

Law on Trademarks*

(of 1999)

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Chapter I General Provisions

Aim of the Law

1. The Law regulates relations arising in connection with the registration and protection of trademarks, service marks and collective marks and the use of such marks.

Expressions Used in the Law

2. For the purposes of this Law, unless expressly stated otherwise:

(a) “Sakpatenti” means a legal entity governed by public law that provides the legal grounds for the acquisition of rights by natural persons and legal entities in the sphere of intellectual property;

(b) “Paris Convention” means the Paris Convention for the Protection of Industrial Property, signed at Paris on March 20, 1883, as revised at Stockholm on July 14, 1967, and as amended on September 28, 1979;

(c) “Madrid Protocol” means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, signed on June 27, 1989;

(d) “International Classification” means the classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, signed at Nice on June 15, 1957, as revised at Stockholm on July 14, 1967 and at Geneva on May 13, 1977;

(e) “certificate” means the document granted in the name of the trademark holder as provided in this Law, confirming the exclusive rights of the trademark holder;

(f) “application” means the set of documents necessary for the grant of a certificate, compiled in accordance with the prescribed conditions;

(g) “applicant” means the natural person or legal entity requesting the grant of a certificate;

(h) “priority” means the privilege derived from an application filed earlier than the current application;

(i) “Convention priority” means the priority deriving from Article 4 of the Paris Convention;

(j) “exhibition priority” means the priority deriving from Article 11 of the Paris Convention;

(k) “patent attorney” means the authorized person registered at Sakpatenti who is entitled to represent third parties in industrial property matters;

(l) “Chamber of Appeals” means the body at Sakpatenti that considers litigation arising in connection with the acquisition of rights in industrial property subject matter;

(m) “association” means any association of producers established under the legislation of Georgia or its country of origin.

The Trademark

3.—(1) A trademark is a sign or combination of signs that can be represented graphically and is capable of distinguishing the goods or services or both (hereinafter referred to as “goods”) of one undertaking from those of other undertakings.

(2) The sign may be a word or words, including proper names, letters, figures, sounds, a design or a three-dimensional figure, including the shape of goods or their wrapping and also other packaging, including colors or combinations of colors.

(3) The trademark is protected by registration with Sakpatenti or by virtue of international treaties.

(4) Well-known trademarks are protected without registration in Georgia under Article 6bis of the Paris Convention.

Absolute Grounds for Refusal of Registration

4.—(1) A sign or combination of signs shall not be registered as a trademark where it:

(a) does not comply with the provisions of Article 3(2) of this Law;

(b) is not capable of distinguishing the goods concerned; and

(b.a.) consists exclusively of the kind, quality, quantity, characteristics, value, intended purpose, geographical origin, place of sale, time or other characteristics of the goods or can be so regarded;

(b.b.) is widely used as a generic term for the particular type of goods;

(b.c.) represents a widely established trade term or sign for which registration is sought;

(c) irritates or is contrary to national dignity, religious sentiment and traditions and moral standards;

(d) is likely to deceive the public (as to the features, quality, geographical origin or other characteristics of the goods);

(e) completely or in its constituent elements corresponds to the national emblem or the flags, emblem or full or abbreviated names of foreign States; the emblems of intergovernmental or other international organizations or their abbreviated or full names; official control, warranty and test hallmarks, seals, awards; the official or historical names, emblems and State flags of the constituent parts of Georgia; the banknotes of Georgia, or imitations of the foregoing; such a sign may be included in a trademark, as a feature not qualifying for protection, if the permission of the Ministry of Culture or the holder has been obtained.

(2) A three-dimensional sign shall not be registered where its shape:

(a) is determined exclusively by the nature of the goods;

(b) is necessary for a technical result to be achieved.

(3) The provisions of paragraph 1(b) above shall not apply if, before a decision is taken on its registration, a trademark has become distinctive through use in the course of trade in relation to the goods specified in the application.

Relative Grounds for Refusal of Registration

5. A trademark shall not be registered if it:

(a) is identical to another trademark registered for the same goods;

(b) is identical to the trademark of a third party and the goods are identical or so similar as to create a risk of confusion between the marks, including confusion based on association;

(c) is similar to the trademark of a third party and the goods are identical or so similar as to create a risk of confusion between the marks, including confusion based on association;

(d) is identical or so similar to a trademark well known in Georgia so that there is a risk of confusion with it, including confusion based on association; this rule shall apply even where the lists of goods are different;

(e) is identical or so similar to an appellation of origin or geographical indication protected in Georgia that there is a risk of confusion with it, including confusion based on association;

(f) is identical to an industrial design protected in Georgia except where registration of the trademark is sought by the holder of the exclusive rights in the industrial design;

(g) is identical or similar to a third party's trademark enjoying a good reputation in Georgia, and if the use of that identical or similar trademark creates unfair advantages for its applicant or damages the reputation of the protected trademark; this rule shall apply where there are different lists of goods;

(h) includes names, pseudonyms, facsimiles, portraits of persons famous in Georgia without the consent of these persons or their legatees, and if they belong to the history and culture of Georgia without the permission of the Ministry of Culture of Georgia;

(i) includes the names of historical monuments of Georgia or of reproductions thereof without the permission of the Ministry of Culture;

(j) includes a company name that causes a risk of confusion.

Exclusive Rights

6.—(1) The exclusive rights of a trademark owner shall come into being on the date of the registration of the trademark.

(2) The person enjoying exclusive rights may prevent third parties from using a trademark in the course of trade that is:

(a) identical to the protected trademark and relates to the same goods;

(b) identical to the protected trademark and the goods are so similar that there is a risk of confusion, including confusion based on association;

(c) is similar to the protected trademark, and the goods are identical or so similar that there is a risk of confusion of the marks, including confusion based on association;

(d) identical or similar to the protected trademark, and protected on account of the good reputation of the trademark in Georgia, so that the use of the mark affords unfair advantages to third parties or damages the good reputation of the trademark or its distinguishing power.

(3) In the cases provided for in paragraph (2) of this Article it is prohibited:

(a) to print a protected trademark on goods or their packaging;

(b) to offer, place on the market or store for that purpose, import or export the goods bearing the trademark, except where the act is performed with the goods bearing a sign affixed by the person owning the exclusive rights in the mark;

(c) to offer or render services using the trademark;

(d) to use the trademark in advertisements or business papers.

(4) Without the consent of the trademark holder, a third party is prohibited:

(a) from affixing a sign identical or similar to the trademark on packaging materials, labels, tags and the like;

(b) from offering, placing on the market, selling, preparing for sale, importing or exporting packaging material or packaging bearing the mark.

Scope of Exclusive Rights

7.—(1) The person enjoying the exclusive rights in the trademark may not prohibit a third party from using in the course of trade:

(a) his name or address if it corresponds to the trademark of the person having the exclusive rights;

(b) a sign or combination of signs indicating the kind, quality, quantity, characteristics, value, intended purpose, geographical origin, time or place of sale or other features of the goods;

(c) the protected trademark itself, if it is necessary for the goods to be used according to their intended purpose, including where the goods bearing the trademark are used as a component or spare part, provided that the use is made in accordance with fair practice in industrial or commercial matters.

(2) The person enjoying the exclusive rights in the trademark may not prohibit a third party from using the protected trademark on goods that have been brought on to the market by the holder of the trademark himself or with his consent.

This rule shall not apply where the features of the goods have changed, the quality has become worse or there are other important grounds for prohibition.

Reproduction of the Trademark in Reference Books

8. If the reproduction of a trademark in a dictionary, encyclopedia or other informative work gives the impression that it represents the generic term designating the goods for which it has been registered or its registration is sought, the publisher, at the request of the holder of the mark in question, is obliged to mention in the next edition of the reference book that the sign published is a registered trademark.

Chapter II

Acquisition and Maintenance of Trademark Rights

Application for a Trademark Registration

9.—(1) An application for registration shall be filed with Sakpatenti by the applicant or his representative.

(2) The request shall be filed in the Georgian language in accordance with the established rule.

(3) The foreign applicant who is not a resident of Georgia or who has no real business within the territory of Georgia shall conduct his relations with Sakpatenti through a patent attorney registered with Sakpatenti.

(4) The application shall apply to one trademark only.

(5) The application, on being filed with Sakpatenti, must contain:

(a) a request for trademark registration;

(b) the full name and legal address of the applicant;

(c) the representation of the trademark;

(d) the list of the goods for which the registration is sought; it is permissible to submit a list of goods in a foreign language, provided that a Georgian translation of the said list is submitted to Sakpatenti within one month from the filing date of the application;

(e) the name and address of the representative, if the application is filed by him;

(f) the mandatory signature of the applicant or his representative.

(6) All the other necessary data and the list of the documents for examination, the time limits for the filing thereof and other conditions shall be specified in the Regulations.

Date of Filing of the Application with Sakpatenti

10. The day on which the applicant submits an application to Sakpatenti shall be considered the filing date thereof if the application as filed complies with the requirements of Article 9(2) and (5).

Priority

11.—(1) The priority of a trademark is determined by the filing date of the application, provided that the prescribed application fee is paid after filing within a period not exceeding one month thereafter. Where two or more identical trademarks have the same filing date, the priority shall be determined by the starting date of actual use of the trademark.

(2) Trademark priority may be determined by the filing date of the first application in a State party to the Paris Convention (hereinafter referred to as “Convention priority”), provided that no more than six months have elapsed between that date and the filing date of the application with Sakpatenti.

(3) If the applicant for a trademark has displayed the trademark in an exhibit at an official or officially recognized international exhibition held in a State party to the Paris Convention, the priority of the trademark shall be determined by the first day of the exhibition (“exhibition priority”) if he files the application within a period of six months from the date of

the display of the trademark at the exhibition. Exhibition priority and Convention priority shall not be cumulative.

(4) An applicant who wishes to benefit from Convention priority or exhibition priority is obliged to notify Sakpatenti within one month from the filing date of the application with Sakpatenti and, within three months from the said filing date, to present the document confirming his right to claim.

(5) The fees payable under the rule governing Convention priority and exhibition priority shall be paid to Sakpatenti within one month from the filing date of the application.

Examination of the Trademark Application

12.—(1) Sakpatenti shall conduct an examination as to form and a substantive examination of the trademark application.

(2) Sakpatenti is authorized to require of an applicant any additional material needed for the examination. The additional material shall be furnished to Sakpatenti within two months from the date on which the relevant notification is handed to the applicant. If the applicant fails to comply within the said period, the application shall be considered rejected.

(3) Where the list of goods contains two or more names, the application may, at the request of the applicant, be divided before registration of the trademark into two or more applications by redistribution of the goods and services of the first application among the divisional applications, subject to payment of the prescribed fees for those applications. The divisional applications retain the filing date of the first application.

(4) Sakpatenti shall not release information on trademark applications until after priority has been established.

(5) The applicant has the right to:

(a) require suspension of consideration at any stage in the examination of his own application subject to payment of the prescribed fee, but for no longer than three months;

(b) familiarize himself with the material issuing from the examination and require copies thereof;

(c) complete, amend, correct or specify the application material before the application priority is established. After the application priority has been established, such changes may be made only on payment of the prescribed fee, but no later than on the registration of the trademark; if the additional material expands the list of goods or substantially changes the sign presented, the information shall not be taken into account;

(d) withdraw the application before the trademark is registered.

(6) The rules governing the writing and filing of the application, examination, opposition to the examination finding, observance of procedural time limits, extensions and renewals, and also other rules regarding trademark registration, shall be defined by the approved regulation enacted under the legislation of Georgia on the filing of trademark applications and on registration procedure.

Examination as to Form

13.—(1) The examination as to form shall be conducted within two months after the filing of the application or, if the applicant claims Convention priority or exhibition priority, within the term provided for in Article 11(4) of this Law. If the applicant has been sent a

notification requiring additional material, the examination shall be delayed until a response to the notification has been received, but no later than the time limit laid down in Article 12(2) of this Law.

(2) The examination as to form serves to ascertain whether the application has been filed in accordance with this Law.

(3) If the application satisfies the requirements of Article 9(2) and (5) of this Law, a document shall be issued in the name of the applicant specifying the filing date of the application, with a mention of the record number and a list of documents. Otherwise the applicant shall receive a notice of refusal to accept the application with a statement of reasons.

(4) If the application fee is not paid within one month from the filing date of the application, or if an amount less than that payable for one class is paid, Sakpatenti shall take the decision to reject the application. If, within the said period of one month, an amount less than that payable for filing in the number of classes to which the application relates but enough for filing in one class is paid, the examination shall cover the classes specified by the applicant or, if none is specified, the number of classes for which the amount paid is sufficient.

(5) On the basis of the examination as to form, Sakpatenti shall take the decision to accept the application for examination and recognize the priority thereof or to reject the application, and shall notify the applicant accordingly.

Substantive Examination

14.—(1) Substantive examination shall be carried out within six months from the end of the examination as to form.

(2) The substantive examination serves to ascertain whether the sign satisfies the requirements of Articles 4 and 5 of this Law.

(3) On the basis of the substantive examination finding, the applicant shall be sent the decision on the registration or refusal of registration of the trademark for the whole list of goods or part thereof.

Publication

15.—(1) After taking a decision on the registration of a trademark after the substantive examination, Sakpatenti shall within one month publish the trademark data in the Official Bulletin of Industrial Property (hereinafter referred to as “the Bulletin”).

(2) If the applicant makes use of the right defined in Article 16(2), the publication of the application data in the Bulletin shall take place within one month after the Chamber of Appeals has taken the decision.

(3) The following shall be published in the Bulletin: a representation of the trademark, the personal particulars and address of the holder, the list of goods according to the International Classification for which the trademark registration is sought and the priority date of the trademark.

Opposition to the Examination Decision

16.—(1) The decision on the examination as to form may be opposed by the applicant before the Chamber of Appeals within three months after having been taken.

(2) A decision on substantive examination to refuse registration of the trademark in respect of all or part of the list of goods may be opposed by the applicant before the Chamber of Appeals within three months after having been taken.

(3) A decision on substantive examination to register a trademark may be revised by operation of Article 11 of this Law concerning the filing with Sakpatenti of an application having earlier priority.

(4) Within three months from the date of publication of the trademark data in the Bulletin, any concerned party has the right to bring an action before the Chamber of Appeals against the decision on examination to grant registration.

(5) The Chamber of Appeals shall consider the appeal within two months from the date of its filing.

(6) The decision of the Chamber of Appeals can be appealed in a court of law within a year of the decision having been taken.

Trademark Registration

17.—(1) If, after publication of the trademark data, the Chamber of Appeals takes a decision on appeal within three months to register a trademark, Sakpatenti shall enter the trademark in the Register of Trademarks (hereinafter referred to as “the Register”).

(2) The Register shall contain a representation of the trademark, the particulars of its holder, the date of its priority, the date of its registration, a list of the goods grouped according to the International Classification for which the trademark is registered and other information regarding the registration.

(3) Any interested person is authorized, after filing a proper request with Sakpatenti, to familiarize himself with the Register data and, against payment of the prescribed fee, to demand the issue of a certified excerpt from the said Register.

Trademark Certificate

18.—(1) After having entered the data in the Register, Sakpatenti shall grant a trademark certificate.

(2) The certificate shall confirm the registration of a sign as a trademark, the date of the trademark priority, the holder’s exclusive right to the trademark in question and its term of validity.

Recording of Amendments in the Register

19.—(1) Any amendments to the data whose registration is mandatory under Article 17(2) of this Law shall be entered in the Register at the request of the trademark owner or his representative. Where the list of goods is amended, the extension thereof is prohibited. Amendments shall enter into force on registration.

(2) Amendments entered in the Register shall be published in the following Bulletin.

(3) Amendments shall also be recorded on the certificate.

Term of Validity of the Trademark Registration

20.—(1) The term of validity of a trademark registration shall be 10 years counted from the date of registration with Sakpatenti.

(2) The term of validity of a trademark registration may be extended indefinitely by consecutive periods of 10 years. Extension of the term of validity of a registration shall be effected on a request filed by the holder with Sakpatenti, after payment of the prescribed fee. The said request shall be filed with Sakpatenti and the said fee paid in the 10th year of the certificate's validity.

(3) A notice on the extension of the term of validity of a trademark registration shall be recorded on the certificate and in the Register by Sakpatenti, and the relevant information shall be published in the Bulletin.

Re-registration of a Trademark

21.—(1) Re-registration of a trademark shall be prohibited for a year following the expiry of its term of validity, except where the registration is sought by the previous owner of the trademark. This rule shall apply also where the trademark owner renounces the mark before the term of the registration expires. In that case the one-year period shall be counted from the date of trademark nullity.

(2) If, in the case provided for in paragraph (1) of this Article, two or more persons, one of them being the last owner of a given trademark, file applications with Sakpatenti for that trademark on the same date after the aforementioned period has expired, the privilege of registration of the said trademark shall be accorded to the last owner.

Fees

22. Fees specified in the rules enacted under the relevant legislation shall be payable for the examination as to form of a trademark application, for substantive examination, for opposition to the examination decision, for registration, for the recording of amendments, for publication, for the grant of the certificate, for excerpts from the Register, for the delaying of the procedural time limits associated with registration, for renewal and extension and for all other acts in relation to the legal protection of a trademark. The amounts of the fees and the conditions for the payment thereof shall be specified in the rules enacted under the relevant legislation. The amounts of the fees shall be revised periodically in line with international standards, currency exchange rates and inflation.

Trademark Registration Abroad

23. The holder of a trademark registered in Georgia has the right, subject to the observance of the established rules, to file a trademark for registration in another country or effect its international registration.

Chapter III **Use of the Trademark and Assignment of the Rights** **Deriving from Registration**

Use of the Trademark

24. The following shall be considered use of a trademark: its affixation on the goods for which it has been registered and the packaging thereof, on exhibits displayed at exhibitions and fairs, on signs, official forms and labels, its inclusion in advertisements and published works and also other uses, including use both by the owner and by a licensee or third party on the basis of assignment of rights by the owner of the mark. Use of a slightly

different sign instead of the registered trademark shall likewise be considered use of the trademark.

Transfer of the Rights Deriving from Trademark Registration

25.—(1) The rights under a trademark registration may be transferred to another natural person or legal entity on the basis of the rules enacted under the relevant legislation.

(2) The trademark may be transferred to another party with or without the associated business.

(3) The transfer may apply to the full list of goods or to a part thereof.

(4) The transfer of a business shall imply transfer also of the trademark, unless otherwise provided in the transfer contract.

(5) Contracts on trademark transfer shall be executed in writing. Failure to use the written form shall cause the contract to be void.

(6) If it emerges from the transfer documents that a trademark transfer might mislead consumers as to the features, quality or geographical origin of the goods for which it is registered, Sakpatenti shall not enter a record of the transfer in the Register until it receives the transferee's agreement to the withdrawal from the list of goods of those liable to be a cause of confusion.

(7) The trademark transfer documents shall be recorded in the Register and published on payment of the prescribed fees.

(8) The new holder of the trademark may not enforce the rights deriving from registration against a third party until the amendments arising from the trademark transfer have been recorded in the Register.

License Contracts

26.—(1) The right to the use of a trademark may be given by its owner (the licensor) to another person (the licensee) on the basis of a license contract. The license contract may be concluded in relation to the full list of goods or to a part thereof.

(2) The license shall be exclusive or simple.

(3) If the character of the license is not specified in the contract, the license shall be considered simple, in which case the licensor may use the trademark himself or enter into another license contract.

(4) An exclusive license prohibits the licensor from entering into other license contracts and from using the trademark unless otherwise provided in the contract. The rights under the exclusive license shall remain in force throughout the term of validity of the trademark registration unless otherwise provided in the contract.

(5) The licensee is prohibited from assigning the rights under the license contract and from issuing sublicenses, even where not expressly so provided in the contract.

(6) In the case of infringement of the license contract the trademark owner has the right to assert his exclusive rights under this Law in relation to the license if the infringement relates to the term of the contract, the manner of trademark use, the list of the goods for which the license was issued, the territory on which the trademark may be used or the quality of the goods or services rendered.

(7) The trademark license contract shall be registered at Sakpatenti and the relevant information published in the Bulletin on payment of the prescribed fee.

(8) In the case of infringement of the trademark rights the licensee brings action only with the consent of the trademark owner.

(9) The licensee is entitled, with a view to compensation for damages, to participate in court proceedings for infringement of the trademark rights.

(10) The transfer or licensing of the trademark rights shall not cover a license issued earlier in the name of a third party

Chapter IV **Termination of the Exclusive Rights in a Trademark**

Grounds for Cancellation of a Trademark Registration

27.—(1) A trademark registration shall be cancelled by Sakpatenti if:

(a) the trademark owner files a request to that end with Sakpatenti;

(b) when the term of the trademark registration ends, it has not been extended;

(c) on the death of the trademark owner (being a natural person) he has no successor, or a legatee is not appointed, or on the liquidation of the trademark holder where it is a legal entity;

(d) there is an application having the earlier priority provided for in Article 11.

(2) A trademark registration shall be cancelled by the court at the request of a third party if:

(a) the trademark is not used continuously during five years in relation to the goods for which it was registered in Georgia; where use of the mark starts or is resumed during the time between the expiry of the said five-year period and the claim of nullity of the trademark registration, no one may seek cancellation of the said registration;

(b) the trademark has become a generic term with which to designate the goods for which it has been registered;

(c) the grounds provided for in Article 5 of this Law are present;

(d) use of a trademark, by its owner or with his agreement, takes place in such a way that it can mislead a consumer as to the kind, quality, features, value, or geographical origin of the goods.

(3) If there are grounds for cancellation of a trademark in respect of only part of the registered list of goods, the registration shall be cancelled only in respect of that part.

Recognition of Nullity of a Registration

28.—(1) A trademark registration may be recognized by the court as being void at the request of a third party if it has been effected in breach of Article 4 of this Law.

(2) If there are grounds for a trademark registration to be recognized as being void only for part of the registered list of goods, the registration shall be recognized as being void only for the said part, which shall be recorded in the Register and published in the Bulletin.

*Effects of Recognition of the Cancellation or Nullity
of a Trademark Registration*

29.—(1) Where a trademark registration is cancelled under Article 27 of this Law, any rights assigned under the registration shall be considered terminated as of the date of the decision on cancellation of the registration.

(2) Where a trademark registration is considered void under Article 27 of this Law, any rights accorded under the registration shall also be considered void as of the date on which the said rights came into being.

(3) Compensation for damages shall be governed by the Civil Code of Georgia.

**Chapter V
Collective Marks**

Rights in Collective Marks

30.—(1) A collective mark is a sign or combination of signs that qualifies for protection as a trademark, under Article 3 of this Law and distinguishes the goods of the members of an association of owners of the said sign or signs from those of other parties with respect to common qualitative or other features.

(2) The owner of or applicant for a collective mark may only be an association or a legal entity governed by public law.

(3) It is prohibited to transfer or license a collective mark to a party that is not a member of the association.

(4) All the provisions of this Law are applicable to the collective mark, unless otherwise provided in Chapter V of this Law.

Use of Indications of Geographical Origin as Collective Marks

31.—(1) Subject to the condition specified in Article 4(1)(b) of this Law, it shall be exceptionally permissible to register as a collective mark a sign that designates the place of geographical origin of the goods (locality, district, region or country, or any other indication of the geographical origin of the goods).

(2) An indication of geographical origin shall not be used as a collective mark for goods that do not originate in the geographical locality, district, region or country concerned where it would cause confusion as to the origin of the goods.

(3) If the indication of geographical origin includes the special features and quality of the goods, it shall be used as a collective mark only for goods having those features and that quality.

(4) Paragraphs (2) and (3) of the Article shall apply to names, indications and signs that are similar to the indication of geographical origin.

Regulations Governing the Use of Collective Marks

32.—(1) An application for a collective mark shall comply with the requirements of Article 9 and be accompanied by the regulations governing the use of the collective mark.

(2) The regulations governing the use of the collective mark shall include:

- (a) the name and address of the association;
 - (b) the names and legal addresses of the members of the association;
 - (c) the aim of the association;
 - (d) the conditions governing the use of the collective mark and overseeing that use;
 - (e) the rights and obligations of the members of the association regarding infringement of the rights in the collective mark;
 - (f) a list of the goods and common characteristics for which the collective mark is intended.
- (3) If the collective mark contains a geographical name, the regulations governing the use of the mark must provide that any party whose goods originate within the geographical region so named, and who meets the conditions for use of the mark laid down in those regulations, has the right to become a member of the association and use of the mark.
- (4) Any interested person is entitled to inspect the charter of the collective mark.

Examination of the Application

33. As well as on the grounds for refusal of registration given in Articles 4 and 5, an application for registration of a collective mark may be rejected if it does not meet the requirements specified in Article 30(1) and (2) of this Law, except where the applicant corrects the said regulations in such a way that the grounds for refusal of the registration no longer exist.

Limits of Collective Mark Protection

34. The registration of a geographical name as a collective mark does not entitle its holder to prevent a third party from using the name in the course of trade, provided that the use is made in accordance with the standards of fair competition and the third party has reasonable justification for the use of the name.

Appeal

35.—(1) A person entitled to use a collective mark has the right to bring an action for infringement of the right to the use of the collective mark only with the permission of the association of holders of the mark, unless otherwise provided in the regulations governing the use of the mark.

Amendments to the Regulations Governing the Use of a Collective Mark

36.—(1) The holder of a collective mark is obliged to notify Sakpatenti of any changes made in the regulations governing the use of the collective mark.

(2) Where making amendments in collective mark regulations, the requirements of Articles 31 and 32 shall be taken into account.

Cancellation of the Registration of a Collective Mark

37. The registration of a collective mark may be cancelled:

- (a) pursuant to Article 27 of this Law;

(b) if the holder of the collective mark uses the mark in breach of the regulations governing its use.

Nullity due to the Absolute Grounds for Refusal of Registration

38. As well as on the grounds given in Article 28 of this Law, a collective mark registration may be considered null and void if it has been registered in breach of the requirements of Article 33 of this Law. If the grounds for the annulment concern the rules for the use of the collective mark, the registration shall not be considered null and void if a collective mark holder amends the regulations in such a way that the grounds for its annulment no longer exist.

Chapter VI
Protection of Trademarks in Accordance with the Protocol
Relating to the Madrid Agreement Concerning the
International Registration of Marks

Application for International Registration of a Trademark

39.—(1) This Law applies to trademarks to be registered in accordance with the Madrid Protocol, unless otherwise provided in Chapter VI of this Law or in the Madrid Protocol.

(2) The application for the international registration of a trademark shall be filed with Sakpatenti in accordance with Article 3 of the Madrid Protocol.

(3) The application shall be completed with an English translation of the list of goods grouped according to the International Classification.

Recording of the International Registration

40.—(1) If international registration is effected on the basis of an application filed with Sakpatenti, the date and number of the international registration shall be recorded in the application data.

(2) If international registration is effected on the basis of the registration granted on the basis of an application at Sakpatenti, the date and number of the international registration shall be entered in the Register.

(3) If international registration is effected as provided in paragraph (1) of this Article, the date and number of the international registration shall be recorded in the Register after registration of the trademark at Sakpatenti.

Examination of the Application for International Registration
of a Trademark

41.—(1) In relation to an application for international registration of a trademark only the substantive examination shall be conducted in accordance with Article 14 of this Law.

(2) The terms “refusal of registration”, “cancellation of the registration” and “annulment of the registration” used in Articles 14, 27, 28, 37 and 38 for the application for the international registration of trademarks shall be replaced by the terms “refusal of protection” and “annulment of protection”.

Publication and Appeal

42.—(1) The particulars of the international registration of a trademark shall be published in the *WIPO Gazette of International Marks* published by the International Bureau of the World Intellectual Property Organization (WIPO).

(2) When the decision is taken, after substantive examination, on the international registration of the trademark, the date and number of the international registration shall be published in the Bulletin within one month of the taking of the decision.

(3) The opposition period provided for in Article 16(4) of this Law shall be calculated from the day of publication of the date and number of the international registration of the trademark.

Annulment of Protection for Non-Use

43. If owing to failure to use the trademark there are grounds for annulment of the protection provided for in Article 27(2)(a), the date of the international registration shall be replaced by the date on which the period specified in Article 5(2) of the Madrid Protocol expires.

Conversion of the International Registration into a National Application

44.—(1) In accordance with Article 9*quinquies* of the Madrid Protocol, on the filing of a national application on the basis of an annulled international registration, the applicant must, together with the application, file the document certified by the International Bureau of WIPO confirming that the international registration applied to Georgia before it was annulled.

(2) If on the filing date of the application with Sakpatenti the periods specified in Article 5(2) of the Madrid Protocol have not expired and no decision on refusal of protection has been taken, the trademark shall be registered under this Law without examination or publication.

Chapter VII Enforcement of Protection of Exclusive Trademark Rights

Liability for Infringement of Exclusive Trademark Rights

45.—(1) Infringement of exclusive trademark rights incurs liability under the legislation of Georgia.

(2) Where his exclusive rights are infringed the holder of the trademark may apply to the court seeking:

(a) prevention of the acts that infringe his rights;

(b) compensation for damages;

(c) destruction of all labels, pictures, imprints, packaging, packaging materials and advertisements that contain the registered trademark or a copy, semblance or imitation thereof;

(d) destruction of the plates, matrices and printing blocks prepared for making the trademark and, if separation of the trademark from the goods is impossible, destruction of the goods.

Chapter VIII **Transitional Provisions**

Applications Filed and Certificates Granted Prior to the Entry into Force of this Law

46.—(1) Applications for the registration of trademarks filed prior to the entry into force of this Law shall be considered in accordance with Resolution N304 of the Cabinet of Ministers of Georgia of March 16, 1992, “Approving and Enacting the Statute on Trademarks”.

(2) Certificates granted for trademarks registered before this Law enters into force shall remain in force thereafter.

Chapter IX **Final Provisions**

Legislation Repealed

47.—(1) On the entry into force of this Law the following shall be considered repealed:

(a) Resolution N304 of the Cabinet of Ministers of Georgia of March 16, 1992, “Approving and Enacting the Statute on Trademarks”.

(b) Resolution N483 “Additional Measures for the Regulation of Trademark Use in Georgia”, approved by the Cabinet of Ministers of Georgia on June 25, 1993.

Entry into Force of the Law

48. This Law shall enter into force three months after its publication.

* *English title.*

Entry into force: May 25, 1999.

Source: Communication from the Georgian authorities.

Note: English translation furnished by the national authorities and edited by the International Bureau of WIPO.

** Added by the International Bureau of WIPO.