

**Chapter I - General Provisions**

**Article 1 - Purpose of the Law**

This Law regulates relationships concerning the registration, protection and use of trade, service and collective marks.

**Article 2 - Definition of terms used in the Law**

The terms used in this Law have the following meanings:

- a) the National Intellectual Property Centre Sakpatenti ('Sakpatenti') - the legal entity under public law determined by the Patent Law of Georgia;
- b) Paris Convention - the Paris Convention for the Protection of Industrial Property, signed in Paris, France on 20 March 1883 (revised in Stockholm, Sweden on 14 July 1967, and amended on 28 September 1979);
- c) Madrid Protocol Treaty - the Madrid Protocol Treaty for the international registration of trademarks, signed in Madrid, Spain on 27 June 1989;
- d) international classification - the international classification of goods and services approved on the basis of signing the Nice Agreement on 15 June 1957 (revised in Stockholm, Sweden on 14 July 1967, and in Geneva, Switzerland on 13 May 1977);
- e) certificate - a document issued in the name of a trademark holder in accordance with this Law certifying the exclusive rights of its holder;
- f) application - a set of documents necessary for issuing certificates that are drafted in accordance with the set requirements;
- g) applicant - a natural or legal person applying for a certificate;
- h) priority - a preference that is given to an application as compared with one that has been submitted earlier;
- i) convention priority - the priority established in accordance with Article 4 of the Paris Convention;
- i) exhibition priority - the priority established in accordance with Article 11 of the Paris Convention;
- k) (deleted);
- l) Chamber of Appeals - the agency that considers litigations in relation to disputes arising in connection with the acquisition of industrial property rights;
- m) association - any association of entrepreneurs established under the legislation of Georgia or of its country of origin;
- n) unprotected elements of a trademark -- an element of a trademark to which exclusive rights of holders do not apply.
- o) the goods bearing a sign affixed by violation of exclusive rights to a trademark – the goods containing an identical or similar sign of a registered trademark or bearing an identical or similar sign of a registered trademark, or having an identical or similar form of a registered three-dimensional trademark and the production, the import to the territory of Georgia, the storage, the inclusion in civil circulation of which, or for this purpose, the storage of which (the placement for temporary storage) and/or any other use thereof results in the infringement of the exclusive right of the holder of the registered trademark, irrespective of the place of marking.



*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*

*Law of Georgia No 3159 of 28 June 2010 - LGH I, No 35, 12.7.2010, Art. 206*

*Law of Georgia No 1922 of 23 December 2017 - website, 11.1.2018*

### **Article 3 - Trademark**

1. A trademark is a sign or any combination thereof represented graphically that is capable of distinguishing the goods and/or services of one company from those of another.
2. A sign may be a word or words, including personal names; letters; numerals, sounds; images; 3D figures, including shapes of goods or of their packaging, as well as any other decorations of goods using colour or any combination thereof.
3. Trademarks are protected on the basis of their registration with the Sakpatenti or on the basis of international agreements.
4. Well-known trademarks in Georgia are protected without registration, in accordance with Article 6<sup>bis</sup> of the Paris Convention. A trademark shall be recognised as well-known by the Chamber of Appeals of the Sakpatenti or by a court within the scope of its authority, upon the request of persons concerned.

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*

### **Article 4 - Absolute grounds for refusal of trademark registration**

1. A sign or a combination thereof shall not be registered as a trademark if:
  - a) it does not meet the requirements of Article 3(1) of this Law;
  - b) it is a single non-styled (standard) letter or numerical, or only a colour;
  - c) it is not capable of distinguishing appropriate goods
  - d) it is a descriptive mark of goods for which registration thereof is requested, and which consists of signs that are designators of the kind, quality, quantity, properties, value, intended purpose, geographical origin, place of sale, the time of production or any other characteristics of the goods and/or if it is considered as such;
  - e) it has come into universal use as a generic concept of a definite type of goods;
  - f) it is a universally accepted term or a sign characteristic to the goods included in the course of trade the registration of which is required.
  - g) it abuses or contradicts national values, religion, traditions or moral standards;
  - h) it is of such nature as to deceive consumers with regard to the properties, quality, geographical origin or any other characteristic of the goods;
  - i) it coincides, fully or in one of its constituent elements, the national coat of arms, the flag, or the emblem, the full or abbreviated name of a foreign country; an emblem, the full or abbreviated name of an international or intergovernmental organisation; an official check mark, a seal of guarantee, hallmark, sign (including certification marks of conformity of goods), a seal, a national decoration or a medal; the current or historical name of Georgia or its territorial unit, its coat of arms, flag, emblem or monetary symbol, or is an imitation of symbols under this sub-paragraph. The above symbols are included in a trademark as an unprotected part if there is a consent of the Ministry of Education, Science, Culture and Sport of Georgia or of its proprietor for using this symbol.
2. A three-dimensional mark shall not be registered as a trademark if its shape:



a) results from the nature of the goods themselves;

b) is necessary for the achievement of technical results.

3. Sub-paragraphs (c), (d), (e), (f) and (g) of the first paragraph of this article shall not apply if, before making a decision to register a trademark, and as a result of its use in the course of trade, the trademark has already been accepted as a distinctive sign for the goods specified in the application .

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*

*Law of Georgia No 4556 of 25 November 2015 - website, 8.12.2015*

*Law of Georgia No 1636 of 7 December 2017 - website, 14.12.2017*

*Law of Georgia No 3054 of 5 July 2018 - website, 11.7.2018*

### **Article 5 - Relative grounds for refusal to register a trademark**

A trademark shall not be registered if:

a) it is identical with the trademark of goods that have been registered earlier;

b) it is identical to a trademark that has been registered earlier in the name of a third person, or if because of the similarity of the goods there is a likelihood of confusion, including the likelihood of confusion as a result of association of these trademarks;

c) it is similar to a trademark having been registered earlier in the name of a third person, or if because of the similarity of the goods there is a likelihood of confusion, including the likelihood of confusion as a result of association of these trademarks;

d) it is identical to or so similar to a trademark that has been universally accepted in Georgia before applying for its registration that because of the similarity there is a likelihood of confusion, including the likelihood of confusion as a result of association of these trademarks; This rule shall also apply when listings of the goods are different;

e) it is identical with or similar to a geographical indication or an appellation of origin protected in Georgia, or if it consists thereof, or there is a likelihood of confusion, including the likelihood of confusion as a result of association therewith, and if the registration of a trademark is requested for identical or similar goods, and/or if the application of such trademark results in the use of reputation of a protected geographical indication or appellation of origin. This sub-paragraph shall not apply if a geographical indication or an appellation of origin is included as an unprotected part of the trademark of a person who is entitled to use it;

f) it is identical with an earlier industrial design protected in Georgia, except when a trademark registration for this design is requested by a person holding exclusive rights for the use of this industrial design;

g) it is identical with or similar to a trademark registered earlier in the name of a third person who has a good reputation in Georgia, and if the use of this trademark undeservedly creates favourable conditions for an applicant or damages the reputation of a protected trademark. This rule shall also apply when listings of goods are different;

h) it contains the name, pseudonym, facsimile or portrait of a person who has been famous in Georgia before applying for the registration – without the permission of the person or his/her heirs, and if these are historical and cultural property of Georgia – without the consent of the Ministry of Education, Science, Culture and Sport of Georgia;

i) it contains the names or image of a historical monument of Georgia – without the consent of the Ministry of Education, Science, Culture and Sport of Georgia.

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*

*Law of Georgia No 4556 of 25 November 2015 - website, 8.12.2015*

*Law of Georgia No 1636 of 7 December 2017 - website, 14.12.2017*



## Article 6 - Exclusive rights

1. The exclusive rights of a proprietor in a registered trademark shall arise from the date of registration of the trademark.
2. A person holding exclusive rights shall be entitled to prevent a third party from using a trademark in the course of trade without his/her permission if, with regard to the protected trademark of the person holding exclusive rights, this trademark:
  - a) is identical and the goods are also identical;
  - b) is identical and the goods are so similar that there is a likelihood of confusion due to the similarity, including the likelihood of confusion as a result of association;
  - c) is similar and the goods are identical or so similar that there is a likelihood of confusion due to the similarity, including the likelihood of confusion as a result of association;
  - d) is identical or similar and protected due to the good reputation of the trademark in Georgia, and the use of this trademark undeservedly creates favourable conditions for a third party, or damages the reputation or distinctiveness of the trademark.
3. In instances provided for in the second paragraph of this article, the following shall be prohibited, in addition to any other potential prohibitions:
  - a) to affix a trademark to the goods or to the packaging thereof;
  - b) to offer the goods, to put them in the course of trade or to stock them for these purposes, to import or export the goods under this sign, except when such action is performed for the goods bearing a sign affixed by a person holding exclusive rights thereto;
  - c) to offer or provide services using a trademark;
  - d) to use a trademark in advertising or on business papers.
4. Without the permission of trademark holder, a third party shall be prohibited to:
  - a) affix a sign identical or similar to this trademark to packaging materials, labels, etc.;
  - b) offer, put into the course of trade, sell or prepare for sale, and import or export packaging materials or packaging bearing a sign identical or similar to this trademark.

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*

## Article 7 - Scope of exclusive rights

1. A holder of exclusive rights in a trademark shall not be authorised to prevent a third party from applying the following as a trademark in the course of trade:
  - a) a personal name or address if it coincides with the trademark of the person holding exclusive rights;
  - b) a sign or any combination thereof that is a designator of the kind, quality, quantity, properties, value, intended purpose, geographical origin, place of sale, the time of production or any other characteristic of the goods;
  - c) a protected trademark, if it is necessary to use the goods for the intended purpose, including when the goods bearing this trademark are used as component or replacement parts.
  - d) in this case, a third person shall use a protected trademark adhering to the principles of honesty in industrial activities.



2. A holder of exclusive rights in a trademark shall not be authorised to prevent a third party from using a protected trademark for goods that have been put into the course of trade directly by a trademark holder or with his/her permission. This rule shall not apply if the properties of the goods have changed, the quality has deteriorated or if there are any other significant grounds for prohibition.

#### **Article 8 - Publication of a trademark in reference literature**

If the reproduction of a trademark in a dictionary, encyclopaedia or in any other reference literature creates the impression that the trademark represents a generic concept for the goods for which it has been registered, or the registration of which is requested a publisher, upon request of the holder, is obliged to note in subsequent editions of the said reference literature that the published sign represents a registered trademark.

### **Chapter II - Acquisition and Retention of Exclusive Rights in a Trademark**

#### **Article 9 - Application for the registration of a trademark**

1. Applications for the registration of trademarks shall be submitted to the Sakpatenti by applicants or their representatives.
2. Applications shall be completed in accordance with established procedures, in the Georgian language.
3. (Deleted).
4. A single application shall be completed for each trademark.
5. An application shall include:
  - a) a request for registration of the trademark;
  - b) the full name (title) and legal address of an applicant;
  - c) an image of the trademark;
  - d) a listing of goods for which the registration of a trademark is requested. The listing of goods may be submitted in a foreign language as an attachment provided that a Georgian translation of the listing is submitted to the Sakpatenti within one month after the date of filling the application;
  - e) the identity and address of a representative if an application has been filed by a representative;
  - f) the signature of an applicant or his/her representative.
6. A list of other data and documents necessary for the examination of applications, and terms and conditions for the submission thereof shall be defined by the legislation of Georgia.

*Law of Georgia No 3159 of 28 June 2010 - LGH I, No 35, 12.7.2010, Art. 206*

#### **Article 10 - The date of filing an application with the Sakpatenti**

The date of filing an application with the Sakpatenti shall be the day when the application was submitted to the Sakpatent' if the application complies with the requirements provided for in Article 9 (2) and (5) of this Law.



## **Article 11 - Priority**

1. A right of priority for a trademark shall be established on the date of filing an application, if the fee prescribed for the examination of formal requirements for the application is paid not later than one month after filing the application.
2. A right of priority for a trademark may be established on the date of filing the first application in a state that is a party to the Paris Convention (convention priority) if not more than 6 months have elapsed from this date to the date of filing the application with the Sakpatenti
3. A right of priority for a trademark used for exhibits displayed at official international exhibitions or at international exhibitions that are considered to be official, and that are organised by states that are parties to the Paris Convention, shall be established on the first day of the exhibition (exhibition priority) if not more than 6 months have elapsed from the date of their display to the date of filing the application with the Sakpatenti Exhibition and convention priorities shall not extend each other's validity.
4. Applicants intending to use convention or exhibition priorities are obliged to notify the Sakpatenti about their intentions within one month after the date of filing an application and to submit documents certifying the right to request such priorities within three months after the date of filing the application.
5. Fees for requesting convention or exhibition priorities as prescribed by established procedures, shall be payable within one month after the date of filing an application with the Sakpatenti.
6. If there is one and the same priority established for several trademarks, preference shall be given to the trademark, the actual use of which has started earlier in the territory of Georgia

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*

## **Article 12 - Examination of applications for trademarks**

1. Examination of formal requirements with regard to applications for trademarks and their substantive examinations shall be conducted by the Sakpatenti.
2. The Sakpatenti may request an applicant to submit additional materials for conducting the examination. Additional materials shall be submitted to the Sakpatenti within two months after the date of an appropriate notice thereof has been delivered to the applicant. In case there is a failure to keep to this time limit, the Sakpatenti shall refuse to review the application.
3. Upon the request of an applicant, and before the registration of a trademark, an application containing two or more names of goods may be divided into two or more applications by way of distributing the goods stipulated in the first application between two or more applications after the fee prescribed by established procedures is paid. The date of filing the first application shall be retained for the applications as a result of the division.
4. The Sakpatenti shall release information about applications for trademarks only after the priorities thereof are determined.
5. An applicant shall be authorised to:
  - a) request the suspension of review of his/her application at any stage of examination after the payment of a prescribed fee is made. A total period of suspension shall not exceed three months;
  - b) review materials used during the examination and request copies of them;
  - c) complete, change, amend or verify application materials before the application priority is established. After the priority is established, said amendments shall be allowed only after the prescribed fee is paid, but not later than the date of registration of the trademark. However, when trademarks are changed, only minor changes may be allowed that do not expand the scope of trademark protection, and when a list of goods is changed, only a limitation or specification of the list may be allowed;
  - d) withdraw the application before the registration of a trademark;
  - e) reopen prosecution after payment of a prescribed fee is made. Reopening of prosecution may be allowed if the termination thereof took place before the publication of application data, in accordance with Article 15 of this Law.



6. Procedures for preparing, filing and examining applications, and appealing the expert's opinion on examination, as well as procedures for suspending, extending and restoring procedural periods, and any other procedures related to the registration of trademarks shall be defined by the specification on 'Procedures for the Submission of Trademark Applications and for their Registration' issued by the Chairperson of the Sakpatenti in accordance with the procedure established by the legislation of Georgia.

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*

*Law of Georgia No 3743 of 26 October 2010 - LGH I, No62, 5.11.2010, Art. 383*

### **Article 13 - Examination of formal requirements for applications**

1. An examination of formal requirements for applications shall be conducted within two months after filing of the application, but if applicants request convention or exhibition priority, the examination shall be conducted within the period provided for in Article 11(4) of this Law. If a notice of requesting additional materials has been sent to an applicant, the examination shall be suspended until a response to the notice is received, but not later than the time limit provided for in Article 12(2) of this Law.
2. The examination of formal requirements shall ascertain whether applications are registered according to this Law.
3. If an application meets the requirements of Article 9 (2) and (5) of this Law, a certificate shall be issued in the name of an applicant regarding verification of the date of filing application, indicating the record number and a list of filed documents. Otherwise, the applicant shall be notified about reasonable refusal to accept his/her application materials.
4. If within one month after filing an application, the fee prescribed by the established rule for an examination of formal requirements is not paid, or if the paid amount is less than the amount prescribed for presenting a single class of goods, the Sakpatenti shall decide not to review the application. If within this time limit an amount is paid which is less than the amount established for presenting the classes of goods under the application, but is sufficient for presenting at least one class of goods under the application, the examination shall be conducted for the classes of goods specified by an applicant, but if there is no class of goods specified, the examination shall be conducted for those classes of goods that are in order of priority for which the amount has been completely paid.
5. On the basis of an examination of formal requirements, the Sakpatenti shall make a decision to accept the application for review and to verify priorities, or to refuse to accept the application for review, and shall notify the applicant thereof.

### **Article 14 - Substantive examination**

1. A substantive examination shall be conducted within six months after the examination of the formal requirements is completed.
2. A substantive examination it shall verify if there are grounds provided for in Articles 4 and 5 of this Law for refusing the registration.
3. On the basis of a substantive examination, a decision on the registration of the trademark shall be sent to an applicant or on the refusal to accept the trademark for registration with regard to a complete list of goods or of a part thereof.

*Law of Georgia No 1922 of 23 December 2017 - website, 11.1.2018*

### **Article 15 - Publication**

1. Within one month after making a positive decision on a trademark registration on the basis of a substantive examination, the Sakpatenti shall publish the application data in the Official Bulletin of Industrial Property (the Bulletin).
2. If an applicant enjoys the right provided for in Article 16(2) of this Law, the Sakpatenti shall publish the application data in the Bulletin within one month after the date of making the appropriate decision by the Chamber of Appeals.

<sup>1</sup>. If on the basis of a substantive examination a negative decision on a trademark registration with regard to a complete list of



goods or a part thereof is changed into a positive decision on the basis of an enforceable court ruling, the Sakpatenti shall publish the application data in the Bulletin.

3. A trademark image, particulars and an address of a holder, a list of goods grouped according to the international classification for which a trademark registration is requested, and a trademark priority shall be published in the Bulletin.

4. From the date of publishing a trademark application to the date of its registration, an applicant shall be provisionally granted the same rights that would have been granted to him/her after the registration. If the trademark has not been registered, the said rights shall not be construed as conferred.

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*

*Law of Georgia No 3159 of 28 June 2010 - LGH I, No 35, 12.7.2010, Art. 206*

### **Article 15<sup>1</sup> - Accelerated registration procedure for a trademark**

1. During an accelerated registration procedure for a trademark, the rules under Chapter II of this Law shall be applied unless otherwise determined by this article.

2. When filing an application or within one month after filing an application, an applicant may request an accelerated examination of the application.

3. All documents defined in Article 9 of this Law shall be attached to the application for accelerated examination, and a power of attorney, if any, and fees prescribed for accelerated examination of the trademark application and for the trademark registration shall be paid.

4. If an applicant intends to use the priority defined in Article 11(2) and (3) of this Law or in Article 9 *quinquies* of the Madrid Protocol Treaty, the application for accelerated examination a document certifying the entitlement to priority shall be attached, and a fee payable for requesting the priority shall be paid.

5. Within three days after an accelerated examination is requested, the Sakpatenti shall verify whether the application complies with the requirements of paragraphs 3 and 4 of this article. If any document required by paragraphs 3 and 4 of this article is missing, the applicant is obliged to submit the missing document within 15 days. Otherwise, the Sakpatenti shall make a decision to refuse to conduct an accelerated examination and shall review the application in accordance with the procedures prescribed under Chapter II of this Law.

6. If an application for accelerated examination meets the requirements paragraphs 3 and 4 of this article, the Sakpatenti shall, within seven working days, determine if there are grounds to refuse registration of the trademark provided for in Articles 4 and 5 of this Law, and if a positive decision is made, it shall register the trademark in the Trademark Registry, publish data on the registered trademark in the Bulletin and shall issue a certificate.

7. Within three months after publication of trademark registration data in the Bulletin, any concerned person may file an appeal with the Chamber of Appeals requesting cancellation of the trademark registration on the ground that the requirements of Articles 4 and 5 of this Law have not been fulfilled.

8. If after the registration of a trademark through an accelerated procedure, an application for the right to use an earlier priority is filed with the Sakpatenti, and if, with regard to trademarks registered through the accelerated procedure, there are grounds provided for in Article 5 of this Law to refuse registration of the trademark, the Sakpatenti shall make a decision to cancel the trademark registration performed through the accelerated procedure and shall publish information in the Bulletin.

9. A decision to cancel a trademark registration performed through an accelerated procedure shall be appealed according to the procedures provided for in Article 16(2) of this Law.

*Law of Georgia No 3159 of 28 June 2010 - LGH I, No 35, 12.7.2010, Art. 206*

### **Article 16 - Filing an appeal to the Chamber of Appeals against a decision of the examination**





1. An applicant may file an appeal with the Chamber of Appeals against a decision of the examination of formal requirements for refusing to review the application within three months after such decision is made.
2. An applicant may file an appeal with the Chamber of Appeals against a decision of substantive examination on refusing a trademark registration with regard to a complete list of goods or a part thereof, within three months after such decision is made.
3. (Deleted).
4. Within three months after the publication of application data in the Bulletin, any concerned person may file an appeal with the Chamber of Appeals against the decision made with regard to trademark registration on the grounds that the requirements of Article 4 or 5 of this Law are not met. However, a decision on a trademark registration made on the basis of a court judgement may not be appealed on similar grounds to the Chamber of Appeals.
5. The Chamber of Appeals shall examine an appeal within three months after the date of its filing.
6. A decision of the Chamber of Appeals may be appealed in court.

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*

#### **Article 17 - Registration of trademarks**

1. If a petition for appeal is not filed with the Chamber of Appeals within the time limit specified under Article 16(4) of this Law, or if the Chamber of Appeals makes a decision on trademark registration on the basis of an appeal filed in accordance with Article 16(4), the Sakpatenti shall register the trademark in the Trademark Registry (the Registry) and shall publish data on the registered trademark in the Bulletin.
2. The following shall be recorded in the Registry: images of trademarks, information on the holders of trademarks, dates of trademark priorities, dates of trademark registration, a list of goods grouped on the basis of international classification and with regard to which the trademarks have been registered, and any other information related to the registration.
3. Any person concerned may obtain information from the Registry after an appropriate application to the Sakpatenti is filed and may request the certified extract from the Registry.

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*

#### **Article 18 - Trademark certificate**

1. After a trademark is registered in the Registry, the Sakpatenti shall issue a trademark certificate.
2. The certificate shall confirm the registration of a sign as a trademark, the date of trademark priority, and the exclusive right of the holder to said trademark and the validity of trademark registration.

#### **Article 19 - Making changes and amendments to the Registry**

1. Every single amendment of data that is obligatory for the registration provided for in Article 17(2) of this Law shall be recorded in the Registry on the basis of an application of a trademark holder or his/her representative. However, when trademarks are changed, only minor changes may be allowed that do not expand the scope of trademark protection, and when a list of goods is changed, only limitation or specification of the list may be allowed; changes shall enter into force only after their registration.
2. Amendments made to the Registry shall be published in the next Bulletin.
3. Changes and amendments shall be also recorded in the certificate.

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*



## **Article 20 - Validity of trademark registration**

1. The validity of trademark registration is 10 years from the date of registering the trademark with the Sakpatenti.
2. The validity of a trademark registration may be extended once every 10 years without limitation on the periods of such extensions. The validity of trademark registration shall be extended by the Sakpatenti on the basis of an application of the holder of that trademark submitted to the Sakpatenti, after the fee prescribed in accordance with established procedures is paid. The aforementioned application shall be submitted to the Sakpatenti and the respective fee shall be paid during the last year of validity of the registration.
3. A record on the extension of the validity of a trademark registration shall be made in the Registry and in the certificate, and shall be published in the Bulletin.
4. If an application for extension of a trademark registration is not submitted to the Sakpatenti, or a fee is not paid within the term provided for in paragraph 2 of this article, a trademark holder may pay the abovementioned fee within six months after the expiry of validity of the trademark registration. If this term is missed, the trademark registration shall be cancelled from the date of expiry of the validity of registration without the right to restore it, and notice thereof shall be published in the Bulletin.
5. The validity of trademark registration, where a geographical indication or an appellation of origin protected in Georgia is included as an unprotected part, may be extended only if a trademark holder has a right to use this geographical indication or appellation of origin at the moment of filing the application with the Sakpatenti for the extension of the validity of the trademark registration.
6. If a trademark registration is cancelled at the request of its holder, the registration may not be restored.

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*

## **Article 21 – (Deleted)**

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*

## **Article 22 - Fees**

Examinations of formal requirements of trademark applications, substantive examinations and accelerated examinations, requests for priorities, the processes of appealing examination decisions, trademark registrations, registration of changes and amendments, issuance of publication certificates, extracts from the Registry, suspension, restoration and extension of procedural terms for registrations, and other actions related to legal protection of trademarks shall be subject to the payment of fees prescribed in accordance with procedures established by the legislation of Georgia. The amount of fees shall be defined by an ordinance of the Government of Georgia.

*Law of Georgia No 3159 of 28 June 2010 - LGH I, No 35, 12.7.2010, Art. 206*

## **Article 23 – (Deleted)**

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*

## **Chapter III - Use of Trademarks and Assignment of Rights Derived from the Registration of Trademarks**



## **Article 24 - Use of trademarks**

1. Actions performed in the territory of Georgia, such as: affixing of trademarks to the goods for which they have been registered or affixing trademarks to packaging of such goods, to exhibits displayed at exhibitions and trade fairs, to signboards, official letterheads, and to labels, and application of trademarks in advertisements and publications, as well as other application thereof by holders, licensees or third parties on the basis of the rights conferred by proprietors, shall be considered as the use of trademarks. The use of a slightly distinctive sign instead of a registered trademark shall also be construed as the use of a trademark.
2. If a geographical indication or an appellation of origin protected in Georgia is included in a trademark as an unprotected part, the use of such trademarks shall be allowed upon the permission of an appropriate authority, which is regulated by the legislation of Georgia and international agreements to which Georgia is a party.

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*

## **Article 25 - Assignment of rights derived from the registration of trademarks**

1. Rights derived from the registration of a trademark may be assigned to other natural or legal persons in accordance with procedures under the legislation of Georgia.
2. Trademarks shall be transferred to other persons with or without an enterprise.
3. The assignment of rights derived from the registration of trademarks applies to a complete list of goods or to a part thereof.
4. The transfer of an enterprise also implies the transfer of a trademark unless otherwise provided for in an agreement for transfer.
5. An agreement on transferring a trademark shall be entered into in writing. An agreement shall not have legal force unless it is in writing.
6. If, on the basis of documents submitted for the transfer of a trademark, the Sakpatenti considers that the transfer of the trademark may confuse consumers with regard to properties, quality, geographical origin of the goods, or manufacturers of the goods or other characteristics thereof for which these trademarks have been registered, the Sakpatenti shall not record information on transfer in the Registry until it receives a consent from the transferee to remove confusing goods from the list.
- 6<sup>1</sup>. If a geographical indication or an appellation of origin protected in Georgia is included in a trademark as an unprotected part, the rights to such trademarks may be transferred only if the transferees are entitled to use this geographical indication or appellation of origin.
7. When transferring a trademark, relevant amendments shall be made in the Registry and shall be published in the Bulletin after the prescribed fees have been paid.
8. A new holder of a trademark may not use the rights derived from the registration of a trademark against a third party until the relevant amendments regarding the transfer of the trademark are made in the Registry.

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*

## **Article 26 - License agreement**

1. Trademark proprietors (licensors) may confer the right to use trademarks to other persons (licensees) under a license agreement. A license agreement may be concluded for a complete list of goods or for a part thereof.
2. A license may be exclusive or non-exclusive.
3. If an agreement does not specify the nature of a license, the license is non-exclusive. In such case, licensors are authorised to use trademarks themselves and to enter into other license agreements.
4. An exclusive license shall not allow licensors to enter into other license agreements and to use trademarks unless otherwise



provided for in the agreement. Rights derived from an exclusive license shall apply during the validity of the trademark registration unless otherwise provided for in the agreement.

5. Licensees may not assign rights derived from a license agreement or assign such rights on the basis of a sub-license unless they are derived directly from the agreement.

6. If a license agreement is breached, a trademark proprietor may use his/her exclusive rights under this Law against a licensee if such breach is related to the term of agreement, the manner of trademark use, the list of goods for which the license has been issued, the territory where the trademark may be used or to the quality of goods.

7. Entering into a trademark license agreement shall be registered with the Sakpatenti and appropriate information shall be published in the Bulletin after payment of the prescribed fee.

8. If trademark rights are infringed, a licensee shall file an action only with the consent of a trademark proprietor.

9. The licensee may participate in court proceedings for the purposes of recovering damages suffered as a result of the infringement of trademark rights.

10. The assignment of trademark rights or the transfer of a license shall not apply to a license granted earlier to a third party.

11. If a geographical indication or an appellation of origin protected in Georgia is included in a trademark as an unprotected part, a license agreement on such trademark may be entered into only if a licensee is entitled to use this geographical indication or appellation of origin.

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*

## **Chapter IV - Loss of Exclusive Rights to Trademarks**

### **Article 27 - Grounds for cancellation of trademark registration**

1. A trademark registration shall be cancelled by the Sakpatenti:

a) upon the request of the trademark proprietor;

b) if a natural person holding a trademark dies and he/she has no heir, or if a legal person is liquidated and there is no legal successor of such legal person;

c) on the basis of Article 15<sup>1</sup>(8) of this Law.

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

a) the trademark has not been used for five consecutive years for the goods for which the trademark has been registered in Georgia. If the use of the trademark started or if its use was resumed in the period between the expiry of the abovementioned five-year term and the date of filing a request for cancellation of registration, nobody may request the cancellation of the trademark registration;

b) a trademark has become a generic concept for the goods for which it has been registered;

c) the use of trademark by a trademark proprietor or the use thereof with his/her permission confuses consumers with regard to the type, properties, quality, value, geographical origin or other characteristics of the goods.

3. Sub-paragraph (a) of paragraph 2 of this article shall not apply unless the trademark proprietor refuses to use a trademark due to circumstances that are beyond his/her control. Such circumstances may include import restrictions imposed on the goods protected by trademarks or other requirements determined by the government.

4. If there are grounds for cancellation of a trademark registered for a part of a list of goods, the registration shall be cancelled only



with regard to that part.

5. If a trademark registration is cancelled with regard to a complete list of goods or to a part thereof, relevant amendments shall be made in the Registry and appropriate information shall be published in the Bulletin.

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*

*Law of Georgia No 3159 of 28 June 2010 - LGH I, No 35, 12.7.2010, Art. 206*

#### **Article 28 - Cancellation of trademark registration**

1. A court shall declare a trademark registration as cancelled at the request of a third party if:

a) a trademark has been registered by breaching requirements of Articles 4 and 5 of this Law;

b) a trademark has been registered with a dishonest intention;

c) a trademark has been registered in the name of the representative or agent of the trademark proprietor in one of the countries to the Paris Convention, without the consent of the trademark proprietor;

d) a trademark contains a brand name, the rights to which have been acquired before filing the application for the registration of the trademark when there is the likelihood of confusion;

e) such registration infringes the copyright of a third party, that has been acquired before the date of priority for the trademark is specified.

2. If there are grounds for the cancellation of a trademark registration with regard to a part of a list of registered goods, the registration shall be cancelled only with regard to that part.

3. If a trademark registration is cancelled with regard to a complete list of goods or to a part thereof, relevant amendments shall be made to the Registry and appropriate information shall be published in the Bulletin.

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*

#### **Article 29 - Consequences of cancellation or invalidation of a registration of trademarks**

1. If a trademark registration has been cancelled in accordance with Article 27 of this Law, rights derived from the registration shall be considered terminated from the date of recording of the cancellation of registration in the Registry, unless any other date is specified in a court decision.

2. If a trademark registration has been invalidated in accordance with Article 28 of this Law, rights derived from the registration shall be considered terminated from the date of origination of these trademark rights, unless any other date is specified in a court decision.

3. Matters related to recovering damages are regulated by the legislation of Georgia.

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*

### **Chapter V - Collective Marks**

#### **Article 30 - Rights in collective marks**



1. A collective mark is a sign, or a combination thereof, that may be protected as a trademark in accordance with Article 3 of this Law and that distinguishes the goods of members of an association holding the collective mark from the goods of other persons by geographical origin, similar qualitative characteristics or other properties.
2. Only associations or legal entities under public law may be applicants and proprietors of collective marks.
3. The transfer of collective marks or the issuance of licenses for these marks shall not be allowed.
4. Rules under this Law are applied with regard to all collective marks unless otherwise determined in this Chapter.

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*

#### **Article 31 - Use of an indication of geographical origin as collective marks**

1. As an exception to the restrictions provided for in Article 4(1)(d) of this Law, a sign designating a geographical origin (place, district, region, name of a country or any other indication of geographical origin of goods) may be registered as a collective mark.
2. Indications of geographical origin shall not be used as collective marks for goods that have not originated from the respective geographical location, district or region, and that may cause confusion regarding the origin of goods.
3. If an indication of geographical origin specifies special characteristics and quality of goods, such sign shall be used as a collective mark for the goods with similar origin having respective properties and quality.
4. Paragraphs 2 and 3 of this article also apply to those names, indications and signs that are similar to the signs of geographical origin.

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2005, Art. 3*

#### **Article 32 - Provisions for collective marks**

1. An application for a collective mark shall meet requirements of Article 9 of this Law. The regulations for collective marks shall be attached to the application.
2. The regulations for collective marks shall contain:
  - a) the name of the association;
  - b) the names and legal addresses of association members;
  - c) the purposes of the association;
  - d) the conditions for the use of collective marks and supervision of the use thereof;
  - e) the rights and obligations of association members with regard to an infringement of rights to collective marks;
  - f) a list and general characteristics or indicators of the goods, for which collective marks are designated
3. If a collective mark contains a geographical name, the provisions thereof shall ensure that any person whose goods have originated in the given geographical region and who meet the conditions for the use of collective marks determined in the provisions, may become a member of the association and have the right to use the collective marks.
4. Any concerned person has the right to review the provisions for collective marks.

#### **Article 33 - Examination of application for a collective mark**



A substantive examination of an application for a collective mark shall determine if the application complies with the requirements of Article 30(1) and (2) and Article 32, in addition to the verification of requirements under Article 14(2). However, a negative decision on the registration of collective marks shall not be made as a result of an examination if an applicant corrects the provisions for collective marks in such manner so that there are no grounds for refusal to register the collective marks.

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*

#### **Article 34 - Restriction on the protection of collective marks**

The registration of a geographical name as a collective mark shall not entitle its proprietor to prevent a third party from the use of this name in the course of trade unless this breaches the norms of fair competition, and the third party has reasonable grounds to use this name.

#### **Article 35 - Appeal**

A person who is authorised to use a collective mark may file an action in court for infringement of this right only with the consent of association holding the collective marks, unless otherwise provided for in the provisions for collective marks.

#### **Article 36 - Making amendments to the regulations for collective marks**

1. A proprietor of a collective mark is obliged to notify the Sakpatenti of any amendments made to the provisions for collective marks.

2. When making amendments to the provisions for collective marks, the requirements of Article 31 and 32 of this Law shall be taken into consideration.

#### **Article 37 - Cancellation of the registration of collective marks**

Registration of collective marks shall be cancelled:

- a) in accordance with Article 27 of this Law;
- b) if a proprietor of the collective mark uses it in breach of the provisions for collective marks.

#### **Article 38 - Invalidation of the registration of collective marks due to the existence of absolute grounds for the refusal of registration**

Apart from the grounds referred to in Article 28 of this Law, the registration of a collective mark shall be invalidated if it has been registered in breach of the requirements of Article 33 of this Law. If the grounds for the invalidation are related to the provisions for collective marks, the registration shall not be declared invalid if within two months after the day when a collective mark proprietor has learned about the necessity to make amendments, he/she amends the provisions so that the grounds for such invalidation no longer exist.

### **Chapter VI - Protection of Trademarks According to the Madrid Protocol Treaty**

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*



### **Article 39 - Application for the international registration of trademarks**

1. This Law applies to those trademarks the protection of which is required by the Madrid Protocol Treaty, unless otherwise provided for by this Protocol or by this Chapter of this Law.
2. In accordance with Article 3 of the Madrid Protocol, an application for the international registration of trademarks shall be filed with the Sakpatenti.
3. An English translation of the list of goods grouped in accordance with the international classification, shall be attached to the application.

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*

### **Article 40 - Record of an international registration**

1. If an international registration is performed on the basis of an application filed with the Sakpatenti, the date and the registration number of the international registration shall be recorded in the application data.
2. If an international registration is performed on the basis of a trademark registration with the Sakpatenti, the date and the number of the international registration shall be recorded in the Registry.
3. If an international registration is performed in the cases provided for in paragraph 1 of this article, the date and number of the international registration shall be recorded in the Registry after a trademark with the Sakpatenti has been registered.

### **Article 41 - Examination of trademarks used in Georgia on the basis of an international registration in accordance with the Protocol of the Madrid Agreement**

1. Trademarks for which protection is requested in Georgia on the basis of an international registration in accordance with the Protocol of the Madrid Agreement (the international trademark) are subject to a substantive examination only.
2. The term 'protection' shall be used instead of the term 'registration' used in Chapters I-V of this Law with regard to international trademarks.

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*

### **Article 42 - Publication and filing an appeal**

1. Data of an international registration of trademarks are published in the Gazette of International Bureau of the World Intellectual Property Organisation (WIPO).
2. If a positive decision is made to grant protection to trademarks in Georgia, the date and the number of the international registration shall be additionally published in the Bulletin within one month after the decision was made.
3. The term for filing an appeal provided for in Article 16(4) of this Law shall be calculated from the moment when the date and number of the international registration of a trademark has been published in the Bulletin.

*Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3*

### **Article 43 – (Deleted)**





#### **Article 44 - Submission of a national application on the basis of a cancelled international registration**

1. In accordance with Article 9 *quinquies* of the Madrid Protocol Treaty, on the basis of a cancelled international registration, an applicant, together with a national application, shall submit a document certified by the International Bureau of WIPO confirming that the international registration has been applied to Georgia before its cancellation.
2. If the Sakpatenti has made a decision to grant protection to an appropriate international trademark for the date of filing a national application referred to in paragraph 1 of this article, the national application shall not be subject to a substantive examination.
3. If at the time of cancellation of the international registration, the international trademark has been granted the right to protection in Georgia, the Sakpatenti shall conduct only an examination of the formal requirements for the national application referred to in paragraph 1 of this article and then shall register the trademark in the Registry and publish data on the registered trademark in the Bulletin.

Law of Georgia No 2380 of 20 December 2005 - LGH I, No1, 4.1.2006, Art. 3

### **Chapter VII - Protection of Exclusive Rights in Trademarks**

#### **Article 45 - Penalties for the infringement of exclusive rights in trademarks**

1..

1. If exclusive rights in trademarks are infringed, a trademark holder of exclusive rights in a trademark shall be authorised to claim:

- a) termination of the actions provided for by Article (2-4) of this Law;
- b) removal from the course of trade the goods marked in violation of exclusive rights in trademarks, or removal of the goods imported to the territory of Georgia or stored (placed for storage) for the purpose of its inclusion in the course of trade;
- c) destruction of the goods marked in violation of exclusive rights in trademarks, if it is impossible to remove a trademark from the goods, or if the trademark is affixed onto the goods;
- d) destruction of any image, label, imprint, packaging, packaging material and advertisements or posters containing the trademark, or copies or imitations thereof, including deletion of such material or image placed in the internet that contain the trademark;
- e) destruction of cliches, matrices, other devices and technical equipment and tools to be used for creating a trademark.

2. A holder of exclusive rights in a trademark shall be authorised, at his/her own discretion, to require the simultaneous implementation of several actions determined by paragraph 1 of this article.

3. Upon violation of exclusive rights to a trademark, based on the request of a holder of exclusive rights to a trademark, and on a court decision, the action provided for by sub-paragraph (a) of paragraph 1 of this article may also be carried out against those persons who were or should have been aware of the fact that their service is and/or was used for the violation of exclusive rights in trademarks in terms of commercial scale.

4. In special cases a court shall be authorised, based on the claim of a violator of exclusive rights in trademarks, to impose on the violator the payment of monetary compensation in exchange of actions under sub-paragraphs (b-e) of paragraph 1 of this article, if his/her actions were negligent, or if he/she suffers disproportionate damage by using appropriate security measures, and where the amount of monetary compensation determined by the court is acceptable for a holder of exclusive rights in trademarks.

5. Upon violation of exclusive rights to a trademark, a holder of exclusive rights in a trademark shall be authorised to claim the



performance of one of the following actions, except for those provided for by paragraph 1 of this article:

- a) compensation of damage (including the unreceived income), if a violator of exclusive rights in trademarks was or should have been aware of the violation of exclusive rights in trademarks;
- b) seizure of income received by a violator of exclusive rights in trademarks as a result of the violation of exclusive rights in trademarks in favour of a holder of exclusive rights in trademarks;
- c) payment of the one-off monetary compensation.

6. During the determination of the amount of damage, the essence of the violation of exclusive rights in trademarks shall be taken into account, as well as income received by violation of exclusive rights in trademarks, property and non-property damage to a holder of exclusive rights in trademarks, and the possible income which might have been received by a holder of exclusive rights in trademarks if the trademark were used in a lawful manner.

7. A one-off monetary compensation amount shall be determined by no less than the amount, which would have been paid by a violator of exclusive rights in trademarks for obtaining the permit for the use of the trademark.

8. During the determination of the amount of the one-off monetary compensation, the volume of the goods marked in violation of exclusive rights in trademarks shall be taken into account, as well as the identical nature of the trademark used, the level of resemblance with the protected trademark, the trademark reputation applicable in Georgia, the intention of a violator, the scale, nature and other properties of services, which are offered in violation of exclusive rights in trademarks, and/or any other circumstance, which may be taken into account during the determination of the amount of compensation.

*Law of Georgia No 1922 of 23 December 2017 - website, 11.1.2018*

## **Chapter VIII - Transitional Provisions**

### **Article 46 - Applications filed and certificates issued before the entry of this Law into force**

1. Applications for the registration of trademarks filed before the entry of this law into force shall be reviewed in accordance with Ordinance No 304 of 16 March 1992 of the Cabinet of Ministers of the Republic of Georgia on the 'Approval and Enactment of the Statute on Trademarks'.
2. Certificates issued before the entry of this Law into force shall remain valid after the entry of this Law into force.

## **Chapter IX - Final Provisions**

### **Article 47 - Invalid normative acts**

Upon the entry of this Law into force, the following shall be construed as invalid:

- a) Ordinance No 304 of 16 March 1992 of the Cabinet of Ministers of the Republic of Georgia on the 'Approval and Enactment of the Statute on Trademarks';
- b) Ordinance No 483 of 25 June 1993 of the Cabinet of Ministers of the Republic of Georgia on 'Additional Measures for the Regulation of the Use of Trademarks in the Republic of Georgia'.

### **Article 48 - Entry of this Law into force**



This Law shall enter into force three months after its promulgation.

**President of Georgia**

**E. Shevardnadze**

**Tbilisi**

**5 February 1999**

**No1795-III**

