the marks and designations specified in item 5 of article 16 of this Law in domain names without the certificate proprietor's consent shall be also considered an infringement of the proprietor's rights.

2. On the request of the proprietor of the certificate, the said infringement shall be terminated, and the infringer shall indemnify the actual damage to the proprietor of the certificate.

The proprietor of the certificate may also request to remove illegally used mark or sign from goods or goods package, which is so much similar to the mark that the mark and the sign may be confused, or to liquidate the produced reproductions of the said mark or the sign, which is so much similar to it that they may be confused.

The person who was granted a license shall be also entitled to the right to require the restoration of the affected rights of the proprietor of the certificate by the certificate owner consent.

Article 21. Methods of Protecting Rights

1. The protection of rights to a mark is provided in courts or under other procedure determined by the legislation.

2. The jurisdiction of courts covers all legal relations arising in connection with the use of the present Law.

The courts, according to their competence, shall resolve disputes regarding:

- determination of the certificate owner;
- conclusion and execution of licensing agreements;
- infringement of the certificate owner rights.

Article 22. Right to Re-Registration

No person, but the previous owner of the certificate has the right to re-registration of the mark within three years after the date of termination

of the certificate validity in accordance with Paragraph 1 - 3 of Article 18 of the present Law.

Section VII FINAL PROVISIONS

Article 23. Fees

The amount of, and the procedure for paying the State fee for granting certificates of marks for goods and services are determined according to the legislation.

The costs obtained from the payments of the State fee for granting certificates of marks for goods and services are included to the State Budget of Ukraine.

The amounts, payment terms, and the procedure for the payment of fees shall be determined by the Cabinet of Ministers of Ukraine.

The fees provided by the present Law shall be paid to current accounts of the institutions authorized by the Institution and included to the State system of the legal protection of intellectual property and, with consideration of their specialization, carry out individual tasks defined by the present Law.

The earnings from the fees provided by the present Law are purpose-oriented and, according to the orders of the Institution, shall be used solely for the provision of the development and operation of the State system of the legal protection of intellectual property, in particular for implementing tasks defined by the present Law and other normative and legislative acts in the sphere of intellectual property.

Article 24. Registration of Mark in Foreign States

1. Any person has the right to register a mark in foreign States.
2. In the case of registration of a mark in foreign States according to the Madrid Agreement on International Registration of Marks or the Protocol to the Madrid Agreement on International Registration of Marks, the application for the international registration as well as the relevant declarations on the territorial extension of the international registration shall be filed via the Institution, provided that the respective national fee is paid for filing each declaration.
3. The applicant or another person by the agreement with the applicant shall pay expenses with respect to the international registration of a mark in foreign States.

Article 25. Protection of Rights to a Well-Known Mark

1. The protection of rights to a well-known mark is provided according to Article 6bis of the Paris Convention for the Protection of Industrial

Property and the present Law and is based on the recognition of the mark as a well-known mark by the Appellate Chamber or the court. The mark can be recognized as well-known irrespective of its registration in Ukraine.

2. While determining whether a mark is a well-known mark in Ukraine, the following factors may be considered if they are applicable:

- the degree of the reputation and recognition of a mark in the relevant public sector;
- the duration, volume, or geographical area of any use of the mark;
- the duration, volume, or geographical area of any propagation of the mark, including advertising, offering to public, and display at exhibitions of goods and/or services with respect to which the mark is used;
- the duration, volume, or geographical area of any mark registration and/or applications for the registration of the mark, provided that the mark is used or recognized;
- evidences of the successful protection of rights to the mark, in particular the territory where the mark is recognized as a well-known mark by authorized organizations;
- the value associated with the mark.

3. The procedure for recognizing the mark as a well-known mark by the Appellate Chamber in Ukraine shall be determined by the Institution. Submission of the request for recognizing the mark as a well-known mark is subject to the payment of the respective fee. The decision of the Appellate Chamber on the recognition of the mark as a well-known mark in Ukraine may be protested in the Court.

4. The mark is protected in the same way as if the mark was filed for registration in Ukraine from the date, from which the mark is recognized as a well-known mark in Ukraine by the decision of the Appellate Chamber or the court. The protection extends also to the goods and services that are not kindred to the goods and services for which the mark is recognized as a well-known mark in Ukraine provided that the use of the mark by another person with respect to such goods and services will be indicating a connection between the latter and the owner of the well-known mark, and his or her interests are likely to be damaged due to such a use.