



## Law of Ukraine on the Protection of Rights to Marks for Goods and Services

(Gazette of the Verhovna Rada [GSR], 1994, No. 7, p. 36)

This Law is issued with consideration of the amendments that were introduced according to the following Laws:

- No. 751-XIV of 16 June 1999; GSR, 1999, No. 32, Art. 266
- No. 2188-III of 21 December 2000; GSR, 2001, No. 8, Art. 37
- No. 2783-III of 15 November 2001; GSR, 2002, No. 7, Art. 51
- No. 2921-III of 10 January 2002; GSR, 2002, No. 16, Art. 114
- No. 34-IV of 4 July 2002; GSR, 2002, No. 35, Art. 256
- No. 762-IV of 15 May 2003; GSR, 2003, No. 30, Art. 247
- No. 850-IV of 22 May 2003; GSR, 2003, No. 35, Art. 271

This Law regulates relations arising in connection with acquisition and use of the property right to marks for goods and services (hereinafter termed as “mark”) in Ukraine.

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## Section I General Provisions

### *Definitions*

1. For the purposes of this Law:

“**Office**” means the central body of executive power on the legal protection of intellectual property;

“**person**” means a natural or legal person;

“**mark**” means a sign by which the goods and services of some persons differ from the goods and services of other persons.

“**certificate**” means a certificate of Ukraine of a mark for goods and services;

“**registered mark**” means a mark for which the certificate has been granted;

“**application**” means a package of documents required for granting a certificate;

“**applicant**” means a person who has filed an application or has acquired the rights of an applicant under another procedure determined by the Law;

“**priority of application (priority)**” means the precedence of the filing of an application;

“**priority date**” means a date of filing an application to the Office or to a relevant body of a State which is a member of the Paris Convention for the Protection of Industrial Property by which a priority has been claimed;

“**Register**” means the State register of certificates of Ukraine of marks for goods and services;

“**Appellate Chamber**” means a collegial body of the Office for the examination of objections to the decisions of the Office on the acquisition of rights to intellectual property objects and on other matters referred to its competence by this Law;

“**examination institute**” means the state institution (enterprise, organization) authorized by the Office for consideration and examination of applications;



“**state system of the legal protection of intellectual property**” means the Office and a number of expertise, scientific, educational, informational and other state institutions of relevant specialization, included in the sphere of management of the Office;

“**domain name**” means a name used for addressing computers and resources in the Internet network;

“**ICGS**” means International Classification of Goods and Services for the Purposes of the Registration of Marks.

*Authorities of the Office in the Sphere of the Protection of Rights  
to Marks for Goods and Services*

2.—(1) The Office provides the implementation of the State policy in the sphere of the protection of rights to marks for goods and services. To that end, it:

organizes the receiving and examination of applications as well as makes decisions on them;

grants certificates of marks for goods and services and provides the state registration of certificates;

provides publication of official data on marks for goods and services;

implements international cooperation in the sphere of the legal protection of intellectual property and represents interests of Ukraine on the matters of the protection of rights to marks for goods and services in the international organizations according to the current legislation;

adopts normative and legislative acts within its authorities under the determined procedure;

organizes the information and publishing activity in the sphere of the legal protection of intellectual property;

organizes research works on the improvement of the legislation and on the organization of activity in the sphere of the legal protection of intellectual property;

organizes the work on the retraining of the personnel of the state system of the legal protection of intellectual property;

authorizes institutions included into the state system of the legal protection of intellectual property, in accordance with their specialization, to fulfill individual tasks defined by this Law, Statute of the Office and other normative and legislative acts in the sphere of the legal protection of intellectual property;

performs other functions according to its Statute, approved under the determined procedure.

(2) The activity of the Office is financed by funds of the State Budget of Ukraine.



*International Agreements*

3. If any international agreement of Ukraine has set rules other than those provided by the legislation of Ukraine on marks, the rules of international agreement are applied.

*Rights of Foreign and Other Persons*

4.—(1) Foreign and stateless persons have equal rights with persons of Ukraine provided by this Law in accordance with international agreements of Ukraine or on the basis of the principle of reciprocity.

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

**Section II**  
**Legal Protection of Marks**

*Conditions of Granting the Legal Protection*

5.—(1) The legal protection is granted to a mark that does not contradict the public order, humane and moral principles and is not subject to the refusal of the rights protection according to the grounds defined by this Law.

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

(3) The property right to mark shall be certified by a certificate. The validity period of the certificate is 10 years from the date of filing an application to the Office and may be extended by the Office for 10 years each time at the request of the certificate owner, provided that the respective fee is paid under the procedure of Paragraph 2 of Article 18 of this Law. The procedure for extending the validity period of the certificate shall be determined by the Office.

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

(4) The scope of the granted legal protection is defined by the reproduction of the mark and by the list of goods and services, which are entered in the Register, and is certified by the certificate that shall contain the copy of the reproduction of the mark entered in the Registry and the list of goods and services.

(5) Any person, associations of persons, or their successors in title have the right to obtain a certificate under the procedure determined by this Law.



(6) The right to obtain a certificate belongs to the applicant, whose application has the earlier date of filing to the Office, or, if the application priority has been claimed, to the applicant, whose application has the earlier date of priority, provided that the application is not considered withdrawn, was not withdrawn, or the Office did not make a decision to refuse the mark registration when the possibilities to appeal that decision were exhausted.

*Grounds for Refusal of the Legal Protection*

**6.—(1)** According to this Law, the legal protection shall not be granted for marks that represent or imitate:

- state armorial bearings, flags, and other state symbols (emblems);
- official names of States;
- symbols and abbreviated or full names of international intergovernmental organizations;
- official control, guarantee, or testing seals, stamps;
- decorations and other honorary signs.

The said signs may be included in a mark as non-protected elements, provided that the consent of the relevant authorized body or of the sign owners was obtained. The authorized body with respect to the name of a State is the collegial body established by the Office.

(2) According to this Law, the legal protection shall not be granted for marks that:

are usually devoid of distinguishing capacity and did not obtain such a capacity through their use;

consist exclusively of signs that are commonly used as the signs of goods and services of a certain type;

consist exclusively of signs or data that are descriptive while using for goods and services defined in the application or with respect to them, in particular signs or data that indicate kind, quality, composition, quantity, properties, purposes, value of goods and services, the place and time of manufacturing or sale of goods or rendering of services;

are deceptive or liable to mislead as to goods, services, or the person producing goods or rendering services;

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

present only the form caused by the natural state of goods, or by the necessity to get a specific technical result, or the form imparting the essential value to the goods.

The signs mentioned in Items two, three, four, six and seven of this Paragraph may be used in a mark as non-protected elements if these signs are not dominative in the reproduction of a mark.



(3) Signs shall not be registered as marks if they are identical or misleadingly similar to:

marks that were earlier registered or filed for the registration in Ukraine on behalf of another person for identical or similar goods and services;

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

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

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

conformity marks (certification marks) that have been registered under the determined procedure.

(4) Signs shall not be registered if they represent:

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

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

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

### **Section III Procedure for Obtaining a Certificate**

#### *Application*

7.—(1) A person who wishes to obtain a certificate shall file an application to the Office.

(2) The application may be filed, on the instruction of the applicant, via a representative on intellectual property matters or another proxy.

(3) The application shall relate to one mark.

(4) The application shall be presented in Ukrainian and shall contain:

a request for registration of a mark;



a reproduction of the sign that is claimed;

a list of goods and services, for which the applicant requests to register the mark, that are grouped according to the ICGS.

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

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

make a declaration to this effect and specify in the request the color or combination of colors to be protected;

present in the request color reproductions of the mark concerned; the Office shall specify the number of copies of such reproductions.

(7) The Office shall define other requirements to the application documents.

(8) The filing of an application shall be subject to the payment of the respective fee. The fee amount shall be determined with consideration of the number of the ICGS classes that cover the goods and services indicated in the application. The payment document shall be received by the Office together with the application or within two months after the date of filing the application. This period may be extended but for no more than 6 months provided that the relevant request is submitted before the expiry of the period and the respective fee for filing the request has been paid.

#### *The Date of Filing an Application*

**8.—(1)** The date of filing an application is the date when the Office has received documents that contain at least:

a statement drawn up in any form for registration of the mark, written in Ukrainian;

information on the applicant and the address of the applicant, written in Ukrainian;

a sufficiently clear reproduction of the mark that is claimed;

a list of goods and services for which the mark is claimed.

(2) The date of filing an application is determined according to Paragraphs 10 and 11 of Article 10 of this Law.

(3) After determination of the date of filing an application, any person has the right to get acquainted with the application materials under the procedure specified by the Office. The acquaintance with the application materials is subject to the payment of the respective fee.



### *Priority*

9.—(1) An applicant has the right to claim the priority of an earlier application on the same mark within 6 months from the date of filing the earlier application to the Office or the relevant body of the State, which is a member of the Paris Convention for the Protection of Industrial Property, provided that the priority was not claimed on the earlier application.

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

(3) An applicant who wishes to use the priority right shall file a priority declaration, with the reference to the date of filing the earlier application and the application number, and a copy of the application in Ukrainian or a document that confirms the demonstration of the mark at an exhibition within 3 months from the date of filing the application to the Office provided that this application has been filed or the exhibition was held in a foreign State which is a member of the Paris Convention for Protection of Industrial Property. The mentioned documents may be changed within the said period. If these documents were submitted untimely, the right to the application priority is considered to be lost, and the applicant shall be notified accordingly.

### *Examination of Application*

10.—(1) Examination of an application has the status of scientific and technical examination and consists of the formal examination and qualifying examination (examination by substance). The examination is made by the examination institute according to this Law and regulations issued by the Office in compliance with this Law.

(2) The examination institute carries out information activity required for examination of applications and is the center for the international exchange of information communications according to the Convention on International Information Communication that was adopted on December 3, 1958, by the United Nation General Conference for Education, Science, and Culture.

(3) The final results of the examination of an application that is not considered withdrawn or was not withdrawn are presented in the grounded conclusion of examination, which shall be valid after its approving by the Office. Based on such a conclusion, the Office shall make a decision on the registration of the mark for all the goods and services listed in the application or on refusing the registration of the mark for all the goods and services listed in the application, or on the registration of the mark for a part of the goods and services listed in the application and on refusing the registration of the mark for another part of the goods and services listed in the application. The applicant shall be notified on the Office decision.





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

(4) The applicant has the right, on his own initiative or on the examination institute invitation, to participate personally or via his representative in discussion of the matters arising in the course of examination under the procedure specified by the Office.

(5) The applicant has the right to correct errors in the application, change his name and his address, address for service and name and address of his representative as well as to make changes on reducing the list of goods and services.

The applicant may make changes in the application that are connected with the change of the person of the applicant by the consent of all other applicants mentioned in the application. The person who wishes to be the applicant may also make these changes by the consent of all other applicants.

The said corrections and changes are taken into consideration, provided that the examination institute has received them not later than the document on the payment of state fee for granting a certificate is received.

The request for correction of a mistake or making of any of the mentioned changes is subject to the payment of the respective fee, provided that a mistake is not obvious or technical, and the change is caused by reasons depended on the applicant.

(6) The examination institute may demand from the applicant to submit additional materials if the examination is impossible without these materials or if the examination institute reasonable doubts the veracity of the information or elements presented in the application documents.

The applicant has the right to request the copies of the materials, which were opposed to the application, within a month after receiving the examination institute notification or conclusion with the demand to submit the additional materials.

The applicant shall submit the additional materials within 2 months from the date of receiving the notification or conclusion of the examination institute or the copies of the materials, which were opposed the application. The period for submitting the additional materials may be extended, but for no more than 6 months, provided that the relevant request is submitted and the fee is paid before expiry of the said period. This period missed for valid reasons shall be renewed provided that the relevant request is submitted and the fee is paid within 6 months after the expiry of the period. If the applicant failed to submit the additional materials within the fixed period, the application would be considered withdrawn, and the applicant shall be notified accordingly.

(7) If the applicant has submitted the additional materials, in the course of examination it is determined, whether these materials do not go beyond the subject-matter of a sign, disclosed in the application, and the list of good and services presented in the application.



The additional materials go beyond the subject-matter of the sign disclosed in the application if they contain features that should be included to the sign that is claimed as a mark.

The additional materials in a part, that goes beyond the subject-matter of the sign disclosed in the application or adds the list of goods and services presented in the application are not taken into consideration in the course of the examination and may be presented by the applicant as an individual application after receiving the relevant notification of the examination institute.

(8) Any person has the right to submit to the examination institute a grounded objection to the application in respect to the unconformity of the sign presented in the application with the requirements of granting the legal protection according to this Law. Submission of the objection is subject to the payment of the respective fee.

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

The applicant has the right to notify the examination institute of his opinion on the objection within 2 months after receiving the copy of the objection. The applicant may decline the objection and leave the application unchanged, make changes in the application, or withdraw the application.

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

(9) In the course of the formal examination:

the date of filing an application is determined according to Article 8 of this Law;

the application is examined for conformity with the formal requirements of Article 7 of this Law and the regulations issued by the Office in compliance with this Law;

the document for payment of the respective fee for filing the application is examined for conformity with specified requirements.

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

(11) If the application materials do not meet the requirements of Article 8 of this Law, the applicant is immediately notified. If the applicant removes the nonconformity within 2 months from the date of receiving the notification, the date on which the examination institute received the corrected application materials is considered to be the date of filing the application. Otherwise, the application is considered not filed, and the applicant is notified accordingly.



(12) If the application meets the requirements of Article 7 of this Law and the fee payment document meets the specified requirements, the applicant shall be notified accordingly.

(13) If the requirements of Paragraph 8 of Article 7 of this Law are not met, the application is considered withdrawn, and the applicant is notified accordingly.

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

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

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

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

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

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

#### *Withdrawal of an Application*

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

#### *Division of an Application*

**11<sup>1</sup>.**—(1) The applicant has the right to divide the application into two or more applications (divisional applications) by dividing the goods and services listed in the



application so that each of the divisional applications shall not contain the goods and services that relate to the goods and services listed in the other divisional applications.

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

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

#### *Publication on Granting a Certificate*

**12.** On the basis of the decision on registration of a mark and provided that the documents confirming payment of the state fee for granting a certificate and the fee for publication on granting a certificate are available, data concerning granting a certificate determined under the specified procedure, are published in the official bulletin. The applicant shall pay the said fees after the date of receiving the decision on registration of a mark.

If within 3 months after the date of receiving the decision on registration of a mark the documents for the payment of fees for granting a certificate and for publication on granting a certificate in the amount and under the procedure defined by the legislation were not submitted to the examination institute, the publication would not be provided, and the application would be considered withdrawn.

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

#### *Registration of a Mark*

**13.—(1)** At the same time with the publication of the data concerning granting a certificate, the Office provides the state registration of a mark. For this purpose, the Office enters the relevant data in the Register. The Office shall determine the form of the Register and the procedure for maintaining the Register.

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

(3) The errors in the data entered in the register shall be corrected on the initiative of the certificate owner or the Office.



Changes to the Register may be introduced on the initiative of the certificate owner according to the specified list of permitted changes. Introduction of changes to the Register with respect to the certificate is subject to the payment of the respective fee.

#### *Granting a Certificate*

**14.**—(1) The Office shall grant the certificate within a month from the date of the state registration of the mark. The certificate shall be granted to a person that has the right to obtain the certificate. If several persons have the right to obtain the certificate, they shall obtain a single certificate.

(2) The form of the certificate and the contents of the certificate data shall be specified by the Office.

(3) The granted certificate may be corrected by the Office on the request of the certificate owner for removing obvious errors with the following notification in the official bulletin of the Office.

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

#### *Appellation against the Decision on an Application*

**15.**—(1) The applicant may appeal to the court or the Appellate Chamber against the Office decision on the application within 2 months from the date of receiving the Office decision or copies of documents required according to the Paragraph 3 of Article 10 of this Law.

(2) If the Office decision on the application was appealed to the court after the state registration of the mark, the court shall consider simultaneously the issue on the validity of the relevant certificate.

(3) The right to appeal the Office decision in the Appellate Chamber would be lost after the payment of the state fee for granting a certificate.

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

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



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

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

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

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

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

#### **Section IV Rights and Obligations Deriving from Certificate**

##### *Rights Deriving from a Certificate*

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

(2) The certificate owner has the right to use the mark and exercise other rights provided by this Law.

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

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

applying the mark on any goods for which the mark is registered, the package containing the goods, the signboard connected with the goods, a label, tab, tag or another item attached to the goods;



storing such a goods with the mentioned application of the mark for the following offering for selling;

offering the goods for selling, selling, import (coming-in) and export (coming-out);

using the mark while offering or rendering any service for which the mark is registered;

using the mark in business documentation or in advertising, and in the Internet network, including the use of the mark in domain names.

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

(5) Any certificate owner has the exclusive right to prohibit without his permission, unless otherwise stated in this Law, the use by other persons:

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

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

the sign that is similar to the registered mark with respect to the goods and services listed in the certificate if the result of such a use is a risk of confusing the said sign with the mark;

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

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

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

the use of the mark for the goods introduced into the commercial circuit with this mark by the certificate owner or by his permission, provided that the certificate owner has no essential reasons to prohibit such a use in connection with the following selling of the goods, in particular in case when the condition of goods changed or the quality of the goods lowered after its introducing into the commercial circuit;

the use of the qualified indication of the origin of goods protected according to the Law of Ukraine “On the Protection of Rights to Indication of the Origin of Goods”;

the noncommercial use of the mark;

all forms of broadcasting and commentaries on news;



fair use of names or addresses of the said persons.

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

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

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

The licensing agreement shall contain a provision providing that the quality of goods or services manufactured or rendered according to the licensing agreement will not be lower than the quality of goods and services provided by the certificate owner, and that the certificate owner will provide the control under the fulfillment of the said requirement.

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

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

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

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

(10) The certificate owner has the right to put a precautionary marking alongside of the mark that indicates that the mark is registered in Ukraine.

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

#### *Obligations Deriving from a Certificate*

17. The certificate owner shall use the rights deriving from a certificate in good faith.



## Section V Termination of Validity and Invalidation of a Certificate

### *Termination of the Certificate Validity*

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

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

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

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

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

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

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

conditions that block the use of the mark independently of the will of the certificate owner, such as the limitation of goods import, or other requirements to goods and services that are determined by the legislation;

the possibility of deception with respect to the person manufacturing the goods or rendering services, while the person that appealed to the court or another person uses the mark for the goods and services in connection with which the demand for terminating the certificate validity was made.

For the purposes of this Paragraph the use of the mark by another person is also considered to be the use of the mark by certificate owner if the certificate owner provides controls under the use of the mark by the said person.



### *Invalidation of a Certificate*

**19.**—(1) A certificate may be fully or partially invalidated by the court in the following cases:

(a) The registered mark does not meet the requirements for granting the legal protection.

(b) The certificate contains elements of the mark reproduction and the list of goods and services that were not presented in the filed application.

(c) The certificate was granted in the result of the filing an application with the infringements of rights of other persons.

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

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

## **Section VI Protection of Rights**

### *Infringement of the Certificate Owner Rights*

**20.**—(1) Any offence against rights of a certificate owner that are defined in Article 16 of this Law, including the actions that shall be agreed with the certificate owner but are carried out without his consent as well as a preparation for such actions, is considered to be the infringement of the certificate owner rights, which is prosecuted according to the current legislation of Ukraine.

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

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

The person who was granted a license also has the right to demand the restoration of the affected rights of the certificate owner by the certificate owner consent.

### *Methods of Protecting Rights*

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



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

The courts, according to their competence, shall resolve disputes concerning:  
determination of the certificate owner;  
conclusion and execution of licensing agreements;  
infringement of the certificate owner rights.

#### *Right to Re-Registration*

**22.** No person, but the previous owner of the certificate has the right to re-registration of the mark within three years after the date of termination of the certificate validity in accordance with Paragraph 1-3 of Article 18 of this Law.

### **Section VII Conclusive Provisions**

#### *Fees*

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

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

The Cabinet of Ministers of Ukraine determines the amounts, payment terms, and the procedure for the payment of fees.

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

The earnings from the fees provided by this Law are purpose-oriented and, according to the orders of the Office, shall be used exclusively for providing the development and functioning of the state system of the legal protection of intellectual property, in particular for implementing tasks defined by this Law and other normative and legislative acts in the sphere of intellectual property.

#### *Registration of a Mark in Foreign States*

**24.—(1)** Any person has the right to register a mark in foreign States.

(2) In the case of registration of a mark in foreign States according to the Madrid Agreement on International Registration of Marks or the Protocol to the Madrid Agreement



on International Registration of Marks, the application for the international registration as well as the relevant declarations on the territorial extension of the international registration shall be filed via the Office, provided that the respective national fee is paid for filing each declaration.

(3) The applicant or another person by the agreement with the applicant shall pay expenses with respect to the international registration of a mark in foreign States.

*Protection of Rights to a Well-Known Mark*

25.—(1) The protection of rights to a well-known mark is provided according to Article 6-bis of the Paris Convention for the Protection of Industrial Property and this Law and is based on the recognition of the mark as a well-known mark by the Appellate Chamber or the court.

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

the degree of the reputation and recognition of a mark in the relevant public sector;

the duration, volume, or geographical area of any use of the mark;

the duration, volume, or geographical area of any propagation of the mark, including advertising, offering to public, and display at exhibitions of goods and/or services with respect to which the mark is used;

the duration, volume, or geographical area of any mark registration and/or applications for the registration of the mark, provided that the mark is used or recognized;

evidences of the successful protection of rights to the mark, in particular the territory where the mark is recognized as a well-known mark by authorized organizations;

the value associated with the mark.

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

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



President of Ukraine L. KRAVCHUK  
Kyiv, December 15, 1993

No. 3689-XII

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