

UKRAINE
Trademark Rules

as amended by Resolution No. 72 of the State Patent Office of August 20,
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Rules on Drafting, Filing and Examination of an Application for the Grant of a Certificate of Ukraine for a Trade Mark For Goods and Services

Rules on Drafting, Filing and Examination of an Application for the Grant of a Certificate of Ukraine for a Trade Mark For Goods and Services (hereinafter the Rules) have been developed pursuant to the Law of Ukraine "On the Protection of Rights to Trade Marks for Goods and Services" and set forth the requirements to a trade mark application, the procedures for filing and examination of an application for a trade mark for goods and services.

1. General provisions

1.1. For the purpose of these Rules, the terms used herein have the following meaning:

the Law - the Law of Ukraine "On the Protection of Rights to Trade Marks for Goods and Services";

the Office - the State Patent Office of Ukraine;

RDCPE - the Research and Development Centre of Patent Examination;

certificate - certificate of Ukraine for a trade mark for goods and services;

person - an individual or legal entity;

application - a set of documents required for the grant of a certificate;

applicant - a person/persons who filed an application, or his/her/their successors in title;

priority - precedence in filing an application;

ICGS - International Classification of Goods and Services;

representative - a representative registered by the Office under the provisions of the Regulations on Representatives in the Matters of Intellectual Property (Patent Attorneys), implemented by the Resolution No. 545 of the Cabinet of Ukraine of 10 August 1994, or another authorized person;

Regulations on the Procedure for Paying Official Fees - Regulations on the Procedure for Paying Official Fees for Acts Related to the Protection of Rights to Inventions, Utility Models, Industrial Designs and Trade Marks for Goods and Services, implemented under the Resolution No. 701 of the Cabinet of Ukraine of 10 October 1994, as revised and supplemented under the Cabinet Resolutions No. 196 of 20 March 1995, No. 98 of 16 January 1996 and No. 498 of 14 August 1996;

Paris Convention - the Paris Convention for the Protection of Industrial Property;

Madrid Agreement - the Madrid Agreement Concerning the International Registration of Marks;

Register – the State Register of Certificates of Ukraine for Trade Marks for Goods and Services;

registration – the state registration of a trade mark by the Office;

WIPO – the World Intellectual Property Organisation.

1.2. An application may be filed by a person, group of persons or their successors in title.

1.3. A trademark for goods and services (hereinafter – trademark) is a sign which is capable of distinguishing goods and services of one person from the same type of goods and services of another person.

1.4. The protection is granted to the following trade marks:

- word marks in the form of words or combinations of letters;
- figurative marks in the form of graphic compositions represented in any form on a plane;
- three-dimensional figures or their compositions;
- combinations of the above-mentioned signs.

Such trade marks may be represented in colour or in combination of colours. As a trade mark may be registered light, as well as a colour per se or combination of colours, etc. Such trade marks are registered by the Office provided it is technically possible to enter them in the Register and thus make information on their registration available to public.

1.5. The grounds for refusal in granting legal protection to a trade mark are set forth in paragraph 1 of Article 5 and in Article 6 of the Law.

2. Drafting and Filing an Application

2.1. Requirements to an application

2.1.1. Filing an application.

An application for a trade mark for goods and services is filed to the Office at the address of the RDCPE in writing.

The application may be filed in the name of the applicant through a representative.

2.1.2. Language of the application

The application shall be drawn up in the Ukrainian language. If some documents of the application are in a language other than Ukrainian, their translation in the Ukrainian language shall be submitted to the Office within two months following the filing date.

Note. Until 1 July 1997 the list of goods and/or services for which a mark may be applied for registration may be filed in the Russian language, with the request being drawn up in the Ukrainian language.

2.1.3. Unity Requirement

The application shall relate to one sign only. A sign which differs from the applied sign in any element is considered to be a different sign.

2.1.4. Structure of the application

The application shall include:

- a request for the registration of a trade mark;
- a representation of the trade mark applied for registration;
- a list of goods and services for which the trade mark is applied, grouped according to the classification under ICGS;
- documents accompanying the application.

The documents accompanying the application include:

- a receipt confirming payment of the official filing fee, including the examination fee, which meets the requirements of the Regulations on the Procedure of Paying Official Fees;
- a copy of the priority application certified by the Office of the country of origin (if the applicant wishes to benefit from the right of priority under paragraph 1, Article 9 of the Law);
- a document confirming display of exhibits incorporating the applied trademark at an official or officially recognized international exhibition (if the applicant wishes to benefit from the right of priority under paragraph 2, Article 9 of the Law);
- a Power of Attorney in the name of the representative, if the application is filed through an agent;
- documents confirming the authorization granted to the applicant for the use in the applied sign of the elements mentioned in paragraph 1, Article 6 of the Law;

- Regulations governing the use of a collective mark, if the applicant is an association which either produces goods or services having common properties and provided that such application had been filed before the implementation of the Law and provided that examination had not been completed by 1 July 1994.

2.1.5. Under Article 23 of the Law, the amounts, terms and the procedure for paying the official fees related to the protection of rights to trade marks for goods and services are set forth by the Regulations on the Procedure for Paying Official Fees taking due note of the respective revisions therein.

2.1.6. A request for the registration of a trade mark shall follow the form prescribed by the annex to these Rules. All fields in the request form shall be filled in. If the required data can not fit in the respective fields, they shall be provided on separate sheets. In this case, the respective fields shall quote "see on a separate sheet".

2.1.7. The sections above the word "Request" are meant for notes by RDCPE and are not meant to be filled in by the applicant.

2.1.8. Under the code (731), information on the applicant must be provided: full name of the individual or full name of the legal entity (according to statutory documents) and his/her address.

Full name of a foreign legal entity must be provided with the indication of its legal organizational form. If the foreign legal entity was incorporated under the laws of a certain territorial entity within the state, the name of such territorial entity must also be provided.

Full name or denomination of the foreign applicant must be provided in Ukrainian transliteration.

The legal organizational form of a foreign legal entity must be provided in transliteration if there is no direct translation to the Ukrainian language. Next to the transliteration the full name or denomination of the applicant must be provided in the original language in brackets. The postal address of a national applicant must be provided in the following format:

- postal code;
- oblast, rayon;
- name of the place;
- street;
- building number;
- Ukraine's code under WIPO ST.3 (UA).

Addresses of foreign applicants must be provided in the Ukrainian language with all details and in the same format as provided by the applicant. Street names, names of squares, as well as symbols used next to numerals

in the address must be provided in the Ukrainian transliteration. The address in original spelling must be provided next to the transliteration in brackets.

For Ukrainian legal entities, a respective code from the Common Register of Enterprises and Organisations of Ukraine must be provided in the same field.

If the applicant is an individual or legal entity, residing or domiciled outside Ukraine, it is necessary to provide the respective two-letter country code under the WIPO ST.3.

2.1.9. If the applicant benefits from the right of priority, then boxes under the codes (310), (320), (330) and (230) must be respectively marked and relevant information must be provided.

2.1.10. Under the code (750), must be indicated complete postal address in Ukraine to which all official communications will be sent to the applicant, as well as full name or denomination of the addressee.

2.1.11. Under the code (740), information on the representative in IP matters is provided (if the application is being filed through a representative).

2.1.12. A representation of the trademark applied for registration is placed in the field under the code (540).

The field under (541) must be marked with (x) sign if the applicant wishes that the trade mark is registered and published with the use of standard symbols of the Office.

The field under the code (546) is marked with the (x) sign if the applied trade mark consists of non-standard symbols.

2.1.13. Under the code (591), the colour (combination of colours) of the applied mark must be indicated.

If the trade mark is applied in black-and-white, this field is to be left blank.

2.1.14. The field under the code (554) is marked with the (x) sign if a three-dimensional trademark is applied for registration.

2.1.15. The field under the code (511) provides a full list of the goods and/or services for which the protection of the trade mark is sought. The goods and/or services must be grouped under the classes of ICGS. First, the number of a respective class is mentioned, and then the goods and/or services included in this class are listed. The classes are listed in ascending order.

2.1.16. The section of the request titled "The list of the enclosed documents" is filled with the use of the "x" sign and put in respective boxes with the indication of the number of pages and the number of copies.

2.1.17. The section under the code (390) is to be filled if the applicant

requests to apply the provisions of article 6 quinquies of the Paris Convention.

2.1.18. The sections under the codes (641), (646) are to be filled in if there are earlier applications, valid registrations or if the applicant wishes to re-register his trade mark under the provisions of Article 22 of the Law.

2.1.19. Filling in the last section of the request, titled "Signatures", is compulsory.

The request form must be signed by the applicant.

If the applicant is a legal entity, the request must be signed by an authorized representative, and the signature must be accompanied by the indication of the full signor's name and his position within the company. The signature must be confirmed by a seal.

If the application is filed through a representative in IP matters, the latter is entitled to sign on behalf of the applicant.

In this field, the date on which the request was signed must also be indicated.

Any information provided on separate sheets must be signed according to the same requirements as set forth in this paragraph.

2.1.20. Requirements to a representation of the trade mark applied for registration

The representation of the trade mark applied for registration must be submitted in photocopies or as prints sized 8 x 8 cm.

If a three-dimensional trade mark is applied for registration, its snapshots must be made from a shooting angle which enables imagining the object in whole. Additionally, it is necessary to provide representations of all necessary views which provide clear and comprehensive representation of the trade mark.

If a label is applied for registration as a trade mark, it is submitted as a representation of the trade mark, provided that its size does not exceed 14 x 14 cm.

Photocopies or prints must be high contrast, clear and must be submitted in the colour or combination of colours mentioned under the code (591) in the request.

Each colour variant shall be subject to another application.

2.1.21. If sound or light sign is applied for registration as a trade mark, such sign is provided in a record, such as a phonogramme (video recording) on an audio or video cassette. If a colour per se or combination of colours is subject to registration, then it is necessary to submit the required number of prints on which the colour or combination of colours was applied.

The said trade marks may be registered by the Office provided it is technically possible to enter them in the Register in order to make the information on their registration available to public.

2.1.22. Along with the representation of the trade mark, the applicant must submit a description of the trade mark if such mark has a word part or relates to trade marks which are not comprised of graphical signs. If a word mark or its part does not have any semantic meaning, one must indicate the way in which it was formed, for example being composed from initial syllables of several words, abbreviation, an invented word, etc. If the word sign is not common in the Ukrainian language (for example a special term, obsolete word), then it is necessary to explain the meaning of such word.

If a word mark or its part is in a foreign language, for a trademark having a semantic meaning, it is necessary to provide their translation in the Ukrainian language and their transliteration in the letters of the Ukrainian alphabet.

2.1.23. If sound is applied for registration as a trade mark, it is necessary to indicate the type of such sound (namely piece of music or its part, noise of any origin, etc). For a sign, in which a musical piece is used, one must provide its musical notation.

2.1.24. If light is applied for registration as a trademark, it is necessary to provide characteristics of light symbols/signals, their sequence, duration of luminescence and other features.

2.1.25. If a colour per se or a combination of colours is applied for registration as a trade mark, the application may be accompanied with examples of its/their use.

2.1.26. The application must be accompanied with a receipt which confirms that the official filing fee, including the examination fee, has been paid. The form of receipt shall meet the requirements set forth by the Regulations on the Procedure of Payment of Official Fees. The said document shall be filed either along with the application upon filing or within two months following the filing date.

2.1.27. If the application is filed through a representative, it must be accompanied with a Power of Attorney which confirms his/her powers. A Power of Attorney is issued by the applicant in an arbitrary form and does not require notarisation. If the Power of Attorney was submitted to the Office in the original language, it will have to be supplemented with its Ukrainian translation.

The requirements to the Power of Attorney are set forth in paragraph 3.1.4 of the Rules.

2.1.28. If the applicant wishes to benefit from the right of priority

under the provisions of paragraph 1, Article 9 of the Law, he shall either upon filing the application, or within three months from the filing date, submit a request claiming priority from an earlier application having indicated its number and filing date, as well as a copy of the priority application certified by the country of origin. A translation of the priority application in the Ukrainian language is submitted either along with the request, or in response to the Office inquiry within the deadline indicated in the official communication.

2.1.29. If the applicant wishes to benefit from the right of priority under paragraph 2, Article 9 of the Law, he shall either upon filing the application, or within three months from the filing date, submit a request claiming priority along with a document in confirmation that that applied trade mark was exhibited at an official or officially recognized international exhibition. Such document is certified by the exhibition administration or organizing committee. A translation of such document in the Ukrainian language is submitted either along with the request, or in response to the Office inquiry within the deadline indicated in the official communication.

The said document must include the name of the person who exhibited the goods and/or services, a representation of the trade mark, the list of exhibited goods and/or services which incorporated this mark and the date of open exhibit of the said goods and/or services at the exhibition.

2.1.30. If the trade mark applied for registration incorporates elements mentioned in paragraph 1, Article 6 of the Law, the application must be accompanied with documents evidencing that the applicant has obtained an authorization to use such elements.

2.1.31. If the applicant is an association of person manufacturing goods or rendering services having common characteristics and the application had been filed before the entering of the Law into force, and if the prosecution of this application had not been completed before 1 July 1994, then the application must be accompanied with Regulations governing the use of a collective mark.

The Regulations governing the use of a collective mark must include the following information:

- full name and address of the person who, with the agreement between the applicant, is authorized to apply the trade mark for registration;
- full names and addresses of the persons authorized to use the collective mark;
- terms of use of the collective mark and information on the rights and obligations of the members of the association in case of breach of use terms.

The Regulations governing the use of a collective mark must be signed by all members of the association. The signature and its verification must meet the requirements set forth in paragraph 2.1.19 of the Rules. 2.1.32. If the association, applying their trademark for goods and services with common characteristics after the entering of the Law into force, wishes to register this trade mark as a collective mark, such registration is possible under the provisions of Article 7 bis of the Paris Convention. In this case, the application must be accompanied with the Regulations governing the use of a collective mark, including information mentioned in paragraph 2.1.31 of the Rules.

2.2. Execution of the application papers

2.2.1. The quality of all application papers must ensure that they may be kept for an extended period of time and may be reproduced directly in necessary number of copies.

Every document enclosed with the application must be on a separate sheet. All pages in the application must be consecutively numbered with Arabic numerals.

2.2.2. A request for the registration of a trade mark and the enclosed documents must be submitted in one copy.

If the trade mark is applied for registration in black-and-white, five representations of the trade mark must be provided.

If the trademark is applied for registration in colour, ten representations of the trade mark must be provided.

2.2.3. The list of goods and/or services, for which the trade mark is applied, must be provided on a separate sheet if the list can not fit in the section under the code (511) of the request.

2.3. Filing an international trade mark under the Madrid Agreement

2.3.1. Under Article 1 (2) of the Madrid Agreement and Rule 9 of the Common Regulations under the Madrid Agreement, the international application shall be presented to the International Bureau through the Office.

The functions of the Office of origin for the purpose of registration of trade marks under the Madrid Agreement are laid on RDCPE.

2.3.2. An international application may be filed by a Ukrainian citizen or legal entity, in whose name the trade mark has been registered and entered in the Register.

2.3.3. At the applicant's request, RDCPE shall send the forms necessary for filing the application to his address.

2.3.4. The international application shall relate to one trade mark but it may be based on several registrations of one and the same trade mark

in Ukraine.

2.3.5. The Office, as the Office of origin, accepts international applications in the Ukrainian language.

2.3.6. The data listed in the application shall correspond in full to the data published in the Register.

The Office checks the provided information and confirms their identity with those entered in the Register.

2.3.7. The application shall be accompanied with a receipt confirming payment of the required fees and duties paid in Swiss Francs (Rule 34 of the Common Regulations under the Madrid Agreement).

2.3.8. If the applicant meets all the above-mentioned requirements, RDCPE within the deadline provided for in paragraph (4), Article 3 of the Madrid Agreement shall send the duly executed application to the International Bureau of WIPO, of which it shall duly notify the applicant. The Notification shall show the date of transmission of the application to the International Bureau of WIPO.

2.3.9. The International Bureau of WIPO shall contact the applicants interested in the international registration of the trade mark if the fees have not been paid in full. In this case, the applicant shall be forwarded a notification requesting payment of the additional fees. The receipt confirming such payment shall be send to RDCPE.

3. Correspondence with the Office in the matters of prosecution

3.1. Representation before the Office

3.1.1. For the purpose of representation in the matters of registration, the applicant may appoint an agent either upon filing the application, or at any time after filing, having issued a Power of Attorney executed in accordance with the requirements set forth in paragraph 3.1.4 of the Rules.

The Power of Attorney is enclosed with the application.

3.1.2. The Power of Attorney may relate to one or several applications mentioned therein, either filed or which will be filed by the applicant in future.

If the Power of Attorney was issued for several applications and registrations, each application shall be accompanied with a copy of the Power of Attorney with the indication of the application or registration number, for which the file holds the original Power of Attorney.

3.1.3. Foreign nationals and other persons having their residence or domicile outside Ukraine shall appoint a representative in IP matters to represent them before the Office unless otherwise is provided for by international treaties.

A Power of Attorney for the representation of a foreign national may be issued either by this person or his/her representative if the latter holds a Proxy from the applicant, issued with the right of substitution. In this case, a notarized copy of such Proxy must be submitted with the application. The Office may request to provide a translation of this document.

3.1.4. A Power of Attorney for the representation before the Office must be simply in writing and does not require notarisation.

The Power of Attorney must indicate:

- the name of the authorized representative;
- the scope of powers under the Power of Attorney;
- the date of execution (without this date, the Power of Attorney is invalid).

The Power of Attorney shall be signed by the person who issued the same. If the Power of Attorney was issued by a legal entity, resident of Ukraine, it shall be sealed.

The term of the Power of Attorney issued in Ukraine may not exceed three years.

If the term of the Power of Attorney was not indicated, the Power of Attorney issued in Ukraine shall be deemed valid within one year from the date of its execution.

The Power of Attorney issued outside Ukraine shall be drawn up according to the requirements and be for the term provided for by the laws of the

country of origin.

3.1.5. If the Power of Attorney was issued in the name of several patent attorneys, the application may be handled by any of them and the correspondence shall be sent to the address provided in the request under the code (750).

3.1.6. The Applicant shall be entitled to appoint a representative for certain legal actions and appoint another representative for other legal actions.

3.1.7. The right of the representative to withdraw the application or to register assignments of rights to the application shall be clearly stipulated in the Power of Attorney.

3.1.8. Any action by the representative to which he/she is authorized by proxy shall be taken to constitute an action by the applicant, while any action taken by the Office with regard to the representative shall be taken to constitute an action with regard to the applicant.

3.1.9. The agency evidenced by the Power of Attorney shall be valid as long as the powers remains valid. Withdrawal of the Power of Attorney is made through the submission of a request from the applicant about the withdrawal of the Power of Attorney or cancellation of certain powers. The agency shall be deemed withdrawn as of the date on which the Office received a request from the applicant.

3.1.10. The agency of the new representative, if the latter has been appointed, shall become valid as of the date of receipt of the new Power of Attorney by the Office.

3.2. Correspondence with the Office

3.2.1. Correspondence with the Office with regard to the procedure of registration is made by the applicant or through his authorised representative.

3.2.2. Any documents which are sent to the Office after the filing shall contain the application number if this number is known by the applicant. If the application is not identified based on other information, such documents will be returned to the applicant without further consideration.

3.2.3. The application may be identified if the following is provided:

- copy of the application, or
- representation of the trademark with the indication of the date of filing the application with the Office, provided that the applicant or his/her representative is sure about this date.

3.2.4. Documents which are submitted in the course of prosecution of the application must be submitted within the deadlines provided for by the Law and the present Rules.

If correspondence in the application is made through an authorised representative, the deadline for the submission of documents in response to an official notification of the Office shall be calculated from the date of its receipt by the representative.

3.3. Making corrections, amendments and revisions in the applications and submission of supplementary documents and amendments to the application

3.3.1. The applicant is entitled to make corrections and amendments in the application before the date of receipt of a decision in the application. Corrections and amendments may relate to grammatical and typing errors or obvious deficiencies. Amendments in the application are made based on the applicant's request which shall be accompanied by a receipt for payment of the respective fee and, if necessary, documents which confirm that such corrections and amendments are valid.

3.3.2. Submission of additional documents is made as prescribed by the Law and the present Rules.

The Applicant may submit any supplementary documents which assist the Examiner or support registrability of the trademark.

The supplementary documents received by the Office will be added to the application file.

3.3.3. Supplementary documents which change the subject of the application shall not be taken into consideration in the course of examination, of which the applicant shall be duly notified.

Supplementary documents are considered to change the subject of an application if they relate to any change in the representation of the trademark applied for registration, or if they extend the list of goods and/or services provided in the application. Substitution of a product or service to another one is deemed to constitute an extension of the list of goods and/or services.

3.3.4. Change of the applicant's name and/or his address is made based on the applicant's request or a request filed by his representative. If necessary, the request must be accompanied with documents which confirm the change of the applicant's name. These documents may be:

- certified copies of statutory documents;
- a copy of the certificate of incorporation under the new name;
- an extract from the Register, etc.

A request for the change of the applicant's name, as well as a request for the change of the applicant's address may cover several applications. The request for the change of the applicant's name and/or address shall be accompanied by a receipt confirming payment of the prescribed fee. The prescribed fee shall be paid per each application in which changes

must be made.

3.3.5. A change in the name of a legal entity who, based on the agreement between the applicants is authorized to register the collective mark, or the persons entitled to use the applied collective mark, is recorded based on the addendum to the Regulations governing the use of the collective mark with the payment of the prescribed fee.

3.3.6. Information about the change of the applicant due to merger or demerger of legal entity(-ies) is recorded at the request of the applicant or his successor in title.

Such request shall be accompanied with a receipt confirming payment of the respective fee.

If the change of the applicant resulted from merger, the request shall be accompanied with a document confirming the merger, which shall be either notarized or certified by the issuing authority.

If the change of the applicant's names resulted from demerger of a legal entity or an association of legal entities, the request shall be accompanied with documents which confirm the waiver of rights by those persons who will be excluded from the list of applicants.

3.3.7. The applicant shall be informed about the outcome of his request filed under the provisions of paragraphs 3.3.1-3.3.6 of the Rules within one month after the receipt of this request by the Office.

3.3.8. A record of the change of the applicant due to an assignment of rights to receive a certificate (hereinafter the assignment) is made in the application at the applicant's request.

The request may relate to one application or it may cover several applications, provided that the applicant and successors in title are the same in all these applications.

The request shall mention the application(s) serial number(s), the fact of the assignment and information about the assignee.

The request shall be accompanied with:

- an assignment deed or a notarized extract from the document which contains information about the assignment;
- a receipt confirming payment of the prescribed fee;
- a Power of Attorney issued by the assignee to a representative, if the latter is appointed.

In case of change of one or several applicants in the group of applicants, the assignment deed or another document confirming the assignment shall be accompanied with an approval by the remaining applicant(s) to the change of the list of applicants in the application.

An assignment deed shall include:

- mention of the assignment of rights to receive a certificate from the

applicant to a third person;

- full name or denomination of the assignee and his address in the format defined by paragraph 2.1.8 of the Rules.

The assignment deed shall be signed by the applicant and his successor in title and shall be certified according to the requirements of the country of origin.

If the assignment deed or the document which confirms the assignment was drafted in a language other than Ukrainian, it shall be accompanied with a Ukrainian translation.

The parties to the assignment deed shall be responsible for the validity of information provided for in this agreement.

3.3.9. If the requirements set forth by paragraph 3.3.8 have been met, the change of the applicant will be recorded in the application, of which the applicant and his assignee shall be notified within one month as of the date of receipt of the request for the recordal of the assignment by the Office.

The effective date of the recordal of the assignment shall be the date of the transmission of a notification about the recordal of the assignment to the applicant and his successor in title.

All further correspondence in the application shall be made with the assignee or his representative.

3.3.10. If the requirements set forth by paragraph 3.3.8 have not been met, the applicant and his successor in title shall be either notified of the need to make amendments or corrections in the submitted documents, or that the change of the applicant is not possible for the indicated reasons.

3.3.11. A partial assignment of rights to an application shall be recorded only provided that the Office has set up the procedure for dividing the application.

3.3.12. A request for making changes in the application may be accepted before the date of adoption of a decision on registration of the respective trademark mentioned in such request. If the request was filed after this date, it will be treated as a request for introducing change in the Register.

3.3.13. If the receipt confirming payment of the prescribed fee is missing or the fee was not properly paid, the request for introducing changes in the application may not be accepted, of which the applicant shall be duly notified.

3.4. Obtaining access to the application dossier and materials mentioned in an official communication of the Office

3.4.1. The applicant shall be entitled to get acquainted with all

application documents, as well as materials mentioned in a notification or a decision of the Office. The Office shall forward copies of the documents requested by the applicant within one month as of the date of receipt of the request for these documents.

3.4.2. Under paragraph 2 of Article 12 of the Law, after the publication of the advertisement about the grant of a certificate any person has a right to obtain access to the application documents as set forth by the Guidelines on the procedure of public inspection of trademark application documents and information published in the State Register of Certificate of Ukraine for Trademarks, implemented by the Order No. 163 of the State Patent Office of Ukraine of 9 November 1995 and registered with the Ministry of Justice of Ukraine on 22 November 1995 under serial number 417/953.

3.5. Participation of the applicant in the prosecution of the application

3.5.1. The applicant is entitled, either on his own initiative or upon an invitation of the Office, himself or through his representative to participate in the prosecution of the application if, in the course of examination, necessity arises in providing explanations with regard to application documents or registrability of the applied trademark.

Such participation is carried out upon an invitation of the Office or at the applicant's request.

The applicant's request shall be accompanied with a receipt confirming payment of the expert negotiation fee or expert counsel fee with regard to the filed application as provided for by the Regulations on Providing Services by the State Patent Office of Ukraine, implemented under the Order No. 9 of the State Patent Office of Ukraine on 25 January, 1995 and registered with the Ministry of Justice of Ukraine on 28 February, 1995 under serial number 50/586, as well as revisions and additions to the Regulations on Providing Services by the State Patent Office of Ukraine implemented by the Order No. 211 of the State Patent Office of Ukraine on 16 October, 1996, and registered with the Ministry of Justice of Ukraine on 25 October, 1996 under serial number 627/1652.

3.5.2. Issues which arise in the course of examination shall be subject to notifications of the Office, while questions and additional arguments of the applicant shall be provided in the applicant's request for his participation in the prosecution of the application.

3.5.3. The applicant shall respond to the observations raised in the course of examination and listed in the notification of the Office within two months as of the date of receipt of this notification even if he does not intend to participate in the prosecution himself or through his representative.

The Office shall respond to the applicant's request for his participation in the prosecution of the application with the indication of the date of consideration of the application within one month as of the date of receipt of such request.

3.5.4. The date and time of the applicant's attendance to the consideration of the application shall be pre-approved. In case circumstances change, a party which can not participate in the consideration in the appointed time shall respectively inform the other party about this.

3.5.5. If the Office or the applicant find the mutual consideration of the application to be premature, the Office's proposal or the applicant's request may be rejected.

3.5.6. If the applicant or his representative has appeared before the RDCPE without the prior arrangements, the applicant's request for the participation in the consideration of the application may be rejected.

3.5.7. Participation of the applicant's representative shall be possible based on the Power of Attorney.

3.6. Extensions and reinstatement of missed terms for the submission of documents in response to the Office inquiries

3.6.1. Under paragraph 6 of Article 10 of the Law, a term for the submission of supplementary documents by the applicant in response to the Office inquiry may be extended at the applicant's request.

3.6.2. The reinstatement of the missed terms shall be made by the Office under the provisions of paragraph 12 of Article 10 of the Law.

A request for the reinstatement of the missed terms shall be submitted by the applicant within six months as of the date of the expiration of the missed term.

The request shall be accompanied with a receipt confirming payment of the prescribed fee.

3.6.3. If the requirements set forth in paragraph 3.6.2 of the Rules have been met, the applicant, within two weeks as of the date of receipt of the request by the Office, shall be notified by the latter of the reinstatement of the missed term.

3.6.4. In case the receipt for payment of the prescribed reinstatement fee is missing, the request will be rejected and the applicant shall be duly notified of this.

3.7. Withdrawal of the application

3.7.1. Under Article 11 of the Law, the applicant shall be entitled to withdraw the application at any time before he receives a decision on the registration of the trademark.

The effective date of the withdrawal shall be the date of receipt of the respective request by the Office.

3.7.2. In the withdrawn application can not be taken any legal action, such as:

- examination of the withdrawn application;
- registration of the trademark applied for registration in the withdrawn application;
- the withdrawn application is not taken into consideration in the course of examination of other applications.

3.7.3. The provisions of paragraph 3.7.2 of the Rules shall also be applied to the applications which are deemed to be withdrawn under paragraph 3, Article 8, and paragraph 8, Article 10 of the Law.

The effective date of the withdrawal shall be the date shall be the date of the transmission of the respective notification of the Office to the applicant.

3.7.4. If the application is deemed to be withdrawn and the applicant has documentary proofs that this is an error, the prosecution of the application may be reinstated based on a decision of the Office Administration with the preservation of the filing date.

3.8. Appeal against a decision issued in the application

3.8.1. If the applicant does not agree with any decision of the Office in the application, he may appeal against such decision with the Chamber of Appeals of the Office under Article 15 of the Law.

3.8.2. The appeal shall be filed within three months as of the date of receipt of the respective decisions or copies of the requested documents by the applicant. The appeal shall be accompanied with a receipt confirming payment of the prescribed fee.

3.8.3. The missed term for the submission of the appeal may be reinstated at the applicant's request which shall be filed along with the appeal within six months following the date of expiration of the missed term mentioned in paragraph 3.8.2 of the Rules, provided that the respective fee has been paid as provided for by the Regulations on the Procedure of Payment of Official Fees.

3.8.4. The Appeal shall be examined by the Chamber of Appeals within four months following the date of its receipt pursuant to the provisions of the current Regulations on the Chamber of Appeals of the State Patent Office of Ukraine.

4. Examination of the application for the registration of trademark for goods and services

Examination of an application for the registration of a trademark for goods and services shall consist of the following stages:

- allocation of the filing date;
- formal examination;
- examination of the sign applied for registration as to substance.

4.1. Allocation of the filing date

4.1.1. Applications submitted with the RDCPE are allocated respective filing dates. The registered application may not be returned, and the filing fee is not subject to refund.

4.1.2. For the allocation of the filing date, the application received by the Office shall include:

- request for the registration of the trademark, drafted in an arbitrary form in the Ukrainian language;
- particulars of the applicant and his address in the Ukrainian language;
- representation of the mark applied for registration;
- list of goods or services for which the mark is applied.

4.1.3. Provided that the documents mentioned in paragraph 4.1.2 of the Rules are present in the application, the Office shall issue a decision on the allocation of the filing date.

The decision on the allocation of the filing date shall indicate the application number and particulars of the priority, if the priority was claimed, without the verification of the basis for claiming priority. The said decision shall be sent to the applicant within one month as of the date of receipt of the application by the Office, provided the receipt for payment of the filing and examination fee is present in the application, which meets the requirements set forth by the Regulation on Payment of the Official Fees, and provided that the paid fee is no less than the amount of the fee provided for filing and examination of an application in 1 to 3 classes of the ICGS.

4.1.4. If the receipt for payment of the filing fee is missing in the application, the decisions on the allocation of the filing date shall be sent to the applicant within two weeks following the date of submission of such payment receipt, provided that the amount of the paid fee meets the requirements set forth in paragraph 4.1.3 of the Rules and that the two month term provided for by paragraph 8, Article 7 of the Law has been met.

4.1.5. If the requirements set forth in paragraph 4.1.2 of the Rules have not been met, the applicant shall, within one months following the date of submission of the application documents, be forwarded a notification

requesting the submission of the corrected or missing documents. If, within two months from the date of receipt of this notification by the applicant, the deficiencies are remedied, the filing date shall be allocated based on the date of receipt of the amended or previously missing documents or the last of these documents if they were not filed simultaneously. In this case, the decision on the allocation of the filing date shall be sent to the applicant within two weeks as of the allocated filing date, provided that the fee for filing and examination of the application in 1 to 3 classes of the ICGS has been paid in the amount and within the deadline provided for by paragraph 8, Article 7 of the Law.

If the terms set forth in this paragraph have not been met, the applicant shall be notified that the application is deemed to have not been filed.

4.1.6. If the requirements set forth in paragraph 4.1.2 of the Rules have been met, but the amount of the fee is less than the fee prescribed for the filing and examination of the application in 1 to 5 classes of the ICGS, a decision on the allocation of the filing date shall be issued and the applicant, within two weeks following the date of the submission of the application, shall be forwarded a notification requesting to pay the required extra fees.

If the fees have been paid within the deadline set forth in paragraph 8, Article 7 of the Law, the applicant shall be forwarded a decision on the allocation of the filing date within one month as of the date of the submission of the respective payment receipt with the Office.

4.1.7. If the receipt for payment of the prescribed fee did not arrive at the Office within two months following the filing date as provided for by paragraph 8, Article 7 of the Law, the application shall be deemed to be withdrawn under paragraph 3 of Article 8 of the Law, of which the applicant shall be duly notified.

4.2. Formal examination

Formal examination is meant to ascertain whether the application meets the requirements of Article 7 of the Law and defining the scope of rights applied for by the applicant.

4.2.1. Checking the contents of the application

Under Article 7 of the Law and paragraph 2.1 of the Rules the presence of the following is checked:

- a) request for the registration of the trademark;
- b) indication of the applicant's full name or denomination, as well as address;
- c) representation of the applied trademark;

- d) list of goods and/or services grouped under the classes of ICGS;
- e) required particulars of the representative, if applicable;
- f) copy(-ies) of the previous application(s) if the applicant wishes to benefit from the right of priority under the provisions of paragraph 1 of Article 9 of the Law;
- g) document which confirms that exhibits incorporating the applied trademarks were displayed at an official or officially recognized international exhibition if the applicant wishes to benefit from the right of exhibition priority under the provisions of paragraph 2 of Article 9 of the Law;
- h) receipt for payment of the filing fee, including the examination fee;
- i) Power of Attorney issued to the representative;
- j) translation of the documents or their extracts which are necessary for examination and included in the application, if the said documents were submitted in a language other than Ukrainian.

4.2.2. Checking the application documents for their conformity with the prescribed requirements

The application documents mentioned in paragraph 4.2.1 a), b), c) of the Rules are checked for the compatibility with the requirements of paragraphs 2.1.8 - 2.1.22 of the Rules.

If, in the course of such check, it is found that the request does not meet the requirements, or the particulars mentioned in paragraph 4.2.1 b), c) of the Rules do not meet the prescribed requirements, the applicant shall be forwarded a notification requesting him to correct or amend the application documents. The applicant has two months as of the date of receipt of the notification to submit a response to such notification with the Office.

If the response submitted by the applicant does not contain all the requested information or documents which make further prosecution of the application impossible, the applicant shall be forwarded a second notification, a response to which shall be submitted within two months as of the date of receipt of such second notification by the applicant.

If the applicant fails to respond to the notification of the Office or fails to meet the deadlines for filing a response to the Office notification or to file a reasoned request for their extension, the application will be deemed to be rejected, of which the applicant shall be duly notified.

4.2.2.1. The list of goods and/or services provided in the application shall be checked:

- for correspondence or correlation between the provided names of goods and/or services in the list and those included in the respective classes of the ICGS;

- whether the grouping of the goods and/or services under the respective classes of the ICGS is correct.

4.2.2.2. In the course of the check of the list of goods and/or services, the Examiner shall find whether the list of goods and/or services provided in the application includes the terms which are not mentioned in the ICGS and whether the used terms are sufficiently clear to include the respective goods and/or services into the respective ICGS class.

If any clarifications in the terms used in the list of goods and services are necessary, the Examiner shall be entitled to request necessary clarifications from the applicant or to suggest such clarifications. If the disparity in the list of goods and services can not be eliminated, then the terms suggested by the applicant are considered final.

4.2.2.3. The Examiner shall check whether the goods and services in the application are correctly grouped under the ICGS classes. If the classification of the goods and services is not correct, the Office shall inform the applicant about the reclassification of the goods and services under the ICGS.

In case the classification of the Examiner is different from that of the Applicant, the decision of the Examiner shall be treated as final.

If the number of ICGS classes as determined by the Examiner is larger than those for which the filing fee was paid, the applicant shall be notified of the need to pay the lacking sum or to reduce the number of classes for which the trademark is applied for registration.

A receipt confirming payment of the lacking amount of the official fee shall be submitted within two months as of the date of receipt of the respective notification.

4.2.2.4. The applicant shall have the right, at his own discretion, to reduce the number of ICGS classes within the limits outlined by the Examiner and to determine for what classes the trademark is applied for registration. The applicant shall notify the Examiner of his decision in writing within two months as of the date of receipt of the official notification.

Upon the receipt for payment of the lacking amount of the official fee and a response from the applicant to the official notification, reducing the number of classes, the examination shall be carried out only for those ICGS classes for which the fee had been paid, and they shall be considered in the same order as that provided in the request form, except for the goods and services not included in these classes.

4.2.3. Claiming priority based on an earlier application or based on the use of a trademark as an exhibit at an exhibition

4.2.3.1. If the applicant claims a priority under the provisions of paragraphs 1, 3 of Art. 9 of the Law, the Office shall check:

- whether the applicant has met the three months term for declaring the claim of priority based on an earlier application as set forth in paragraph 3 of Article 9 of the Law;

- whether a copy of the priority application certified by the office of origin was submitted within three months following the filing date. A Ukrainian translation of such application shall be filed either along with the declaration or at the Office request within the term indicated in the official notification;

- whether the six months term calculated from the filing date of the prior application as provided for by paragraph 1, Article 9 of the Law, has been met;

- whether the representation of the applied trademark and the list of goods and/or services correspond to those in the prior application.

4.2.3.2. The priority shall be established for the goods and/or services mentioned in the prior application.

4.2.3.3. For the goods and services which were not mentioned in the prior application the priority shall not be established.

4.2.3.4. If the applicant wishes to maintain the right of priority based on several prior applications which were filed with the respective offices in various member states parties to the Paris Convention (multiple priority), the Examiner shall check whether the submitted copies of the prior applications were duly certified.

4.2.3.5. If the priority is claimed under the provisions of paragraphs 2, 3 of Article 9 of the Law, the Examiner shall check:

- whether the applicant has met the three months term for filing a declaration of priority as provided for by paragraph 3, Article 9 of the Law;

- whether the application contains a document certified by the administration or organization committee of the exhibition, which confirms the display of exhibits incorporating the applied trademark at the official or officially recognized international exhibition, and whether the three months term for the submission of such document has been met. A translation of this document in the Ukrainian language shall be submitted along with the declaration or in response to an official notification before the deadline set forth in the notification for the submission of the translation;

- whether this document indicates the date of the beginning of an open display of the exhibits at the exhibition;

- whether this document indicates the full name or denomination of the exhibitor of the goods and/or services;

- whether the applied representation and the list of goods and/or services correspond to those provided in the document which confirms the display

of the exhibits incorporating the applied trademark at the exhibition;
- whether the six months term set forth by paragraph 2, Article 9 of the Law, which is calculated as from the date of the beginning of the open display at the exhibition, has been met.

4.2.3.6. The priority shall be established for the goods and/or services mentioned in the document which confirms the display of the exhibits incorporating the applied trademark at the exhibition.

For the goods and services which were not mentioned in the document, which confirms the display of the exhibits incorporating the applied trademark at the exhibition, the priority shall not be established.

4.2.3.7. A notification about the establishment of the priority shall be forwarded to the applicant within one month after the expiration of the term for filing a declaration about the establishment of the priority as set forth in paragraph 3 of Article 9 of the Law, provided that the requirements set forth in paragraphs 4.2.3.1, 4.2.3.5 of the Rules have been met.

4.2.3.8. If the documents accompanying the declaration of priority need clarification or additions, the applicant, within one month after the expiration of the term for filing a declaration of priority, set forth in paragraph 3, Article 9 of the Law, shall be forwarded a notification setting out the term for the submission of the clarification and additions.

4.2.3.9. If the applicant fails to meet the terms set forth by Article 9 of the Law and provided for in paragraph 4.2.3.8 of the Rules, or if the documents related to claiming the priority do not meet the requirements set forth in paragraphs 4.2.3.1, 4.2.3.5 of the Rules, the priority right shall be deemed lost, of which the applicant shall be duly notified within one month following the day of expiration of the term for the submission of the necessary documents.

4.2.4. Check of the Power of Attorney

If the application was filed through a patent attorney, which is respectively marked under the code (740) of the request form, or another authorized representative, the Examiner shall check whether a Power of Attorney is present in the application and whether it meets the requirements set forth in paragraph 3.1.4 of the Rules.

4.2.5. Checking supplementary data

4.2.5.1. If the applicant applies for registration of the trademark for goods and/or services which falls under the protection according to the provisions of Article 6 quinquies of the Paris Convention (the rule "telle-quelle"), which is marked, respectively, under the code (390) of the request form, the Examiner shall check whether the application includes a document which confirms the registration of this trademark in the country

of origin.

4.2.5.2. The data provided under the codes (641) and (646) shall be particularly taken into consideration if the trademark is applied for registration in order to expand the list of goods and/or services, as well as if the applicant wishes to obtain re-registration for his trademark under the provisions of Article 22 of the Law.

4.2.5.3. If the trademark is applied for by an association of persons as a collective mark, such trademark shall be checked for the conformity of the Regulations governing the use of a collective mark with the requirements of paragraph 2.1.31 of the Rules.

If the Regulations governing the use of a collective mark do not meet the prescribed requirements, the applicant shall be requested to make amendments or to provide explanations with regard to the Regulations.

4.2.6. If the application meets the requirements set forth in Article 7 of the Law and paragraph 2.1 of the Rules, the Office shall conduct substantive examination of the representation applied for registration as a trademark.

4.3. Substantive examination of a trademark

The goal of substantive examination of the representation applied for registration as a trademark under the provisions of paragraph 7, Article 10 of the Law is to check whether the applied sign meets the requirements of registrability.

The substantive examination consists of:

- checking the sign for the grounds of refusal under the provisions of paragraph 1, Article 5 and paragraphs 1, 2 of Article 6 of the Law;
- checking the sign for the grounds of refusal under the provisions of paragraph 3, 4 of Article 6 of the Law.

4.3.1. Checking the sign for the grounds of refusal under the provisions of paragraph 1, Article 5 and paragraphs 1, 2 of Article 6 of the Law.

4.3.1.1. When checking the sign for the grounds of refusal under the provisions of paragraph 1, Article 5 of the Law, it shall be found: whether the applied trademark may be related to pornographic signs, whether it contains anti-state, racist slogans, emblems and names of extremist organizations, obscene words and expressions, etc.

If the applied sign or at least one of its elements relates to the signs mentioned in the first indent of this paragraph, the prosecution of the application shall be ceased and the applicant shall be notified of the rejection of his application.

4.3.1.2. During the check of the applied sign for the grounds of refusal under the provisions of paragraph 1, Article 6 of the Law, the Examiner

shall establish whether the applied trade mark represent in full state emblems, flags and other emblems; official state names; emblems, abbreviated or full names of international intergovernmental organisations; official signs and hallmarks indicating control and warranty, stamps; rewards and other insignia, or whether it is confusingly similar with them.

The signs mentioned in indent 1 of this paragraph may be included in the trademark as elements subject to disclaimer as set forth in paragraph 1, Article 6 of the Law, provided that an authorization of the competent authority or owners have been secured.

If such authorization is missing in the application, the applicant shall be notified and requested to provide the documents mentioned in paragraph 4.3.3.2 of the Rules.

The document which confirms the right to use the said signs shall be submitted within two months following the date of receipt of the notification of the Office by the applicant.

If the sign applied for registration as a trademark consists in full of the signs mentioned in paragraph 1, Article 6 of the Law, or the applicant did not submit a proof of his right to use such disclaimed elements, the application shall be rejected, of which the applicant shall be duly notified as provided for by paragraph 4.5 of the Rules.

4.3.1.3. In the course of check for the grounds of refusal under the provisions of paragraph 2, Article 6 of the Law, the Examiner shall establish whether the signs:

- a) are devoid of distinctive character;
- b) are terms of general use designating the kind of goods;
- c) are symbols and terms of general use;
- d) designate the kind, quality, quantity, properties, intended purpose, value of goods and services, or the place and time of production or sale of goods or of rendering of services;
- e) are misleading or of such a nature as to deceive the public as to the goods, service or person manufacturing the goods or rendering services.

4.3.1.4. The signs devoid of distinctive character include:

- signs which consist only of one letter, number, line, simple geometric figure which do not have special graphic representation;
- realistic representations of goods if they are applied for registration as trademarks for these goods;
- 3-D objects shaped according to their functions, if such object is applied as a trademark;
- commonly used abbreviation;
- signs which have been used as trademarks in Ukraine by several

manufacturers producing goods which have the same quality or other characteristics, and have become devoid of distinctiveness as individual trademarks for these goods.

4.3.1.5. The signs which are the terms of general use for certain goods include the signs which are used for certain goods and which, due to their long use for the same goods or for the goods of the same kind by different manufacturers, have become specific or generic terms.

4.3.1.6. The signs which are commonly used symbols, in general, include the signs which stand for a field of industry or activities to which belong the goods or services for which the sign is applied for registration as a trademark; conventional symbols used in different fields of science and technology.

The signs, which are commonly used terms, include lexical units specifically used in certain fields of science and technology.

Generic symbols and terms shall become a barrier for the registration of a trademark if such trademark was applied for registration for the goods and services which relate to the same field to which these generic symbols and terms belong.

4.3.1.7. The signs which designate the kind, quality, quantity, properties, intended purpose, value of goods and services, or the place and time of production or sale of goods or of rendering of services include names of goods per se; designations of the quality category of goods; designation of properties of goods, including those of praiseful nature; designation of material or content; designation of weight, volume, price of goods, manufacturing date; historical information with regard to the establishment of the manufacture, representations of prizes awarded to these goods; generic names of enterprises, addresses of manufacturers of goods or dealers.

4.3.1.8. Signs mentioned in paragraph 4.3.1.3 a), b), c), d) of the Rules, may be included in the trademark as elements subject to disclaimer. For this purpose one must analyse semantical and/or special aspects of such element.

When making a decision on the possibility of registration of a trademark including signs mentioned in paragraph 4.3.1.3 a), b), c), d) of the Rules, one must take into consideration all information supporting the registrability of the trademark, in particular the applicant's request to apply the provisions of Article 6 quinquies of the Paris Convention and especially the duration of use of the trademark if such information had been provided by the applicant. If necessary, the applicant may be requested to submit supplementary documents.

If the applied trademark belongs to signs which have been used in Ukraine

by several manufacturers for the goods having common properties, and if it has lost distinctiveness as an individual mark for such goods, the application shall be rejected, of which the applicant shall be duly informed as provided for by paragraph 4.5 of the Rules. If the applicant wishes to benefit from the provisions of Article 7 bis of the Paris Convention, the trademark may be registered as a collective mark with the preservation of the filing date.

In this case, the applicant has to file a request for the registration of the trademark as a collective mark and provide the Regulations governing the use of this collective mark which shall comprise the indication of the persons who have been using the applied trademark over a long period of time and who are entitled to use the collective mark.

4.3.1.9. Misleading signs or those with a likelihood of confusion as to the goods, services of the manufacturer or the person rendering services include signs which bring up associations in consumers with a certain quality, geographical origin of the goods or services, or with a certain manufacturer, which are not real.

The sign may be found to be misleading or likely to be confused when it is obvious that in the course of use of such trademark there is a likelihood of misleading the consumer.

4.3.1.10. If the Patent Office issues a decision on non-registrability of the applied sign as a mark for goods and/or services based on the grounds for refusal according to the provisions of paragraph 4.3.1.3 a), b), c), d), e) of the Rules, the application shall be rejected, of which the applicant shall be duly notified as provided for by paragraph 4.5 of the Rules.

4.3.2. Checking the sign as to the grounds of refusal according to paragraphs 3, 4 of Article 6 of the Law.

4.3.2.1. Under paragraph 3 of Article 6 of the Law, may not be registered signs which are identical or confusingly similar with:

- a) trademarks previously registered or applied for registration in the name of another person and with regard to similar goods and/or services;
- b) - marks of third persons, where such marks are protected without registration under international treaties to which Ukraine is a party:
 - international trademarks protected in Ukraine under the Madrid Agreement;
 - well-known trademarks protected in Ukraine under the provisions of Article 6bis of the Paris Convention for the Protection of Industrial Property;
- c) trade names known in Ukraine and owned by third persons who had acquired their rights in such trade names before the date on which an application for registration of a trademark for similar goods and services was filed with the Patent Office;

d) appellations of origin unless these signs are included in trademarks of persons authorised to use such signs as elements subject to disclaimer;
e) certification marks registered under the established procedure.

4.3.2.2. Under paragraph 4 of Article 6 of the Law, the Office checks whether the applied sign imitates:

a) industrial designs the rights to which belong to third parties in Ukraine;
b) titles of known (well-known) in Ukraine works of science, literature and art, or citations or characters from such works;
c) pieces of art or their fragments without the authorization from the copyrights holders or from their successors;
d) surnames, names, pennames or their derivatives, portraits and facsimile of persons famous in Ukraine without their consent.

4.3.2.3. During the search for identical or similar signs mentioned in paragraph 4.3.2.1 a), b) of the Rules, the following shall not be taken into account:

- trademarks mentioned in paragraph 4.3.2.1 a) of the Rules, for which the period before the date of expiry of the certificate under Article 18 of the Law is less than three years. If this period is less than three years, then these trademarks are searched only for similarity;
- trademarks mentioned in paragraph 4.3.2.1 a) of the Rules, the applications for which are considered to have been rejected or withdrawn based on the provisions of paragraphs 6, 8 of Article 10 of the Law;
- trademarks mentioned in paragraph 4.3.2.1 a), b) of the Rules, certificates for which or international registrations of which were invalidated under Article 19 of the Law;
- trademarks for applications or international registrations, in which decisions of refusal were issued which can no longer be opposed.

During the similarity search among the signs mentioned in paragraph 4.3.2.2

a) of the Rules, the following shall not be taken into account:

- industrial designs patents for which were cancelled under the provisions of Article 24 of the Law of Ukraine "On the Protection of Rights to Industrial Designs";
- industrial designs patents for which were invalidated under Article 25 of the Law of Ukraine "On the Protection of Rights to Industrial Designs".

4.3.2.4. Similarity or identical search

A sign is considered to be identical to another sign if it corresponds to the said sign in all elements.

A sign is considered to be confusingly similar to another sign if, despite of the difference in certain elements, it is overall associated with that other sign.

In order to check identity or similarity, it is necessary:

- to conduct a search for identical or similar signs;
- to determine the degree of similarity of the applied sign and the signs revealed upon the search;
- to determine similarity between the goods and/or services for which the trademark was applied and the goods and/or service for which the similar or identical trademark found during the search was applied.

Among the signs mentioned in paragraphs 4.3.2.1 a), b), c), 4.3.2.2. a) of the Rules, the search shall be performed among those signs which have earlier priority dates.

4.3.2.5. Confirming similarity of goods or goods and services

For the sign applied for registration as a trademark which is examined as to substance and the signs applied for registration and having earlier priority date, the similarity of goods or goods and services shall be assessed.

Upon the check of similarity of goods or goods and services, the likelihood of associating them by the consumer with one person manufacturing goods or rendering services shall be assessed.

When assessing the similarity, one shall take into account the kind of goods and services, their purpose, type of materials from which the goods were manufactured; conditions of sales and trade channels, the circle of customers.

4.3.2.6. Determination of similarity of word signs

Word signs applied for registration as trademarks shall be compared with word and combination signs including word signs in their composition. Upon the assessment of the similarity of word signs, one shall take into consideration similarity in sound (phonetic similarity), similarity in graphics (visual) and similarity in the meaning (semantic similarity).

4.3.2.7. Determination of similarity of figurative and 3-D signs

Figurative and 3-D signs applied for registration as trademarks shall be compared with figurative, 3-D and combination signs the composition of which includes figurative or 3-D elements.

4.3.2.8. Determination of similarity of combination signs

Combination signs applied for registration as trademarks shall be compared with combination signs and with signs incorporated as elements in the combination sign being checked.

4.3.2.9. The sign applied for registration as a trademark shall be rejected in case it is identical or similar with the trademark protected in Ukraine under the provisions of Article 6 bis of the Paris Convention and whose famousness is obvious.

4.3.3. Inquiry about the submission of supplementary materials

4.3.3.1. An inquiry about the submission of supplementary documents shall

be forwarded to the applicant under paragraph 8 of Article 10 of the Law only in case when substantive examination on registrability of the trademark can not be conducted.

4.3.3.2. Grounds for sending an inquiry include the following:

a) the application lacks documents about the consent of the respective competent authorities or owners for the use in the trademark of the signs which represent:

- armorial bearings, flags and emblems;
- official names of States, emblems and full or abbreviated names of international intergovernmental organisations;
- official control, warranty and standard hallmarks, stamps;

b) the application lacks documents which attest the rights of the applicant to official state rewards and other insignias;

c) the application lacks documents confirming the date of establishment of the manufacture, or attesting the rights of the applicant to the rewards or other insignias awarded to the goods which they produce if the applied sign incorporates reference to them. If there are objective grounds for not providing such documents, the applicant shall submit a written testimony about their responsibility for the authenticity of the provided information about the rewards and insignias, or the date of establishment.

4.3.3.3. Other issues, as well as observations and suggestions arising in the course of examination may be included in a notification which shall be sent based on the aforementioned grounds.

4.3.3.4. A notification of the examining authority shall be set forth, in particular, with reference to provisions of the Law, this Rules, other regulations and references.

4.3.3.5. Supplementary materials mentioned in the notification shall be submitted within two months following the date of receipt of the official notification by the applicant.

4.3.3.6. If the applicant fails to meet this deadline and does not submit a motivated request for its extension, then the decision in the application shall be based on the materials present in the case.

4.3.3.7. The missed term may be reinstated at the applicant's request provided that he pays the respective fee within the deadline provided for by paragraph 12 of Article 10 of the Law.

4.3.3.8. If the examiner questions any document or information provided by the applicant, he/she shall be entitled to request necessary proofs from the applicant.

4.4. Decision on the registration of the trademark for goods and services

4.4.1. If the trademark applied for registration is found to meet the

requirements of registrability set forth in paragraph 1, Article 5 and Article 6 of the Law, for all the goods and services for which the mark was applied for registration, the Patent Office issues a decision on the registration of the trademark for all the list of goods and/or services.

4.4.2. If the applied trademark is found to meet the requirements of registrability set forth in article 6 of the Law only for a part of the goods and/or services for which the trademark was applied for registration, the Patent Office issues a decision on the registration of the trademark for a part of the list of goods and services.

4.4.3. If the trademark includes elements subject to disclaimer, which needs to be mentioned in the registration, the decision on the registration may include a standard reference: "(mentioned element) is not subject to individual protection".

4.5. A decision on the rejection and the respective procedure

4.5.1. If the applied trademark is found not to meet the requirements of registrability set forth in Article 6 of the Law for all the list of goods and/or services or its part, the applicant is forwarded a notification providing reasoned arguments which may serve as a ground for the refusal of the trademark in full or with regard to the part of goods and/or services.

4.5.2. Such notification shall include references to the respective provisions of the Law, the Rules and shall include respective references. The said notification may include observations and suggestions. The suggestions may be necessary due to found similar registered trademarks or trademarks earlier applied for registration for all or part of similar goods or services. The applicant may be offered to submit a letter of consent for the registration of the examined trademark, issued by the owner of a registered trademark or a trademark earlier applied for registration.

The Patent Office may offer to have the trademark registered as a collective mark if the examination establishes that such trademark has been used in Ukraine over an extended period of time by several manufacturers of goods having common quality or other characteristics, and if such mark has consequently lost its distinctiveness for these goods as an individual trademark.

4.5.3. The applicant may, within two months following the date of receipt of such notification of the Patent Office, submit a motivated response with arguments supporting the registration, which shall be taken into consideration upon issuing a final decision on the application.

If extra explanations are necessary, the application may be examined with the involvement of the applicant as provided for by paragraph 3.5 of the

Rules.

4.5.4. If the applicant has not submitted a response to the Office's suggestions, a decision shall be taken based on the materials present in the application.

4.5.5. If the arguments provided by the applicant are found to be reasonable, the Patent Office issues a decision on the registration of the trademark as provided for by paragraph 4.4 of the Rules.

4.5.6. If the deadline for the submission of the response has not been met, or the Patent Office does not find the arguments of the applicant to be sufficient, it shall issue a decision on the rejection of the application for all the list of goods and/or services or for its part.

4.6. Registration of a trademark for goods and services and publication of an advertisement about the grant of a certificate

4.6.1. Based on a decision about the registration of a trademark for goods and services and provided that a receipt confirming the payment of the official granting fee has been submitted, the Patent Office performs the state registration of the trademark and introduces it in the Register pursuant to Article 13 of the Law and publishes particulars of the Certificate in its Official Bulletin as provided for by Article 12 of the Law.

4.6.2. The granting fee shall be paid within three months from the date of receipt of the decision on grant by the applicant.

A receipt confirming payment of the fee for the grant of a certificate shall be forwarded to the Patent Office before the expiration of the said three months deadline.

4.6.3. Registration and publication shall be performed by the Patent Office within three months from the date of receipt of the payment document confirming transmission of the registration fee.

4.6.4. If the applicant fails to meet the deadline set forth in paragraph 4.6.2 of the Rules and the Patent Office does not receive a payment receipt confirming the transmission of the granting fee, the Patent Office shall not publish an advertisement and the application shall be deemed to be withdrawn, of which the applicant shall be duly notified.

4.7. Refusal to register an international trademark

4.7.1. As to the trademarks registered under the provisions of the Madrid Agreement, the Patent Office conducts the same examination for registrability according to the provisions of paragraph 1, Article 5 and Article 6 of the Law and according to the requirements set forth in paragraph 4.3 of the Rules as that conducted for national marks applied for

registration in Ukraine.

4.7.2. If the trademark does not meet the requirements of registrability, instead of the notification mentioned in paragraph 4.5.1 of the Rules, the Patent Office shall send a provisional refusal to register the trademark stating reasoned grounds for such refusal, to which the applicant may file a motivated response.

4.7.3. After the Patent Office studies the arguments provided by the trademark owner, it shall issue a final decision about the grant of protection to the trademark in Ukraine with regard to all the list of goods and/or services, or with regard to the part of such goods and/or services, or it shall issue a final decision about the refusal to register this trademark.

4.7.4. Advertisements about international registrations entered in the International Register are published in the Bulletin issued by the International Bureau of the World Intellectual Property Organisation. (the Rules as adopted under the Resolution No. 72 of the State Patent Office of Ukraine, dated 20 August, 1997)