

**UKRAINE**

**Trademark Law**

On Protection of Rights to Trademarks for Goods and Services

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## **Section I GENERAL PROVISIONS**

### **Article 1. Definition of Terms and Abbreviations**

1. For the purposes of this Law, the following definitions shall apply:

National Intellectual Property Office (hereinafter NIPO) means a state organisation that is part of the state system of the legal protection of intellectual property, defined at the national level by the Cabinet of Ministers of Ukraine, exercising powers in the field of intellectual property, defined by this Law, other laws in the field of intellectual property, acts of the central executive authority in charge of shaping and implementing state policy in the field of intellectual property, and the charter, and has the right to represent Ukraine in international and regional organisations;

person is an individual or a legal entity;

trademark means a sign according to which the goods and services of some persons are distinguished from the goods and services of other persons;

certificate means a trademark certificate of Ukraine;

registered trademark means a trademark for which a certificate has been issued or which has the international registration valid within the territory of Ukraine;

application means a set of documents required for issuing a certificate;

applicant is a person who has filed an application or acquired the rights of an applicant under another procedure established by law;

priority of an application (priority) is the priority in submitting the application;

priority date means the date of submission of the preliminary application to NIPO or the relevant authority of a state being a party to the Paris Convention for the Protection of Industrial Property or the Agreement Establishing the World Trade Organisation, on which a priority claim is based;

Register means the State Register of Certificates of Ukraine for Trademarks maintained electronically;

Appeals Chamber is a collegiate body of the NIPO for consideration of objections against NIPO decisions on acquisition of intellectual property rights, statements of invalidation of intellectual property rights in whole or in part, statements of recognising a trademark well known in Ukraine and consideration of other issues within its competence under this Law, other laws and regulations of Ukraine;

state system of legal protection of intellectual property is the central executive authority in charge of shaping and implementing state policy in the field of intellectual property, NIPO and a system of scientific, educational, informational, and other state enterprises, institutions, organisations of relevant specialisation that are managed by the central executive authority in charge of forming and implementing state policy in the field of intellectual property;

domain name means a name used for addressing computers and resources on the Internet;

Nice Classification means the International Classification of Goods and Services for the Purposes of the Registration of Marks;

Attestation commission is the NIPO collegiate body, the main purpose of which is to undertake a performance review of persons who have shown their intention to acquire the right to engage in the activities of a representative in intellectual property cases (patent attorney);

Appeals Commission is the NIPO collegiate body, the main purpose of which is to consider complaints of candidates for representatives in intellectual property cases (patent attorneys) against decisions of the Attestation commission and to consider complaints against the actions of intellectual property representatives (patent attorneys);

Application Database means a database maintained electronically, which contains information on applications and their current processing as determined by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property, is open and viewable by any person on the official NIPO's website;

Bulletin is the official electronic bulletin of NIPO;

WIPO is the World Intellectual Property Organisation;

collective trademark means a sign which serves to distinguish the goods and services of members of the association, which means any association irrespective of its organisational and legal form and composition and the existence of which does not contradict the legislation of the state where it has been created, from the goods and services of other persons;

international registration means the international registration of a trademark made in compliance with the Madrid Agreement Concerning the International Registration of Marks and/or the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks;

Paris Convention means the Paris Convention for the Protection of Industrial Property of 20 March 1883.

**Article 2. Powers of the Central Executive Authority in Charge of Forming and Implementing State Policy in the Field of Intellectual Property**

1. Powers of the central executive authority in charge of forming and implementing state policy in the field of intellectual property, shall include:

ensuring legal regulation in the field of protection of rights to trademarks for goods and services;

determination of development priorities in the field of protection of rights to trademarks for goods and services;

interaction and coordination with central executive authorities, other government bodies when forming and implementing state policy in the field of intellectual property, as well as with a view to strengthening the protection of intellectual property rights;

development of proposals to improve legislation in the field of intellectual property legal protection;

international co-operation in the field of legal protection of intellectual property and representation of Ukraine's interests in the protection of rights to trademarks for goods and services in international organisations;

conclusion of international treaties on cooperation in the field of legal protection of intellectual property in accordance with the law;

ensuring the implementation of international programmes and projects in the field of legal protection of intellectual property in accordance with international treaties;

ensuring the fulfilment of obligations arising from Ukraine's membership in international organisations in the field of intellectual property legal protection;

interaction with the relevant authorities of foreign states and international organisations in accordance with the established procedure;

approval of provisions on representatives in intellectual property cases (patent attorneys), on the Attestation Commission of NIPO and the procedure for performance review of representatives in intellectual property cases (patent attorneys), on the Appeals Commission, on the State Register of Representatives in Intellectual Property Cases (patent attorneys);

coordination of NIPO activities in the field of intellectual property;  
exercising control over the NIPO observance of the legislation in the field of intellectual property, use of proceeds from the collection of fees for actions related to the protection of intellectual property rights.

2. The central executive authority in charge of forming and implementing state policy in the field of intellectual property shall exercise other powers under the law.

**Article 2-1. Powers of the National Intellectual Property Office (NIPO) in the Field of Protection of Rights to Trademarks for Goods and Services (Trademarks)**

1. The functions of NIPO shall be performed by a legal entity of public law (state organisation), formed by the central executive authority in charge of forming and implementing state policy in the field of intellectual property, and determined by the Cabinet of Ministers of Ukraine.

2. The powers delegated to NIPO shall include:  
receipt of applications, their examination, decision-making on them;  
issuance of certificates for trademarks, state registration of trademarks;  
publication of official information on trademarks and filed applications for trademarks in the Bulletin, maintenance of the Register and Application Database, entry of data into the Register, provision of extracts and abstracts in electronic and/or paper form;  
international co-operation in the field of legal protection of intellectual property and representation of Ukraine's interests in the protection of rights to trademarks at the World Intellectual Property Organisation and international organisations in accordance with the law;  
training, performance review and registration of representatives in intellectual property cases (patent attorneys);  
maintenance of the State Register of Representatives in Intellectual Property Cases (patent attorneys);  
informing and giving explanations on implementation of state policy in the field of protection of rights to trademarks.

3. NIPO also shall:

perform functions of the "National Office" provided for under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks;

conduct informational and publishing activities in the field of legal protection of intellectual property;

generalise national and international practice in the application of legislation in the field of protection of rights to trademarks, develop proposals to improve legislation in this field and submit such proposals to the central executive authority in charge of shaping and implementing state policy in the field of intellectual property;

approve guidelines for the examination of applications and state registration of rights to trademarks;

arrange training, retraining, and professional development of personnel of the state system for legal protection of intellectual property;

conduct other functions and powers provided by this Law, other laws and regulations of Ukraine, the charter.

NIPO shall have the right to receive from ministries, other central and local executive bodies, and local self-government bodies the information, documents, and materials necessary to perform the powers and functions assigned to it free of charge.

4. NIPO acts on the basis of this Law, other laws, acts of the central executive authority in charge of shaping and implementing state policy in the field of intellectual property, and the charter approved by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property.

5. The head of NIPO shall be authorised to sign title documents to ensure the implementation of delegated powers by NIPO.

6. The authority shall conduct scientific research, engage experts and consultants to prepare recommendations on matters falling within the competence of NIPO.

7. NIPO shall be chaired by the head, who is appointed and dismissed by the central executive authority in charge of forming and implementing state policy in the field of intellectual property.

The head of NIPO may be a citizen of Ukraine who has lived in Ukraine for the last five years, is fluent in the national language, fluent in one of the official languages of the World Intellectual Property Organisation (WIPO), has a university degree in law and/or intellectual property, work experience in the field of intellectual property for at least 10 years and experience in management positions for at least five years.

The head of NIPO may not be a person who, in accordance with a court decision, is deprived of the right to bring about activities related to the performance of state functions or hold relevant positions, and has been subject to administrative penalties for corruption or corruption-related offences within three years following the day when the court judgment takes effect.

The head of NIPO is appointed subject to the results of an open competition conducted by the central executive authority in charge of forming and implementing state policy in the field of intellectual property, in accordance with the established procedure for competitive selection of heads of business entities in the public sector.

The head of NIPO shall have one principal deputy and two deputies, who are appointed to the position by the central executive authority in charge of forming and implementing state policy in the field of intellectual property, at the request of the head of NIPO.

8. The Supervisory Board is the supervisory body of NIPO and shall be composed of:

- two representatives of the Verkhovna Rada of Ukraine;
- two representatives of the central executive authority in charge of forming and implementing state policy in the field of intellectual property;
- one representative of the central executive authority in charge of forming and implementing state policy in the fields of science and education;
- one representative of public organisations of intellectual property representatives (patent attorneys);
- one representative of the National Academy of Sciences of Ukraine.

The Supervisory Board may consist of two representatives of international and/or regional intellectual property organisations with an advisory voting right.

The personal composition of the Supervisory Board shall be approved by the central executive authority in charge of forming and



implementing state policy in the field of intellectual property. Members of the Supervisory Board shall perform their duties on a pro bono basis.

The Head of the Supervisory Board and his/her deputies shall be elected by members of the Supervisory Board from among them. The Head of the Supervisory Board may not be a representative of the central executive authority in charge of forming and implementing state policy in the field of intellectual property.

Powers of the Supervisory Board shall include the supervision of financial and economic activities of NIPO, budget execution, the use of funds generated from the proceeds from the collection of fees for actions related to the protection of intellectual property rights.

Supervisory Board shall be entitled to:

request any information from NIPO, except for restricted information, and obtain such information;

hear reports of the head of NIPO on the state of implementing powers by NIPO, on the conduct of financial and economic activities, budget execution, use of funds generated from the proceeds of collecting fees for actions related to the protection of intellectual property rights, as well as the plan of NIPO's activities;

submit recommendations to NIPO that are mandatory for consideration; inform the central authority in charge of forming and implementing state policy in the field of intellectual property, about identified violations.

The term of office of members of the Supervisory Board, except for the head, is two years and may be extended for no more than one term. Upon expiration of the term of office of a member of the Supervisory Board, the relevant body or organisation that delegated the member shall, within one month, delegate a new representative to the Supervisory Board or decide on extending the term of office of a member of the Supervisory Board.

The powers of the Supervisory Board member may be terminated before maturity at the request of the body that delegated him. The powers of a member of the Supervisory Board shall be also terminated at the initiative of the Supervisory Board in the case of:

submission of application for termination of powers at the member's request;

inability to perform the duties due to health issues;

termination of relations with the body delegating the member;

entry into force of a court verdict against such member;

death or based of a court decision recognising the member incapable,

of diminished legal capacity, missing or declared dead; application of administrative penalties for corruption or corruption-related offences.

The body that delegated a member of the Supervisory Board whose powers have been terminated before maturity shall be obliged to delegate a new representative to the supervisory board within one month from the date of early termination of the powers of the previous representative.

The Supervisory Board shall operate in accordance with this Law and the regulations on the Supervisory Board approved by the central executive authority in charge of forming and implementing state policy in the field of intellectual property.

The form of work of the Supervisory Board is a meeting, based on the results of which the protocol is drawn up, a copy of which is sent to NIPO and the central executive authority in charge of forming and implementing state policy in the field of intellectual property. The meeting of the Supervisory Board shall be considered valid if simple majority of the members of the Supervisory Board are present.

The placement and organisational and material support of the Supervisory Board shall be provided by NIPO.

9. NIPO shall annually publish financial statements, in particular annual financial statements, audit reports on annual financial statements, the report on its activities, including budget execution, and the budget for the following year on its official website.

Financial or consolidated financial statements of NIPO shall be subject to audit, which is carried out based on the decision of the central executive authority in charge of forming and implementing state policy in the field of intellectual property.

10. NIPO shall not have a purpose of making a profit from its activities. Funding of NIPO activities shall be provided from the proceeds from the collection of fees for actions related to the protection of intellectual property rights, as well as from other sources not prohibited by law.

NIPO shall procure goods, works and services in the manner and using the procedures established by the Law of Ukraine "On Public Procurement".

11. A qualified electronic signature may be used on documents

accepted or approved by NIPO in accordance with this Law. Submission of documents in the electronic form to NIPO and issuance of documents in electronic form shall be carried out in accordance with the legislation in the field of electronic documents and electronic document management, electronic trust services, this Law and rules established by the central executive authority in charge of forming and implementing state policy in the field of intellectual property.

**Article 2-2. Guarantees of Independence of the Appeals Chamber and Experts of the National Intellectual Property Office**

1. The activities of the Appeals Chamber shall be based on the principles of legitimacy, impartiality, independence, transparency, reliability, collegiality and qualified staffing.

2. The main principles for considering objections and applications by the Appeals Chamber shall be the rule of law, legitimacy, equality of participants in the consideration before the law and the Appeals Chamber.

3. The powers of the Appeals Chamber, the requirements for its members, the procedure for consideration of objections against NIPO's decisions on acquisition of intellectual property rights by the Appeals Chamber, the procedure for organisational and technical support for activities of the Appeals Chamber and resolution of other issues falling within its competence shall be determined by the Rules of Procedure of the Appeals Chamber approved by the central executive authority in charge of forming and implementing state policy in the field of intellectual property.

4. Independence of a NIPO experts and correctness of their opinion shall be ensured by: compliance with the procedure established by law for the appointment and conduct of expert examination; prohibition of interference in the expert examination process by anyone; creation of conditions necessary for the activities of the NIPO's experts, their financial, social, and other support; ensuring the possibility for the Appeals Chamber to review the conclusions of the expert examination; ensuring the possibility of the applicant and third parties to participate in the expert appraisal in the cases prescribed by law.

**Article 2-3. Attestation Commission**

1. Attestation Commission is a NIPO collegiate body, which is established with the purpose of determining the level of professional training of persons who have shown their intention to acquire the right to engage in the activities of a representative in intellectual property cases (patent attorney);

2. Attestation Commission shall consist of employees of the NIPO, the central executive authority in charge of forming and implementing state policy in the field of intellectual property, and representatives in cases of intellectual property (patent attorneys) who have at least 10 years of practical experience in the field of legal protection of intellectual property.

3. The powers of the Attestation Commission, its composition, formation procedure, requirements for its members, term of office as well as rules and procedures of its activities shall be determined by the central executive authority in charge of forming and implementing state policy in the field of intellectual property.

4. The Attestation Commission shall act on the basis of this Law and the regulation approved by the central executive authority in charge of forming and implementing state policy in the field of intellectual property.

**Article 2-4. Appeals Commission**

1. Appeals Commission is the NIPO collegiate body, the main purpose of which is to consider complaints of candidates for representatives in intellectual property cases (patent attorneys) against decisions of the Attestation commission and to consider complaints against the actions of intellectual property representatives (patent attorneys), as well as to control that the patent attorneys meet the requirements of the legislation.

2. The Appeals Commission shall consist of employees of the NIPO, the central executive authority in charge of forming and implementing state policy in the field of intellectual property, prominent scientists working in the field of intellectual property, and representatives in cases of intellectual property (patent attorneys) who have practical experience in the field of legal protection of intellectual property for at least 10 years.

3. The powers of the Appeals Commission, its composition, formation procedure, requirements for its members, term of office, as well as rules and procedures of its activities shall be determined by the central executive authority in charge of forming and implementing state policy in the field of intellectual property.

4. The Appeals Commission shall act on the basis of this Law and the regulation approved by the central executive authority in charge of forming and implementing state policy in the field of intellectual property.

### **Article 3. International Treaties**

If an international treaty of Ukraine ratified by the Verkhovna Rada of Ukraine establishes rules other than those provided for by the legislation of Ukraine on trademarks, the rules of the international treaty shall apply.

### **Article 4. Rights and Obligations of Foreigners and Other Persons**

1. Foreigners and stateless persons shall have the same rights and obligations as persons of Ukraine provided by this Law in accordance with international treaties of Ukraine ratified by the Verkhovna Rada of Ukraine.

2. Foreigners, stateless persons, foreign legal entities, and other persons residing or having a permanent location outside Ukraine, shall exercise their rights in relations with NIPO through representatives in intellectual property cases (patent attorneys) registered in accordance with the provision approved by the central executive authority in charge of forming and implementing state policy in the field of intellectual property.

## **Section II LEGAL PROTECTION OF TRADEMARKS**

### **Article 5. Conditions of Granting Legal Protection**

1. The legal protection shall be granted to a trademark that is not contrary to the public order and generally accepted principles of morality, requirements of the Law of Ukraine "On Condemnation of the Communist and National-Socialist (Nazi) Totalitarian Regimes in Ukraine and Prohibition of Propaganda of Their Symbols" and is not subject to grounds for refusal of legal protection defined by this Law.

2. Any sign or any combination of signs may be the subject of a trademark. Such signs may be, in particular, words, including personal names, letters, numerals, figurative elements, colours, the shape of goods or their packaging, sounds, provided that such signs are suitable to distinguish the goods or services of one person from the goods or services of other persons, are appropriate for their reproduction in the Register in such a way as to enable clear and precise scope of the granted legal protection. The names or pseudonyms of persons who held leading positions in the Communist Party (the position of a Secretary for the District Committee and above), in the highest agencies of the state power and administration of the USSR, the Ukrainian Soviet Socialist Republic (Ukrainian Socialist Soviet Republic), other union or autonomous Soviet republics (except cases related to the development of the Ukrainian science and culture), who worked in the Soviet state security agencies, the names of the USSR, the Ukrainian Soviet Socialist Republic (Ukrainian Socialist Soviet Republic), other Soviet Union republics and their derivatives, names connected with the activities of the Communist Party, the establishment of the Soviet power in the territory of Ukraine or in the separate administrative and territorial units, persecution of the participants in the struggle for independence of Ukraine in the XX century shall not be the subject of a trademark.

3. The acquisition of the right to a trademark shall be certified by a certificate. The validity period of a certificate shall be ten years from the date of submitting an application to NIPO and may be extended by NIPO at the request of the certificate holder every ten years, provided that the fee is paid under the procedure established by clause 2, Article 18 of this Law. The procedure for extending the

validity period of the certificate shall be determined by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property.

The certificate shall be earlier terminated under the conditions established in Article 18 of this Law.

The acquisition of rights to a trademark that has the international registration or is recognised to be well known in Ukraine, shall not require certification.

4. The scope of the granted legal protection shall be defined by the reproduction of a trademark and the list of goods and services entered into the Register and shall be certified by the certificate with a copy of the reproduction of the trademark entered into the Register and the list of goods and services.

5. Any person, association of persons or their successors shall have the right to obtain a certificate in accordance with the procedure established by this Law.

6. An applicant whose application has the earlier date of submission to NIPO or, if the application priority or earlier priority date has been claimed, shall have the right to obtain a certificate, provided that the application is not considered withdrawn, was not withdrawn, or NIPO did not take a decision to refuse a trademark registration where the possibilities to appeal such a decision are exhausted.

#### **Article 6. Grounds for Refusal of Legal Protection**

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

state emblems, flags and other state symbols (emblems);

full or abbreviated official names of states or international two-letter codes of states;

emblems, abbreviated or full names of international intergovernmental organisations;

official control, guarantee or testing seals, stamps;

decorations and other honourable distinctions.

Such signs may be included as non-protected elements of a trademark, provided that there is the consent of the relevant competent authority or their owners. The competent authority for granting permission to use the official name and international two-letter

code of the state of Ukraine in a trademark shall be a collegial body established by NIPO.

2. According to this Law, the legal protection shall not be granted for signs which:

do not usually have distinctive character and have not obtained it through their use;

consist only of signs that are generally used in the modern language or in fair and constant trade practices on goods and services;

consist only of signs or data which are descriptive when being used in terms of goods and services referred to in the application or due to them, show the type, quality, composition, quantity, properties, intended purpose, value of goods and services, geographical origin, the place and time of production or selling of goods or provision of services, or other specifications of goods or services;

may mislead with regard to the goods or services, namely, as to their properties, quality or geographical origin;

may mislead with regard to the person manufacturing goods or providing services;

consist exclusively of signs that are commonly used symbols and terms;

represent only the form imposed by the nature of goods or by the necessity to obtain a technical result, or by the form which gives substantial value to goods;

reproduce the name of a plant variety registered or applied for registration in Ukraine or which has been granted legal protection in accordance with an international treaty of Ukraine before the date of submitting an application for a trademark containing such a sign, and if the claimed sign concerns a plant variety of the same or related species;

contain geographical indications (including for alcohol and alcoholic beverages) registered or applied for registration in Ukraine, or which are granted legal protection in compliance with the relevant international treaty of Ukraine, prior to the date of submitting an application for a trademark which contains such an indication, and if the priority has been claimed - prior to the date of priority for the identical or related goods, if when using the sign applied for reputation of a geographical indication is used and/or the sign applied for misleads the public as to the special quality, characteristics and true origin of the product.



The signs specified in paragraphs 2, 3, 4, 7 and 8 of this clause may be included in a trademark as non-protected elements in the event that these signs are not dominative in the image of the trademark.

The signs specified in paragraphs 2, 3, 4, 7 and 8 of this clause may be granted legal protection in the event that they have acquired distinctive character as a result of their use prior to the date of application.

3. Signs shall not be registered as trademarks when as of the date of submitting an application or, if the priority is claimed, as of the date of priority, they are identical or similar to such an extent that they may be confused, in particular, associated with: trademarks that were earlier registered or submitted for the registration in Ukraine in the name of another person for identical or related goods and services; trademarks of other persons if such trademarks are protected without registration within the territory of Ukraine on the basis of the international treaties of Ukraine, namely, the trademarks recognised as well-known in compliance with Article 6bis of the Paris Convention for identical or related goods and services; trademarks of other persons, if such trademarks are protected without registration within the territory of Ukraine on the basis of the international treaties of Ukraine, namely, the trademarks recognised as well-known in compliance with Article 6bis of the Paris Convention for non-related goods and services, if the use of a trademark by another person in regard to such non-related goods and services indicates the connection between them and the owner of a well-known trademark and may harm the interests of such owner; trade names that are known in Ukraine and belong to other persons who have acquired the right to them before the date of submitting the application to NIPO regarding identical or related goods and services; conformity marks (certification marks) registered in accordance with the established procedure; trademarks used by another person in a foreign state, if an application is submitted on his own behalf by an agent or a representative of such person within the meaning of Article 6septies of the Paris Convention without such person's authorisation and there are no proofs that justify such submission if there is an objection by such person.

4. Signs shall not be registered as trademarks if they reproduce: industrial designs, the rights to which belong to other persons in Ukraine;

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

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

5. Signs that contradict the requirements of part 2, Article 5 of this Law and the Law of Ukraine "On Condemnation of the Communist and National-Socialist (Nazi) Totalitarian Regimes in Ukraine and Prohibition of Propaganda of Their Symbols" shall not be granted legal protection and shall not be registered as trademarks.

6. Signs specified in paragraphs 2 to 5 and 7, clause 3 of Article 6 and paragraph 2, clause 4 of this Article may be registered as trademarks, if the consent is given by a certificate holder of the earlier registered trademark or the holder of the other earlier acquired right and there is no possibility to mislead the consumers.

### **Section III PROCEDURE FOR OBTAINING A TRADEMARK CERTIFICATE**

#### **Article 7. Application**

1. A person willing to obtain a certificate shall submit an application to NIPO.

The application may be submitted in paper or electronic form. The applicant shall choose the method of submitting the application. Applications submitted in electronic form shall be subject to electronic record keeping in accordance with the legislation in the field of electronic documents and electronic document management, this Law and the rules established based on them by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property. Applications in electronic form shall be submitted provided that the applicant (representative in intellectual property cases or other authorised person of the applicant) is identified by using a qualified electronic signature.

2. The application may be submitted via a representative in intellectual property cases or other authorised person on behalf of the applicant.

3. An application shall relate to one trademark.

4. The application shall be drawn up in the Ukrainian language and shall contain:

a request for registration of a trademark;

an image of the sign that is applied for;

a list of goods and services for which a trademark is claimed by an applicant that are grouped according to the Nice Classification.

5. The applicant(s) and his address shall be indicated in a request for a trademark registration.

A relevant checkmark shall be made in a request for a collective trademark registration together with the indication of the list of persons entitled to use such trademark. The request for registration of a collective trademark shall also be accompanied by the document that sets out the terms of its use.

6. If an applicant claims protection of a colour or combination of colours as a distinctive feature of a trademark, he shall be obliged

to:

make a request thereof and indicate the colour or combination of colours to be protected in the application;  
provide colour reproductions of the specified trademark in the application. The number of copies of such reproductions shall be established by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property;  
provide examples of using the trademark, if the sign applied for is a colour as such.

7. The application shall be drawn up and submitted following the rules established by the central executive authority in charge of forming and implementing state policy in the field of intellectual property.

8. A fee shall be levied for submitting an application. Its amount shall be determined taking into account the number of applicants and Nice Classification classes covering goods and services indicated in the application, as well as the peculiarities of the sign applied for. The specified fee shall be paid before the day of expiry of two months upon the date of submitting the application. This period may be extended but for no more than six months, provided that the relevant request is submitted and the respective fee for its submission has been paid prior to the expiration of this period.

#### **Article 8. Application Submission Date**

1. The date of submitting the application shall be the date when the NIPO receives materials containing at least:  
a request for a trademark registration in any form, set forth in the Ukrainian language;  
information about the applicant and his address set forth in the Ukrainian language;  
a sufficiently clear image of the sign that is applied for;  
a list of goods and services for which the trademark is applied for, set forth in the Ukrainian language.

2. The date of submitting an application shall be established by clauses 10 and 11, Article 10 of this Law.

#### **Article 9. Priority**

1. An applicant shall have the right to the priority of a

preliminary application for the same trademark related to the same goods and services or those covered by the list of goods and services specified in the preliminary application, within six months from the date of submission of the preliminary application to NIPO or the relevant authority of a state being a party to the Paris Convention or the Agreement Establishing the World Trade Organisation, provided that there is no priority claimed in respect of the preliminary application.

2. The priority of a trademark used in an exhibit, presented at official or officially recognised international exhibitions within the territory of a state being a party to the Paris Convention or the Agreement Establishing the World Trade Organisation, may be determined by the date of the first public display of the exhibit at the exhibition, where the trademark applied for was used or presented, provided that NIPO received an application within six months from the specified date.

3. An applicant willing to use the priority right, during three months from the date of submitting an application to NIPO, shall submit a priority request with reference to the date of submission and number of a preliminary application along with the copy thereof with the Ukrainian translation or the document confirming the trademark presentation at the exhibition, provided that this application was submitted, or such display was held within the territory of a state being a party to the Paris Convention or the Agreement Establishing the World Trade Organisation. During this period, the specified materials may be amended. If these materials are not submitted in time, the priority right of the application shall be lost, and the applicant shall be notified whereof.

#### **Article 10. Examination of the Application**

1. Expert appraisal of an application consists of the formal expert appraisal and qualification expert appraisal (substantive expert appraisal) and shall be carried out by NIPO according to this Law and rules established in line with this Law by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property.

2. The NIPO shall exercise the information activity needed for the proceeding expert appraisal of applications and is a centre for

international exchange of publications in accordance with the Convention concerning the Exchange of Official Publications adopted on 3 December 1958 by the General Conference of the United Nations Educational, Scientific and Cultural Organisation.

3. The final results of the expert appraisal of an application that is not considered to be withdrawn or is not withdrawn or of a trademark under the international registration shall be presented in the reasonable conclusion of the expert appraisal which enters into force on the day of its approval by NIPO.

Based on such conclusion on the application, NIPO shall make a decision to register the trademark for all goods and services specified in the application or refuse to register the trademark for all the goods and services specified in the application, or register the trademark for some goods and services specified in the application and refuse to register the trademark for another part of goods and services specified in the application. The decision of NIPO on the application shall be sent to the applicant.

After the expert appraisal conclusion on a trademark under the international registration is approved, NIPO shall make a decision to grant or refuse legal protection to the trademark under the international registration in Ukraine for all specified goods and services or grant legal protection to the trademark under the international registration in Ukraine for some of specified goods and services.

A request for legal protection to a trademark under the international registration in Ukraine shall be sent to the International Bureau of WIPO.

If upon approval of the expert appraisal conclusion on the trademark under the international registration NIPO has made a decision to refuse legal protection to the trademark under the international registration in Ukraine for all specified goods and services or grant legal protection to the trademark for some of specified goods and services, a relevant request shall be sent to the International Bureau of WIPO.

The applicant has the right to request copies of the materials, which were opposed to the relevant application, within one month from the date of receiving the decision by NIPO. For the holder of the international registration, such term shall be two months from the date of sending the request to refuse granting legal protection to the trademark under the international registration in Ukraine for

all specified goods and services or grant legal protection to the trademark for some of specified goods and services to the International Bureau of WIPO by NIPO.

The specified copies shall be sent to the applicant or the holder of the international registration respectively within one month.

4. The applicant shall have the right on the own initiative or on invitation from the NIPO to take part personally or through the representative in the consideration of issues that have arisen during the examination by the procedure established by the central executive authority in charge of forming and implementing state policy in the field of intellectual property.

5. The applicant shall have the right to correct mistakes in the application and introduce changes to his name (denomination) and address, correspondence address, name and address of his representative as well as to make changes on narrowing the list of goods and services.

The applicant may make changes to the application associated with change of the person of the applicant on condition of consent thereto of other applicants indicated in the application. Such changes may be introduced also by a person who wishes to become an applicant with consent of all applicants.

These corrections and changes shall be taken into consideration, provided that they were received by NIPO not later than the document on payment of the state duty for certificate issuance.

Fee shall be charged for the filing of a request for correction of a mistake or making the above indicated changes on condition that the mistake is not obvious or technical and the change has arisen through circumstances depending on the person that submits the request.

6. The NIPO may request from the applicant submission of additional materials if examination is impossible without them or in the event of appearance of well-founded doubts about credibility of any data or elements contained in materials of the application.

The applicant shall have the right to submit additional materials to request from the NIPO copies of materials presented against the application within a month from the date of receipt of the notification or conclusion of the examination with a request. Additional materials shall be submitted by the applicant within 2

months from the date of receipt by him of the notification or conclusion of the expert appraisal or copies of materials presented against the application. If the applicant fails to submit additional materials within the specified term, the application shall be considered withdrawn, and the applicant shall be notified thereof. The period for filing additional materials shall be extended, but for not more than 6 months, if a corresponding request is submitted and the fee for its filing is paid before the expiry of this period. If, regardless of the appropriate measures taken by the applicant, the term for submission of additional materials is missed but during six months from the expiry of this term a relevant request is submitted along with additional materials and a fee for its submission is paid, the rights of the applicant regarding the application shall be restored.

7. If an applicant submitted additional materials, in the course of the expert appraisal it is determined whether these materials do not go beyond the essence of the sign revealed in the submitted application and the list of goods and services specified in the application.

Additional materials go beyond the essence of the sign revealed in the submitted application if they contain features that should be included in the sign that is claimed as a trademark.

Additional materials in a part that goes beyond the essence of the sign revealed in the submitted application or broaden the list of goods and services specified in the application shall not be taken into consideration in the course of expert appraisal of the application and may be presented by the applicant as an individual application after receiving the relevant notification of NIPO.

8. According to clause 10 of this Article, within three months from the publication date in the Bulletin of the information regarding the application or international registration of a trademark, or territorial extension of the international registration to Ukraine made after the international registration, any person shall have the right to submit a reasonable objection of the application or validity of the international registration in Ukraine to NIPO with regard to non-compliance of the sign represented therein with the conditions of granting legal protection established by this Law. Fee shall be charged for the submission of such objection. Requirements for objections shall be determined by the central



executive authority in charge of shaping and implementing state policy in the field of intellectual property. The objection shall be submitted with its copy.

NIPO shall send a copy of the objection to the applicant.

The applicant may notify NIPO of his attitude towards the objection within two months from the date of its receipt. He may refute the objection and leave the application unchanged, amend, or withdraw the application. For the holder of an international registration, the specified term shall be three months from the date of sending a notification of preliminary refusal to grant legal protection together with the copy of the objection to the International Bureau of WIPO by NIPO.

9. When carrying out formal expert appraisal:

the date of submitting an application shall be determined by Article 8 of this Law;

the application shall be checked for conformity with formal requirements of Article 7 of this Law and rules determined on its basis by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property; the fee paid for submitting an application shall be checked for conformity with the established requirements.

10. In the event the application materials comply with the requirements established by Article 8 of this Law and the fee paid for submitting an application complies with the established requirements, a notification of the determined date of submitting an application shall be sent to the applicant and information on the application determined by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property shall be published in the Bulletin within five business days from the date of sending such notification. The composition of information subject to publication shall include the following data (if available): application number, date of submitting an application, exhibition priority date, number of the preliminary application under the Paris Convention, date of submitting a preliminary application under the Paris Convention, two-letter code of a state being a party to the Paris Convention, index (indexes) of the Nice Classification to register marks and the list of goods and services, index (indexes) of the International Classification of the Figurative Elements of Marks, image of the

mark, colours applied for (a colour or combination of colours), the applicant (name or full denomination and address of the applicant (applicants)), representative (name, full denomination and registration number of the representative in intellectual property cases (patent attorney) or another authorised person), the addressee (correspondence address).

Simultaneously with the publication in the Bulletin, information on the application shall be entered into the Application Database. The procedure for maintaining the Application Database and composition of information contained therein shall be determined by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property. The information contained in the Application Database shall include the following data (if available): application number, date of submitting an application, exhibition priority date, number of the preliminary application under the Paris Convention, date of submitting a preliminary application under the Paris Convention, two-letter code of a state being a party to the Paris Convention, index (indexes) of the Nice Classification to register marks and the list of goods and services, index (indexes) of the International Classification of the Figurative Elements of Marks, image of the mark, colours applied for (a colour or combination of colours), the applicant (name or full denomination and address of the applicant (applicants)), representative (name, full denomination and registration number of the representative in intellectual property cases (patent attorney) or another authorised person), the addressee (correspondence address).

As soon as the information on the application is published, any person shall have the right to review application materials following the procedure established by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property. A fee shall be charged for familiarisation with the materials of the application.

Information on the international registration of a trademark or the territorial extension of the international registration to Ukraine after the international registration shall be published in the Bulletin upon the receipt by NIPO of a notification of the International Bureau of WIPO on the international registration of a trademark or on the territorial extension of the international registration to Ukraine after the international registration.

11. If application materials fail to meet the requirements of Article 8 of this Law, a notification thereof shall be immediately sent to the applicant. If the non-conformity is eliminated within 2 months from the date of receiving the notification by the applicant, then the date of receiving corrected materials by NIPO shall be considered the date of submitting an application. Otherwise, the application shall be considered not submitted, and the applicant shall be notified thereof.

12. If the application meets the requirements of Article 7 of this Law and the fee paid for submitting an application complies with the established requirements, the applicant shall be notified thereof.

13. If the requirements of clause 8, Article 7 of this Law are violated, the application shall be considered withdrawn, and the applicant shall be notified thereof.

14. If the application does not meet formal requirements of Article 7 of this Law and the rules established on its basis by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property, or the fee paid for submitting an application does not comply with the established requirements, a notification shall be sent to the applicant with proposals to correct defects.

If defects relate to the grouping of goods and services, the notification shall contain the list of goods and services grouped by NIPO and, if necessary, indicate the amount of the fee for submitting an application to be additionally paid. When a certain good or service is presented in the application as a term, which does not provide the possibility to range it in a certain class of the Nice Classification, the applicant shall be offered to replace this term or delete it. If the applicant fails to fulfil the request, the said term shall not be included in the list of goods and services grouped by NIPO.

Correction of defects indicated in the notification shall be carried out within the term and under the procedure established in clause 6 of this Article for additional materials.

15. During the qualification expert appraisal, compliance of the sign applied for with the conditions of granting legal protection established by this Law shall be verified, and objections submitted

in accordance with clause 8 of this Article shall be considered. When verifying the compliance of the sign applied for with the conditions of granting legal protection established by this Law, the information database of NIPO shall be used including the materials of applications, reference and search unit and relevant official publications.

The submitted objection shall be considered within the grounds provided for therein and taking into account the applicant's response, if provided, within the established term.

Results of the objection consideration shall be specified in the conclusion of the expert appraisal on the application. A copy of the NIPO decision made on the basis of the conclusion of expert appraisal shall be sent to the person submitting the objection. If based on the outcomes of such consideration NIPO makes a decision on registration of a trademark for all goods and services specified in the application or some of the goods and services specified in the application and refusal to register the trademark for the rest of the goods and services specified in the application, consideration of the application shall be suspended until the expiry of the term set forth in paragraph 2, clause 1 of Article 15 of this Law to appeal such a decision by a person submitting the objection under clause 8, Article 10 of this Law.

16. If based on the qualification expert appraisal and objection consideration results, if any, there are reasons to consider that the sign applied for does not meet the requirements for granting the legal protection in whole or in part, NIPO shall send to the applicant a reasonable preliminary conclusion with an exhaustive list of grounds for non-compliance of the sign applied for with the conditions of granting legal protection in whole or in part, such preliminary conclusion may be sent only once with the proposal to provide a reasoned response to support the registration of a trademark.

The applicant's response shall be provided within the term and following the procedure established by clause 6 of this Article for additional materials and shall be taken into account when preparing the expert appraisal conclusion on the application.

If based on the results of the qualification expert appraisal there are grounds to consider that the trademark under the international registration does not comply with the conditions of granting legal protection in whole or in part, NIPO shall send a preliminary

refusal to grant legal protection to the International Bureau of WIPO. In such event, a response of the holder of the international registration shall be given under the procedure established by clause 6 of this Article within three months from the date of sending such notification by NIPO.

#### **Article 11. Withdrawal of the Application**

The applicant shall have the right to withdraw the application at any time before the date of paying the state duty for certificate issuance.

#### **Article 11-1. Division of Application**

1. Before NIPO makes a decision on the application, an applicant shall have the right to divide the application into two or more applications (divisional applications) by setting apart goods and services listed in this application so that each of the divisional applications shall not contain goods and services related to goods and services listed in other applications.

2. The applicant shall carry out the division of the application by submitting a request for making relevant changes in the application and a divisional application (applications), provided that respective fees for submitting the request and application are paid.

3. The date of submitting the divisional application shall be the same as the date of submitting the divided application. The priority date of the divisional application shall be determined the same as the priority date of the divided application, if there is a ground for that.

#### **Article 12. Publication on Certificate Issuance**

Based on the decision on registration of a trademark and provided that a document on the payment of the state duty for certificate issuance and the fee for publication on certificate issuance are available, information on certificate issuance determined under the specified procedure shall be published in the Bulletin. An applicant shall pay the specified duty and fee after receiving the decision on registration of a trademark.

If within three months from the date of receiving the decision on registration of a trademark by an applicant a document on the payment of the state duty for certificate issuance and the fee for

publication on certificate issuance in the amount and under the procedure established by the legislation were not received by NIPO, the publication shall not be provided, and the application shall be considered withdrawn.

The term for receiving a document on the payment of the state duty for certificate issuance and the fee for publication on certificate issuance shall be prolonged but not more than for six months, provided that a relevant request is submitted and the fee for submission thereof is paid prior to the expiry of the specified term. If the term for receiving a document on the payment of the state duty for certificate issuance and the fee for publication on certificate issuance is missed for serious reasons, rights of the applicant in respect of the application shall be restored in the event that a relevant request is submitted within six months upon expiry of the specified term together with the document on the payment of the state duty for certificate issuance and the fee for publication on certificate issuance and the fee for submitting the request.

Simultaneously with sending a request for granting legal protection to a trademark under the international registration in Ukraine to the International Bureau of WIPO, the relevant information shall be published in the Bulletin.

### **Article 13. Registration of a Trademark**

1. Simultaneously with the publication of information on certificate issuance, NIPO shall carry out the state registration of a trademark. The procedure for the Register maintenance and a list of information contained in the Register shall be determined by the central executive authority in charge of forming and implementing state policy in the field of intellectual property.

2. Upon the entry of the information in the Register, any person shall have the right to access this information under the procedure established by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property and to obtain an abstract of the information concerning a certificate from the Register upon a request, provided that the fee for submission of the said request is paid.

3. Mistakes in the information recorded in the Register shall be corrected on the initiative of the certificate holder or NIPO.

Changes to the Register may be made on the initiative of the certificate holder according to the specified list of possible changes.

A fee shall be charged for submitting a request for correction of a mistake or making any changes, provided that the mistake is not obvious or technical and the change has arisen through circumstances depending on the person submitting the request.

#### **Article 14. Certificate Issuance**

1. NIPO shall issue a certificate within a month after the state registration of a trademark. A certificate shall be issued to a person that has the right to obtain the certificate. If several persons have the right to obtain a certificate, they shall obtain a single certificate.

2. The form of the certificate and the content of the information provided therein shall be specified by the central executive authority in charge of forming and implementing state policy in the field of intellectual property.

3. NIPO shall amend obvious mistakes in the issued certificate on request of the certificate holder with subsequent announcement to this effect in the Bulletin.

4. In the event of loss or damage to the certificate, its holder shall be granted a duplicate of the certificate by the procedure determined by the central executive authority in charge of forming and implementing state policy in the field of intellectual property. Fee shall be charged for granting a duplicate of the certificate.

#### **Article 15. Appellation against the NIPO Decision**

1. The applicant may appeal against the NIPO decision on the application in court proceeding or to the Appeals Chamber within two months from the date of the NIPO decision receipt or copies of materials requested in accordance with clause 3 of Article 10 of this Law. For the holder of the international registration, the specified term shall be three months from the date of sending the request to refuse to grant legal protection to the trademark under the international registration in Ukraine for all specified goods and services or grant legal protection to the trademark for some of specified goods and services to the International Bureau of WIPO by

NIPO.

A person submitting an objection in accordance with clause 8 of Article 10 of this Law, may appeal the NIPO decision to the Appeals Chamber within two months from the date of receipt of a copy of the decision sent to such a person in compliance with paragraph 4, clause 15, Article 10 of this Law.

3. An applicant shall be deprived of the right to appeal the decision of NIPO to the Appeals Chamber in the event of payment of the state duty for issuing a certificate.

4. The NIPO decision shall be appealed to the Appeals Chamber by filing an objection against the decision according to the procedure determined by this Law and on its basis by the Regulation of the Appeals Chamber, approved by the central executive authority in charge of forming and implementing state policy in the field of intellectual property. Fee shall be charged for the submission of such objection. If the fee has not been paid within the term specified in clause 1 of this Article, the objection shall be deemed not submitted, and a notification shall be sent to the person submitting an objection.

5. When the Appeals Chamber receives the objection and the document on the payment of the fee for the submission of the objection, the office work on the application shall be suspended until the decision of the Appeals Chamber is approved.

In the case of submitting an objection against the NIPO decision on the application in accordance with paragraph 2, clause 1 of this Article, a notification and a copy of such objection shall be immediately sent to the applicant. The applicant shall have the right to submit a substantiated response to the objection to the Appeals Chamber following the procedure and within the term established by the Regulation of the Appeals Chamber.

6. An objection against the NIPO decision on the application shall be considered according to the Regulation of the Appeals Chamber within two months from the date of receipt of the objection and of the fee payment document for submitting an objection, within the scope of the reasons presented in the objection and during its consideration as well as taking into account the applicant's response, in case of its receipt. The term for consideration of the



objection may be extended on the initiative of the applicant or the person submitting an objection in accordance with paragraph 2, clause 1 of this Article, but for no more than two months, provided that the relevant request is submitted, and the fee for its submission is paid before the expiry of this term.

7. On the results of the objection consideration, the Appeals Chamber shall make a reasonable decision that is approved by the order of NIPO and sent to the applicant and to the person submitting an objection, in case the objection is submitted by the person in accordance with paragraph 2, clause 1 of this Article.

If the objection is satisfied in full or in part, the fee for submission of the objection shall be refunded in the amount of 50 per cent of the established fee for submitting an objection.

In case the objection is submitted by a person who is not the applicant, the Appeals Chamber shall send a duplicate copy of such decision to the applicant based on the results of the objection consideration.

9. The applicant or the person submitting the objection in accordance with paragraph 2, clause 1 of this Article may appeal to the court against the Appeals Chamber decision approved by NIPO within two months from the date of receipt of the decision.

10. Decisions of the Appeals Chamber shall enter into force on the date of their approval by the NIPO order and shall be published in full on the NIPO official website.

## **Section IV RIGHTS AND OBLIGATIONS ARISING FROM THE CERTIFICATE**

### **Article 16. Rights Arising from the Certificate**

1. The rights arising from the certificate shall be effective from the date of submitting an application.

2. The certificate holder shall have the right to use the trademark and exercise other rights provided by this Law.

3. When using the trademark, the relations between several persons - holders of the certificate shall be defined by an agreement between them. If such agreement is not available, each certificate holder may use the trademark at his own discretion, but none of them has the right to grant a permission (issue a licence) for the use of the trademark and transfer the trademark property right to another person without consent of other certificate holders.

4. The following shall be considered to be the use of a trademark: applying the trademark on any goods for which it is registered, a package containing such goods, a signboard related to the goods, a label, a tab, a tag or another item attached to the goods, storing such goods with the specified application of the trademark with the purpose of offering for sale, offering it for sale, selling, importing (coming-in) and exporting (coming-out);  
using it while offering or providing any service for which the trademark is registered;  
using it in business documentation or in advertising and on the Internet.

A trademark shall be considered to be used if it was applied in the form of the registered trademark as well as in the form differing from the registered trademark only by certain elements if that does not change the distinctive features of the trademark in general.

5. A certificate holder shall have the exclusive right to prohibit other persons, unless otherwise provided for by this Law, to use without his consent:

a sign that is identical with the registered trademark with respect to the goods and services listed in the certificate;

a sign that is identical with the registered trademark with respect

to the goods and services related to those listed in the certificate, if such a use may result in confusion of the specified sign and the trademark, in particular, if an association of such sign with the trademark may appear;

a sign that is similar to the registered trademark with respect to the goods and services listed in the certificate, if such a use may result in confusion of the specified signs, in particular, if an association of such sign with the trademark may appear;

a sign that is similar to the registered trademark with respect to the goods and services related to those listed in the certificate, if such a use may result in confusion of the specified signs, in particular, if an association of such sign with the trademark may appear.

6. The exclusive right of a certificate holder to prohibit other persons to use the registered trademark without his consent shall not apply to:

exercising any right acquired before the application submission date or, if the priority was claimed, before the application priority date;

the use of the trademark for goods put into the civil circulation under this trademark by the certificate holder or by his consent, provided that the certificate holder has no essential reasons to prohibit such use in connection with the further sale of goods, in particular in case of change or deterioration of goods after putting it into the civil circulation;

the use of signs, in the course of trade, which are related to the type, quality, quantity, purpose, value, geographical origin, time of production of goods or provision of services or other characteristics of goods or services, provided that there are no signs of violating rights of the trademark certificate holder;

the use of the trademark in the course of trade, in the event it is necessary to specify the purpose of goods or services, namely, as additional equipment or spare parts, provided that the trademark is used according to fair business practices;

application of the trademark in comparative advertising exclusively for the purpose of distinguishing the goods and services in order to objectively emphasise their distinctions, provided that such a trademark is applied according to fair business practices and with the observance of provisions of the legislation on protection against unfair competition;

non-commercial use of the trademark;  
all forms of broadcasting news and commenting upon news;  
fair use of their names or addresses by them;  
the use of the trademark in comparative advertising, which is carried out in accordance with the legislation on advertising, protection against unfair competition and is not related to unfair business practices.

The exclusive right of a certificate holder to the trademark, which contains a geographical indication, to prohibit other persons to use the registered trademark without his consent shall not apply to fair use of the relevant geographical name by other persons.

7. A certificate holder may transfer, by an agreement, the property right to the trademark to any person in whole or with respect to the part of goods and services listed in the certificate.

8. A certificate holder shall have the right to grant a permission (issue a licence) for the use of the trademark to any person under a licence agreement.

The licence agreement shall contain, in particular, information about the ways of using the trademark, the territory and term for which the use of it is allowed, and the requirement stating that the quality of goods and services manufactured or provided under the licence agreement shall not be lower than the quality of goods and services of the certificate holder and that the certificate holder will provide the control over the fulfilment of the specified requirement.

9. The agreement on the transfer of the trademark property rights and the licence agreement shall be deemed valid, if made in writing and signed by the parties.

The party to the agreement shall have the right to inform an indefinite number of persons about the transfer of the trademark property rights or issuance of a licence for the use of the trademark. Such informing shall be carried out by means of publishing information in the Bulletin in the amount and following the procedure established by NIPO, with its simultaneous entry in the Register.

Publication of information about transferring the property right to the trademark in whole and about issuing a licence for the use of the trademark as well as of changes to the information on the

licence issuance proposed by the party to the agreement shall be subject to payment of respective fees.

In the case of publishing information about transferring the property right to the trademark with respect to the part of goods and services listed in a certificate NIPO shall issue a new certificate in the name of the person to which the specified right was transferred, provided that the document on the payment of the state duty for issuing a new certificate is available.

10. A certificate holder shall have the right to place a warning marking alongside with the trademark in the form of the circled Latin character "R" that indicates that the trademark is registered in Ukraine.

11. A certificate holder that carries out re-selling activities, under an agreement with the manufacturer of goods or the person providing services, shall have the right to use his own trademark alongside with the trademark of the specified persons as well as instead of their trademark.

#### **Article 17. Obligations Arising from the Certificate**

A certificate holder shall exercise the rights arising from a certificate in good faith.

## **Section V TERMINATION AND INVALIDATION OF THE CERTIFICATE**

### **Article 18. Termination of the Certificate**

1. A certificate holder may at any time renounce the certificate in whole or in part upon a request submitted to NIPO. The specified renunciation shall be effective from the date of publishing the relevant information in the Bulletin.

2. A certificate shall be terminated in case the fee for extending its validity period is not paid. A request for extending the certificate's validity period and fee for each extension of its validity period shall be received by NIPO by the end of the current certificate's validity period, provided that the fee is paid within the last six months of this period.

The fee for extending the certificate's validity period and the request for extending the validity period of the certificate shall be submitted to NIPO within six months after the established term. In this case, the amount of the fee shall be increased by 50 per cent.

A certificate shall be terminated on the first day of the certificate's validity period if the respective fee has not been paid.

3. A certificate shall be terminated by the court decision: in connection with transformation of the trademark into a commonly used sign for goods and services of a certain type after the date of publishing information on issuing the certificate; if following the use of the trademark by the certificate holder or by other person upon his consent, it may mislead the public, in particular, in terms of the origin, quality or geographical origin of the goods and services for which it has been registered. If the grounds for termination of the certificate apply to certain goods or services, the certificate shall be terminated only with regard to such goods or services.

4. If the trademark is not used in Ukraine, in whole or with respect to the part of goods and services listed in the certificate, continuously within five years from the date of publishing the information on issuing the certificate, or if the use of the trademark has been suspended from the other date after such publication for the continuous term of five years, any person shall

have the right to appeal to the court with a request for early termination of the certificate in whole or in part.

For the purposes of applying this clause, the date from which the use of the trademark under the international registration should commence shall be the date of publication in the NIPO Bulletin of information on the provision of legal protection to the trademark under the international registration in Ukraine.

In such a case, the certificate or international registration in Ukraine may be terminated in whole or in part, unless the certificate holder gives serious reasons for such non-use. Such serious reasons shall be the circumstances preventing the use of the trademark despite the will of the holder of the certificate or the international registration, in particular, such as limitation of import or other requirements to goods and services established by the legislation.

For the purposes of this clause, the use of the trademark by the certificate holder shall be also considered to be the use of this trademark by another person upon the consent of the certificate holder.

The use of the trademark by the person entitled to use a collective mark shall be considered to be the use by the certificate holder. The certificate may not be terminated if, within the period from the expiry of a five-year term of non-use of the trademark until submitting the claim for early termination of the certificate, the trademark has come into use or its use was resumed, except for the case when preparation to the use or resuming of the use of the trademark had started within three months prior to submitting such claim and after the certificate holder has learned about the possibility to submit it.

#### **Article 19. Invalidation of the Certificate**

1. A certificate may be invalidated in whole or in part by judicial procedure in the following cases:

- a) the registered trademark does not meet the requirements for granting legal protection;
- b) the certificate contains elements of the trademark reproduction and the list of goods and services that were not presented in the submitted application;
- c) the certificate was issued in the result of submitting an application with infringement of other persons' rights.

2. If a certificate is recognised to be invalid in whole or in part, NIPO shall inform about that in its Bulletin.

3. A certificate or its part recognised as invalid shall be considered not to have entered into force on the day following the application submitting date.

4. A person who is the owner of the trademark in a foreign state, the right to which has been obtained in Ukraine by the agent or representative without the owner's consent, may demand to invalidate the certificate to such trademark, in case the agent or representative fails to justify their actions by relevant proofs.

5. If a certificate was invalidated and the court established that the application had been submitted with violation of other person's rights, the court may decide on the compensation of losses by the certificate holder in favour of the person that suffered losses caused by the actions resulting from the registration of the trademark with violation of that person's rights.



## **Section VI PROTECTION OF RIGHTS**

### **Article 20. Infringement of the Certificate Holder Rights**

1. Any encroachment on the rights of a certificate holder provided for by Article 16 of this Law, including actions that shall be agreed with the certificate holder but are carried out without his consent, as well as preparation for such actions, shall be considered to be the infringement of the certificate holder rights resulting in the liability under the current legislation of Ukraine.

The use of trademarks and signs specified in clause 5 of Article 16 of this Law in domain names without the certificate holder consent shall be also considered to be the infringement of the rights.

2. On request of the certificate holder, such an infringement shall be ceased, and the infringer shall be bound to compensate the certificate holder for inflicted losses.

The certificate holder may also demand to remove the illegally used trademark or sign, which is similar to it to the extent that the trademark and the sign may be confused, from the product, from its packaging, or to liquidate the manufactured reproductions of the specified trademark or the sign, which is similar to it to the extent that they may be confused.

Restoration of infringed rights of the certificate holder may also be demanded by his consent by the person who has acquired the licence.

### **Article 21. Remedies**

1. The protection of trademark rights shall be carried out following a judicial and other procedure established by law.

2. The jurisdiction of courts shall cover all legal relations arising due to the application of this Law.

Courts shall resolve, in particular, in accordance with their competence disputes about:

determination of the certificate holder;

conclusion and enforcement of licence agreements;

infringement of the certificate holder rights.

### **Article 22. Right to Re-Registration**

Only the former certificate holder shall have the right to re-register a trademark within two years after termination of the

certificate in accordance with clauses 1 and 2, Article 18 of this Law, except for cases when the holder of the terminated certificate gives consent for registration of the trademark that was applied for.

## **Section VII FINAL PROVISIONS**

### **Article 23. State Duty and Fees**

The amount of and procedure for paying the state duty for issuing certificates to trademarks for goods and services shall be determined according to the legislation.

Revenues received from the payment of state duty for issuing certificates to trademarks shall be credited to the budgets in the manner prescribed by the Budget Code of Ukraine.

The amount of fees provided for by this Law, terms and the procedure for their payment shall be determined by the Cabinet of Ministers of Ukraine.

Fees provided for by this Law shall be paid to the NIPO current accounts.

Receipts from fees stipulated by this Law shall be target-oriented and used solely for the development and functioning of the state system of legal protection of intellectual property, in particular for the accomplishment of tasks defined by this Law and other regulatory acts in the field of intellectual property.

### **Article 24. Registration of a Trademark in Foreign States**

1. Any person shall have the right to register the trademark in foreign states.

2. In case of registration of a trademark in foreign states, according to the Madrid Agreement Concerning the International Registration of Marks or/and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, an application for the international registration, as well as relevant requests on the territorial extension after the international registration and on the renewal of the international registration, shall be submitted via NIPO, provided that the respective national fee is paid for submitting each of requests.

The request on the territorial extension after the international registration and request on the renewal of the international registration may be submitted directly to the International Bureau of WIPO, in the event that the international registration has been done exclusively in compliance with the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

3. The expenditures associated with the registration of a trademark

in foreign states shall be borne by the applicant or the other person with his consent.

**Article 25. Protection of Rights to a Well-Known Trademark**

1. The protection of rights to a well-known trademark shall be carried out according to Article 6bis of the Paris Convention and this Law and shall be based on the recognition of the trademark to be well known by the Appeals Chamber or the court. The trademark may be recognised as well-known regardless of its registration in Ukraine.

2. When determining whether a trademark is well known in Ukraine, the following factors may be considered, if applicable:

- degree of notability and recognition of the trademark in the relevant public sector;
- duration, scope and geographical area of any use of the trademark;
- duration, scope and geographical area of any promotion of the trademark, including advertising, making public, and display at fairs or exhibitions of goods and/or services with respect to which the trademark is used;
- duration, scope and geographical area of any registrations and/or applications for registration of a trademark, provided that the trademark is used or recognised;
- evidence of the successful assertion of rights to the trademark, in particular the territory where the trademark is recognised to be well known by competent authorities;
- the value associated with the trademark.

3. The procedure for recognising a trademark to be well known in Ukraine by the Appeals Chamber shall be established by the central executive authority in charge of shaping and implementing state policy in the field of intellectual property. The fee shall be paid for the submission of the request on the recognition of a trademark to be well known.

The decision of the Appeals Chamber on the recognition of a trademark to be well known in Ukraine may be appealed in court.

4. If a trademark is recognised as well-known in court, a person the trademark of which is recognised to be well known shall inform NIPO of such decision.

Information on well-known trademarks, which are recognised as such

by the Appeals Chamber or in court, shall be entered into the list of trademarks well known in Ukraine by NIPO and published in the Bulletin. The list of well-known trademarks in Ukraine shall be for reference purposes, available for the public and published on the official website of NIPO.