

LAW OF UKRAINE

On Amending Certain Legislative Acts of Ukraine Concerning Strengthening the Security and Protection of Rights to Trademarks and Industrial Designs and Combating Patent Abuse

The Verkhovna Rada of Ukraine resolves:

I. To amend the following legislative acts of Ukraine:

1. In the [Economic Code of Ukraine](#) (Herald of the Verkhovna Rada of Ukraine, 2003, No. 18-22, Article 144):

1) in [Article 156](#):

paragraph one is amended as follows:

"1. In compliance with the legislation, the intellectual property right to the invention, utility model shall be certified with a patent, to the industrial design – with a certificate";

paragraph two after the word "patent" is supplemented with the word "(certificate)";

paragraph three is amended as follows:

"3. Terms of using the invention, utility model, industrial design in the sphere of economic management shall be set out by laws";

in paragraph four, the words "previous use" are replaced with the words "previous user";

paragraph five is amended as follows:

"5. The intellectual property rights to the invention, utility model, industrial design may be transferred to the authorized capital of an economic entity as a contribution.

Within thirty days after the expiration of intellectual property rights to the invention, utility model, industrial design transferred to the authorized capital of an economic entity as a contribution, the authorized capital of the economic entity shall be reduced by an amount corresponding to their value";

2) in [Article 157](#):

paragraph two is amended as follows:

"2. Terms of using the trademark in the sphere of management shall be determined by law";

in paragraph three, the words “holder” and “except for the cases of legal use of the trademark without its permission” are replaced with the words “owner” and “except for the cases provided for in the law”;

paragraphs four and five are deleted;

paragraph six is amended as follows:

"6. The intellectual property rights to the trademark may be transferred to the authorized capital of an economic entity as a contribution";

3) [Article 158](#) is deleted.

2. In the [Civil Code of Ukraine](#) (Herald of the Verkhovna Rada of Ukraine, 2003, No. 40-44, Article 356):

1) in [Article 461](#):

paragraph one is supplemented with the words “and has individual nature”;

paragraph two is amended as follows:

"2. The industrial design may have an appearance of a product or a part of it, which is determined, in particular, by the lines, contours, colour, shape, texture and/or material of the product and/or finishing of it.";

2) in [Article 462](#):

paragraph one is amended as follows:

"1. The intellectual property right to the invention, utility model, industrial design shall be subject to the state registration, if not otherwise prescribed by law or international treaty, the consent to be bound by which is granted by the Verkhovna Rada of Ukraine. Acquiring the intellectual property right to the invention and utility model shall be certified with a patent, to the industrial design – with a certificate.

in paragraph two, the words “a combination of substantial indicators of the industrial design” are replaced with the words “an image of the industrial design”;

paragraph three is amended as follows:

"3. The terms and procedure for the state registration of intellectual property rights to the invention, utility model, industrial design as well as the conditions and procedure of issuance of a patent, certificate shall be established by law".

3) [paragraph two](#) of Article 464 after the word "patent" is supplemented with the word "(certificate)";

4) [paragraph five](#) of Article 465 is amended as follows:

"5. The validity period of exclusive intellectual property rights to the industrial design shall make five years from the day of submitting an application for the industrial design under the procedure set forth in the law and shall be prolonged by request of the owner of the industrial design by one or more five-year terms. A total validity period of these rights shall not exceed twenty-five years from the day of application submission”;

5) in [Article 496](#), the words “, following the day of” are deleted.

3. In the [Law of Ukraine](#) "On Protection of Rights to Industrial Designs" (Herald of the Verkhovna Rada of Ukraine, 1994, No. 7, Article 34, as amended):

1) in [Article 1](#):

the title and indent one are amended as follows:

“Article 1. Terms and definitions

Terms used in this Law throughout the text below have the following meanings”;

indents three, five, six, eight, eleven and thirteen are amended as follows:

“industrial design shall mean the outcome of intellectual, artistic activities of a person in the sphere of artistic designing”;

“certificate shall mean the certificate of industrial design state registration”;

“registered industrial design shall mean the industrial design, information on which is included in the Register and to which the certificate is issued”;

“application shall mean the combination of documents necessary for the state registration of the industrial design”;

“date of priority shall mean the date of application submission to the Institution or relevant public authority of the state party to the [Paris Convention for the Protection of Industrial Property](#) or the [Agreement Establishing the World Trade Organization](#) under which the priority is stated”;

“Register shall mean the State Register of Ukraine for Industrial Designs maintained electronically”;

indents seventeen through twenty-five are inserted as follows:

“Bulletin shall mean the official electronic bulletin of the Institution;

item shall mean any item of industrial production or a handmade item, in particular, parts, designed to be assembled into a composite item, external decoration, graphical symbols and typographical fonts (elements), except for the computer programs;

industrial design holder shall mean a holder of intellectual property rights to the registered industrial design and/or non-registered industrial design;

WIPO shall mean the World Intellectual Property Organization;

international registration shall mean the international registration of the industrial design performed in compliance with the [Hague Agreement Concerning the International Registration of Industrial Designs](#);

ICID shall mean the International Classification for Industrial Designs;

rights to the industrial design shall mean the intellectual property rights to the industrial design;

composite item shall mean a composite item consisting of several elements, which may be replaced thus, making it possible to dismantle and assemble the item after that;

degree of author's freedom shall mean the limitations of the author's possibilities in developing a solution for appearance of the item of certain intended purpose, which are related, particularly, to the functional peculiarities of the item";

2) in [Article 2](#):

indent three of paragraph 1 is amended as follows:

"ensure the state registration of industrial designs and issue certificates";

subparagraph 3 is inserted as follows:

"3. A qualified electronic signature may be used on the documents, which are received or approved by the Institution in compliance with the Law. Submission of documents in electronic form to the Institution and issuance of documents in electronic form by it shall be carried out in compliance with the legislation in the sphere of electronic documents and electronic document circulation, this Law and rules established by the central executive authority, which ensures formulation of the state policy in the field of intellectual property".

3) [Article 3](#) after the words "treaty of Ukraine" is supplemented with the words ", consent to be bound by which is granted by the Verkhovna Rada of Ukraine";

4) in [Article 4](#):

the title is amended as follows:

"Article 4. Rights and obligations of foreign and other persons";

in subparagraph 1, the words "Foreigners and stateless persons" are replaced with the words "Foreign persons and stateless persons", and the word "citizens" – with the word "persons";

in subparagraph 2, the words "Foreigners and stateless persons" are replaced with the words "Foreigners, stateless persons, foreign legal entities and other persons having the place of permanent residence or permanent location outside Ukraine", and the words "(patent attorneys)" – with the words "(patent attorneys)";

5) [Articles 5](#) and [6](#) are amended as follows:

“Article 5. Terms of providing legal protection

1. Legal protection shall be provided to the industrial design, which does not contradict a public order, generally accepted principles of morality and corresponds to the protectability criteria.

2. The industrial design may have an appearance of a product or a part of it, which is determined, in particular, by the lines, contours, colour, shape, texture and/or material of the product and/or finishing of it.

3. According to the present Law, legal protection cannot be received by the following:

items of unstable form made of liquid, gaseous, friable or similar substances, etc.;

outcome of intellectual, artistic activities in the sphere of artistic construction, implemented or applied in the item, which is part of the composite item and which is invisible in the course of normal use of the item. Normal use of the item shall mean the use of it by the end user; furthermore, logistics, maintenance or repair of the item shall not be deemed to be the normal use;

signs of appearance of the item stipulated by its technical functions only;

signs of appearance of the item, which size and form must be accurately reproduced in order for one of the products to be mechanically connected to the other item or located inside, around or in front of the other item in such a manner that each item could perform its respective function; the aforementioned regulation does not extend to the appearance of the items designed for multiple assembly or connection of interchangeable products inside a modular construction.

4. The industrial design may be provided with legal protection as:

a registered industrial design, in the event that it is included in the Register under the procedure set forth in the present Law, or if it is provided with legal protection in Ukraine in accordance with an international treaty, the consent to be bound by which is granted by the Verkhovna Rada of Ukraine;

a non-registered industrial design, in the event it is communicated to the public under the procedure set forth in the present Law.

5. Acquisition of rights to the non-registered industrial design shall be certified with the certificate which shall contain an image of the industrial design entered to the Register.

Acquisition of the right to the industrial design, which has international registration, shall not be certified with the certificate.

Validity period of property rights to the registered industrial design shall make five years from the day of application submission to the Institution and shall be prolonged by the Institution by request of the industrial design holder by one or more five-year terms, subject

to payment of a fee under the procedure established in subparagraph 2 of Article 24 of this Law. A total validity period of the property rights to the registered industrial design shall not exceed 25 years from the day of application submission. A procedure for prolongation of the validity period of property rights to the registered industrial design shall be established by the central executive authority, which ensures formulation of the state policy in the field of intellectual property.

Validity of property rights to the registered industrial design shall be terminated prematurely subject to the conditions set forth in Article 24 of the present Law.

6. The term of legal protection of a non-registered industrial design shall be three years from the day of communicating it to the public within the territory of Ukraine.

7. The scope of legal protection provided for the registered industrial design shall be determined by the image of the industrial design entered into the Register.

The scope of legal protection of the industrial design shall be inclusive of any other industrial design, which does not make any different general impression on the informed user.

To determine the scope of legal protection, a degree of author's freedom while creating an industrial design shall be taking into consideration.

Article 6. Industrial design protectability criteria

1. The industrial design shall be in conformity with the protectability criteria in the case it is new and has individual nature.

The industrial design applied or implemented in the item, which represents a component of the composite item, shall be determined to be new and having its individual nature, if a component included in the composite item remains visible throughout the course of normal use of the composite item, and visible signs of a component of the composite item correspond to the requirements for the novelty and individual nature.

2. The industrial design shall be deemed to be new, if neither identical industrial design has been communicated to the general public in terms of:

an industrial design – prior to the day of application submission to the Institution or, if the priority has been stated, prior to the day of its priority

a non-registered industrial design – prior to the day on which the industrial design, in terms of which the protection is required, has been communicated to the general public for the first time.

Industrial designs shall be deemed to be identical in the event that their substantial signs differ only in terms of minor details.

During the process of establishing novelty of the industrial design, any information that has become publicly available prior to the date of application submission, and if the applicant has stated priority – prior to the date of the priority, including the content of all applications previously received by the Institution shall be taken into consideration, excluding those,

which are deemed to be revoked, which are revoked or decisions are made by the Institution with regard to them on refusal to conduct the state registration of the industrial design and opportunities to appeal such decisions have been exhausted.

Information disclosed to a third party under explicit or implicit condition of confidentiality is not considered publicly available.

3. The industrial design shall be recognized as the one having its individual nature, in case the general impression it makes on the informed user is different from the general impression that is made on such user by any other industrial design communicated to the general public concerning:

an industrial design – prior to the day of application submission to the Institution or, if the priority has been stated, prior to the day of its priority

a non-registered industrial design – prior to the day on which the industrial design, in terms of which the protection is required, has been communicated to the general public for the first time.

To assess an individual nature, a degree of author's freedom while creating an industrial design shall be taking into consideration.

4. A registered industrial design shall be deemed to be communicated to the general public, if it has been published as a result of the state registration or on other basis, or it has been exhibited at a relevant exhibition, used in trade or promulgated in any other manner, except for the cases when these events could not become known throughout the course of ordinary business activities in the circles, which specialize in a relevant industry and perform their activities in the territory of Ukraine, prior to the date of application submission to the Institution, or, in the event the priority has been stated, prior to the date of the priority.

A non-registered industrial design shall be deemed to be communicated to the general public, if it has been published, exhibited at an exhibition, used in trade or otherwise promulgated in such a manner that during the ordinary business activities these measures could become known in the circles due to objective reasons, which specialize in a relevant industry and perform their activities within the territory of Ukraine.

The industrial design shall not be deemed to have been communicated to the general public, if it has been disclosed to a third party provided an explicit or implicit condition of confidentiality.

5. Non-recognition of the industrial design as protectable shall not impact the disclosure of information on it by the author, his/her legal successor or person, who received such information from the author or his/her legal successor either directly or indirectly within the period of twelve months prior to the day of application submission to the Institution, if the priority has been stated, prior to the date of its priority. In addition, the obligation to prove the circumstances of disclosing information shall be imposed on the person interested in the application provisions of this subparagraph.

Provisions if this item shall also apply in the event that the industrial design has been communicated to the general public as a result of abuse with regard to the author or his/her legal successor";

6) title of [Section III](#) is amended as follows:

"SECTION III
RIGHTS TO INDUSTRIAL DESIGN REGISTRATION";

7) [subparagraphs 1](#) and [2](#) of Article 7 are amended as follows:

"1. The right to industrial design registration shall rest with the author or his/her inheritor, unless otherwise provided for in this Law.

2. The right to registration of the industrial design, which has been created by means of joint work of several authors, shall belong jointly to the authors, unless otherwise provided for in the agreement between them";

8) in [Article 8](#):

indent one of subparagraph 1 is amended as follows:

"1. The right to industrial design registration shall rest with the employer of the author, if the industrial design has been created due to the fulfillment of official responsibilities or instructions of the employer, subject to the fact it is not otherwise stipulated in the labour agreement (contract). The employer shall make a written agreement with the author on the amount and terms of remuneration payment to him/her (his/her legal successor) in accordance with the economic value of the industrial design and other remuneration received by the employer from the industrial design";

in indent two of paragraph 2, the words "receipt of patent" are replaced with the words "registration of industrial design";

9) in [Article 9](#), the words "receipt of patent" are replaced with the words "registration of industrial design";

10) in [Article 10](#) the words "receive the patent for the industrial design created" are replaced with the words "register the industrial design created", and the words "to issue the patent" – with the words "in the state registration of industrial design";

11) title of [Section IV](#) is amended as follows:

"Section IV
INDUSTRIAL DESIGN REGISTRATION PROCEDURE";

12) in [Article 11](#):

in subparagraph 1:

the words "receive the patent" are replaced with the words "register the industrial design";

indents two and three are inserted as follows:

"The application may be submitted on paper or electronically. The way of application submission shall be the choice of the applicant.

Electronic office work shall be carried out on the applications submitted in electronic form in compliance with the legislation in the sphere of electronic documents and electronic document circulation, this Law and rules established by the central executive authority, which ensures formulation of the state policy in the field of intellectual property. Applications in electronic form shall be submitted subject to the identification of the applicant (representative for intellectual property cases or other trustee of the applicant) with the use of a qualified electronic signature";

subparagraph 3 is amended as follows:

"3. An application may be related to one or several (multiple application) industrial designs belong to one and the same ICID class.

A multiple application may contain no more than one hundred industrial designs.

In the multiple application, an applicant (applicants) and also author (authors) for all industrial designs applied for shall be one and the same persons";

in indent two of subparagraph 4, the words "issuance of patent" are replaced with the words "registration of industrial design";

in subparagraph 5:

in indent one, the words "issuance of patent" are replaced with the words "state registration of industrial design";

in indent two, the word "patent" is replaced with the words "state registration of industrial design";

subparagraph 7 is amended as follows:

"7. The application shall be drawn up and submitted in accordance with the rules established by the central executive authority, which ensures formulation of the state policy in the field of intellectual property";

the first and second sentences of subparagraph 8 are amended as follows: "Submission of the application shall be subject to payment of the fee, the amount of which shall be established, taking into consideration a number of industrial designs applied for. "The aforementioned fee shall be paid before the expiry of two months upon the day of application submission";

13) in [indent two](#) of subparagraph 1 of Article 12, the words "issuance of patent" are replaced with the words "state registration of industrial design";

14) in [Article 13](#):

in subparagraph 2, the words “exhibition opening” are replaced with the words “commencement of the first public exhibit showcasing at the exhibition, where the industrial design applied for has been implemented or used”;

the text of the Article after the words "Paris Convention for the Protection of Industrial Property" is supplemented with the words "or the [Agreement Establishing the World Trade Organization](#)";

15) in [Article 14](#):

in subparagraph one, the words “shall have the status of the scientific and technical expert examination and” are deleted;

in subparagraph 3:

the second sentence of indent one is replaced with two sentences as follows: “On the basis of such conclusion, the Institution shall make a decision on the state registration of the industrial design or on refusal to conduct the state registration of the industrial design. A decision may be made for the multiple application for the state registration of certain industrial designs and refusal to conduct the state registration in terms of the rest of industrial designs”;

indents three and four are inserted as follows:

“Final findings of the expert examination under the international registration, in case of refusal to recognize its validity, shall be mentioned in a notice of full or partial refusal to recognize its international registration in Ukraine, which shall be sent to the International Bureau of WIPO.

In the event of recognizing validity of international registration within the territory of Ukraine, a relevant notice shall not be sent to the International Bureau of WIPO”;

in indent three of paragraph 5, the words "issuance of patent" are replaced with the words "registration of industrial design”;

subparagraph 8 is amended as follows:

"8. During the expert examination:

the date of application submission shall be scheduled on the basis of Article 12 of the present Law;

it shall be determined whether the industrial design applied for corresponds to the requirements referred to in subparagraph 2 of Article 5 of this Law;

it shall be determined whether the industrial design applied for belongs to the items referred to in subparagraph 3 of Article 5 of this Law;

it shall be checked whether the industrial design applied for does not contradict a public order and generally accepted principles of morality;

application shall be checked for compliance with formal requirements set forth in Article 11 of this Law and rules established on its basis by the central executive authority, which ensures formulation of the state policy in the sphere of intellectual property;

payment of the fee for submission of the application shall be checked for compliance with the established requirements";

in subparagraph 9, the words "availability of a document on payment of the fee for submission of the application" are replaced with the words "the fee paid for the submission of the application with the established requirements";

subparagraph 11 is amended as follows:

"11. If the materials of the application, which corresponds to the requirements of Article 12 of the present Law, contain a reference to the drawing (scheme, map) but the application does not have such drawing (scheme, map), the aforementioned reference shall not be taken into consideration throughout the course of the expert examination";

in subparagraph 13:

in indent one, the words and figures "the item applied for does not correspond to the requirements of subparagraph 2 of Article 5" are replaced with the words and figures "the industrial design applied for does not correspond to the requirements provided for in subparagraph 2 of Article 5 or the industrial design applied for belongs to the items referred to in subparagraph 3 of Article 5, or the industrial design applied for contradicts a public order, generally accepted principles of morality", and the words "document on payment of the fee" – with the words "fee paid";

indents three and four are amended as follows:

"If requirements of subparagraph 3 of Article 11 of the present Law are violated, namely, more than one hundred industrial designs are applied for and/or the industrial designs applied for do not belong to one and the same ICID class, the expert examination institution shall send a notice to the applicant containing a proposal to divide the applications pursuant to Article 15 of this Law within the period of three months from the day of receiving the aforementioned notice by it.

In the case the applicant fails to fulfill the proposal mentioned above, the expert examination shall be conducted with regard to the industrial design mentioned in the application first as well as subsequent industrial designs that belong to one and the same ICID class as the first one (if any), with the total number of industrial designs on which the expert examination is conducted not exceeding 100";

subparagraph 14 is inserted as follows:

"14. If it is detected on the basis of the expert examination findings that the industrial design under the international registration belongs to the items referred to in subparagraph 2 of Article 5 of this Law, does not belong to the items referred to in subparagraph 3 of Article 5 of the present Law, does not contradict the public order and generally accepted principles of

morality, validity of international registration shall be recognized within the territory of Ukraine.

If it is detected that the industrial design under the international registration does not meet the requirements referred to in a previous paragraph, a notice of full or partial refusal to recognize the international registration in Ukraine shall be sent to the International Bureau of WIPO”;

16) in [Article 15](#), the words "issuance of the patent" are replaced with the words "registration of industrial design”;

17) Article 15 is inserted as follows:

“Article 151. Application division

1. In response to the proposal of the Institution or at personal initiative, the applicant shall have the right to divide the multiple application by two and more applications by distributing the industrial designs applied for between them prior to decision-making by the Institution on the application.
2. The application shall be divided by submitting a statement by the applicant on making certain amendments to the application and the allocated application (applications) subject to payment of fees for the submission of the aforementioned statement and application (applications).
3. The date of submitting the allocated application shall be the date of submitting the divided application. The date of priority of the allocated application shall be (if there is a relevant basis to do so) the date of priority of the divided application.
4. Other requirements for the application division shall be determined by the rules established in accordance with this Law by the central executive authority, which ensures formulation of the state policy in the field of intellectual property”;

18) [Articles 16](#) and [17](#) are amended as follows:

“Article 16. Registration

1. Based on decision on the state registration of the industrial design and in case there is a document on payment of the state duty for registration of the industrial design and a fee paid for publication of information on the state registration of the industrial design, the Institution shall conduct the state registration of the industrial design by inputting relevant information into the Register. The aforementioned duties and fee shall be paid after the receipt of a decision by the applicant on the state registration of the industrial design. A procedure of keeping the Register and composition of information contained in the Register shall be determined by the central executive authority, which ensures formulation of the state policy in the field of intellectual property.

The state registration of the industrial design shall be carried out against the responsibility of its holder for the compliance of the industrial design with the protectability criteria.

If during the period of three months from the day of receiving a decision by the applicant on registration of the industrial design the document on payment of the state duty for registration of the industrial design and a fee for publication of information on the state registration of the industrial design in the amount and under the procedure set forth in the legislation are not delivered to the expert examination institution, the state registration shall not be done and the application shall be deemed to have been revoked.

The term for receiving a document on payment of the state duty for registration of the industrial design and payment of a fee for publication of information on the state registration of the industrial design shall be prolonged but not more than by six months, if a relevant request is submitted and a fee for the submission of it is paid prior to the expiry of the above-mentioned term. If the term for the receipt of a document on payment of the state duty for registration of the industrial design and payment of a fee for publication of information on the state registration of the industrial design is missed, rights of the application concerning the application shall be restored in the event that a relevant request is lodged during six months from the expiry of the aforementioned period of time together with the document on payment of the state duty for registration of the industrial design and a fee for submission of the aforesaid request has been paid and also a fee for publication of information on the state registration of the industrial design has been paid.

2. As soon as the information is entered into the Register, any person shall be entitled to study it within the procedure determined by the central executive authority, which ensures formulation of the state policy in the field of intellectual property, and receive an extract from the Register on information regarding the industrial design in accordance with its request, subject to payment of a fee for the submission of this request.

3. Errors in the information entered into the Register shall be corrected by the initiative of the industrial design holder or Institution.

At the initiative of the industrial design holder, amendments may be made into the Register pursuant to the established list of possible amendments. A fee shall be paid for making amendments to the Register in terms of the certificate.

Article 17. Publication

1. Concurrently with the state registration of the industrial design the Institution shall publish information on the state registration of the industrial design in the Information Bulletin determined under the established procedure.

2. Upon publication of information on the state registration of the industrial design, any person shall have the right to familiarize with the application materials under the established procedure. A fee shall be paid for familiarization with the application file”;

19) in [Article 18](#):

subparagraph 1 is amended as follows:

"1. The certificate shall be issued by the Institution within the period of one month upon the day of the state registration of the industrial design. The certificate shall be issued to the

person having the right to register the industrial design. If the right to register the industrial design belongs to several persons, they shall be provided with one certificate";

in subparagraph 2, the word "patent" is replaced with the word "certificate";

in subparagraph 3, the words "official bulletin" are replaced with the word "Bulletin";

20) in [Article 19](#):

subparagraph 2 is deleted;

in subparagraph 3, the words "for issuance of patent" are replaced with the words "for state registration of industrial design";

in subparagraph 4, the words "central executive authority, which ensures formulation of the state policy in the field of intellectual property" are replaced with the word "Institution";

indent two of subparagraph 7 is supplemented with the words and figures "in the amount of 50 percent of the fee set for objection submission";

subparagraph 8 is deleted;

subparagraph 10 is inserted as follows:

"10. As soon as the decision of the Appeals Chamber is made, the Institution shall publish the information determined by it on this decision on its official website";

21) in the title of [Section V](#), the words "ARISING FROM THE PATENT" are replaced with the words "SUBJECTS OF RIGHTS TO INDUSTRIAL DESIGNS";

22) in [Article 20](#):

in the title, the words "from the patent" are replaced with the words "from the state registration of the industrial design and rights provided for the non-registered industrial design";

subparagraph 1 is amended as follows:

"1. "Rights to the non-registered industrial design shall enter into force from the day following the day of state registration of the industrial design, subject to payment of a fee for maintenance of their validity";

in subparagraph 2:

in indent one, the words "The patent shall provide the holder of it" and "patent holders" are replaced with the words "The owner of the industrial design shall" and "persons", respectively;

indents two to four are amended as follows:

“When using an industrial design, the rights to which belong to several persons, mutual relationships shall be determined by the contract entered into between them. In case there is no such contract, each of the holders may use the industrial design at its own discretion, but none of them shall be entitled to grant permission (issue a license) for the use of the industrial design and assign the property rights to the industrial design to any other person without prior consent of the other industrial design holders.

Use of the registered industrial design shall be understood as the production of an item with the use of the registered industrial design, use of such item, offering it for sale, including via the Internet, sale, import, export and other way of putting it in commercial circulation or storage of such item for indicated purposes.

The item shall be recognized as produced with the use of the registered industrial design, if the appearance of such item or a part of it makes the same general impression on the informed user as the protected industrial design”;

in subparagraph 3, the words “The patent shall provide the holder of it” and “patent holder” are replaced with the words “The owner of the registered industrial design shall” and “for industrial design”, respectively”;

subparagraph 4 is amended as follows:

"4. The holder of the registered industrial design may assign the intellectual property rights to the industrial design on the basis of the agreement to any person that becomes a legal successor of the holder”;

in subparagraph 5, the words “The patent holder shall have the right to give” are replaced with the words “the owner of the registered industrial design shall have the right to give”;

in subparagraph 7:

indent one is amended as follows:

"7. The holder of the registered industrial design shall be entitled to submit an application to the Institution for official publication on provision of any person with a permission to use the registered industrial design. In this case, the annual fee for maintenance of validity of the rights to the industrial design shall be reduced by 50 percent starting from the year following the year of publication of such application”;

in indent two, the word "patent" is replaced with the words "registered industrial design”;

in indent three, the words "patent owner" are replaced with the words "holder of the registered industrial design", and the words "validity of patent" – with the words "validity of rights to the industrial design”;

subparagraph 8 is amended as follows:

"8. Rights arising from the state registration of the industrial design shall not cover any other personal non-property or property rights of an author of the industrial design, which are regulated by the legislation of Ukraine”;

subparagraph 9 is inserted as follows:

"9. A holder of the non-registered industrial design communicated to the general public shall be entitled to prohibit its copying and use of the industrial design in a manner referred to in indent three of subparagraph 2 of Article 20 of the present Law, subject to the fact that such use results from copying on unregistered industrial design.

The industrial design shall not be deemed to be the result of copying in the event it has been created by an independent artistic work of the author, in terms of whom it is possible to think that he/she has been familiarized with the industrial design, communicated to the general public by the holder of the non-registered industrial design";

23) in [Article 22](#):

in subparagraph 1, the words "previous use" are replaced with the words "previous user";

in subparagraph 2:

in indent one, the words "industrial design shall not be deemed to be the violation of the rights granted by the patent" are replaced with the words "rights to use the registered industrial design shall not be deemed to be the violation of the rights";

indent paragraph is supplemented with the words " , and also operations on import of spare parts and components for the repair of the aforesaid vehicle and performance of repair works on it";

after indent four, a new indent is inserted as follows:

"for the purpose of illustration or for educational purposes, subject to mentioning the sources of information and provided the fact that such actions do not contradict trade and other fair customs in business activity and do not harm a normal use of the industrial design".

In view of this, indent five is considered to be indent six;

in indent six, the word "patent" is replaced with the words "industrial design";

in subparagraph 3, the words "rights granted by the patent", "patented" and "patent" are replaced with the words "rights to industrial design", "registered" and "industrial design", respectively;

24) [Article 23](#) and Section VI are amended as follows:

"Article 23. Obligations of a holder of the registered industrial design

1. The holder of the registered industrial design shall use the rights belonging to it in good faith.

2. In the event that the industrial design is not used or insufficiently used in Ukraine within the period of three years starting from the date of state registration of the industrial design or from the date when the use of the industrial design was suspended, any person willing and

expressing readiness to use the industrial design, in case of refusal of the holder of the registered industrial design to make a license agreement, may go to court with a statement on granting permission to it for the use of the industrial design.

3. If the holder of the registered industrial design does not prove that the fact of non-use or insufficient use of the industrial design is stipulated by valid reasons, the court shall make a decision on granting permission to the party concerned to use the registered industrial design together with the determination of the scope of its use, permission validity period, amount and procedure of remuneration payment in favour of the holder of the registered industrial design.

Section VI

TERMINATION OF STATE REGISTRATION AND INVALIDATION OF RIGHTS

Article 24. Termination of state registration validity period

1. The holder of the registered industrial design may at any time waive the rights to such industrial design either fully or partially on the basis of the statement submitted to the Institution. The aforementioned waiver shall enter into force from the date of entering relevant information into the Register. Simultaneously, the Institution shall publish information on such abandonment in the Bulletin.

2. State registration of the industrial design shall be terminated in the event of a failure to pay the annual fee for the maintenance of validity of the rights to the industrial design within the established period of time.

The annual fee for keeping the rights to the industrial design valid shall be paid for each year of validity of the rights to the industrial design starting from the date of application submission. The first payment of the aforementioned fee shall be made concurrently with payment of the fee for publication of information on the state registration of the industrial design. Payment of the annual fee for each subsequent year shall be made until the end of a current year subject to payment of the fee within the period of the last six months.

The annual fee for maintenance of validity of the rights to the industrial design may be paid within the period of six months after the established term. In such a case, the amount of the annual fee shall be increased by 50 percent.

A request for prolongation of the validity period for the rights to the industrial design and a fee for the submission of it shall be lodged with the Institution no later than six months prior to the expiry of the term for the state registration or expiry of the prolonged term.

Validity period of state registration of the industrial design shall be terminated from the first day of the year, for which the fee has not been paid.

Article 25. Invalidation of rights to the industrial design under legal proceedings

1. Rights to the industrial design may be invalidated either in full or partially under legal proceedings on certain options of industrial designs referred to in the certificate in the following cases:

non-correspondence of the industrial design with the terms of providing legal protection determined in the Law;

existence of indications in an image of the industrial design, which were not specified in the application submitted;

state registration of the industrial design with violation of other persons' rights.

2. A claim of the party concerned on invalidation of rights to the industrial design may be filed to court within the total validity period of property rights to the industrial design and after their invalidation.

3. When invalidating the rights to the industrial design, the Institution shall publish a relevant notice in the Bulletin.

4. The invalidated rights to the industrial design shall be deemed to be the ones that have not entered into force from the date of the state registration of the industrial design.

5. If the rights to the industrial design have been invalidated under the procedure set forth in the law and it has been established that the application had been submitted with violation of the rights of other persons, the court may decide on compensation of losses by the certificate holder in favour of the person that suffered from losses caused by the actions on the basis of registration of such industrial design.

Article 251. Invalidation of rights to the industrial design by the Appeals Chamber

1. Any person shall have the right to provide the Appeals Chamber with a justified statement of invalidation of rights to the industrial design either in full or partially on the basis of non-correspondence of the industrial design with the terms of providing legal protection stipulated in the present Law. According to the instructions of the applicant, an application may be submitted through the representative for intellectual property affairs or any other trustee.

2. A statement on invalidation of rights to the industrial design may be filed within the total validity period of property rights to the industrial design and after their invalidation. A fee shall be paid for submission of the statement. The statement shall be deemed have been submitted in the event of crediting a fee to the account of the expert examination institution.

3. Parties to the consideration of the case on invalidation of the rights to the industrial design at the Appeals Chamber shall be deemed to be the person, which submitted the statement on invalidation of rights to the industrial design, and the industrial design holder.

4. The parties shall have equal rights in terms of submitting the evidence, study of the evidence and proving the evidence at the Appeals Chamber.

5. Each party shall prove the circumstances it refers to as the basis of its respective claims or objections.

6. Requirements for the statement on invalidation of rights to the industrial design, terms and procedure of its consideration shall be determined by the central executive authority, which ensures formulation of the state policy in the sphere of intellectual property.

7. The statement on invalidation of rights to the industrial design shall be considered in accordance with the regulations of the Appeals Chamber within the period of three months from the day when the Appeals Chamber receives the statement provided the fact that there is a fee paid for its submission.

8. Based on the outcomes of statement consideration, the Appeals Chamber shall make a justified decision to be approved by the order of the Institution and sent to the parties.

9. The parties may appeal a decision of the Appeals Chamber made by the Institution under the legal procedure within the period of two months from the day of receiving the decision.

10. A decision of the Appeals Chamber shall enter into force from the day of approval by the order of the Institution and shall be subject to publication in full on the official website of the Institution.

When invalidating the rights to the industrial design, the Institution shall publish a relevant notice in the Bulletin.

11. The invalidated rights to the industrial design shall be deemed to be the ones that have not entered into force from the date of the state registration of the industrial design.

12. An industrial design recognized by a court or the Appeals Chamber as not meeting the terms for granting legal protection specified by this Law or violating the rights of other persons shall not be re-registered”;

25) in [Article 26](#):

in the title, the word “patent” is replaced with the words “registered or non-registered industrial design”;

subparagraph 1 is amended as follows:

"1. Any encroachment on the rights of the registered industrial design holder provided for in paragraph two of Article 20 of this Law or any encroachment on the rights of the non-registered industrial design holder provided for in paragraph nine of Article 20 of this Law shall be considered a violation of the rights of the holder of the registered or unregistered industrial design, respectively, which entails liability prescribed by law”;

in subparagraph 2:

in indent one, the word “patent” is replaced with the words “registered or non-registered industrial design”;

in indent two, the word "patent" is replaced with the words "registered industrial design";

26) in indents [five](#) and [six](#) of subparagraph 2 of Article 27, the word "patent" is replaced with the words "industrial design";

27) in [Article 28](#):

in paragraph one, the words “issuance of patents for industrial designs” are replaced with the words “registration of industrial designs”;

paragraph two is amended as follows:

“Funds received from payment of the state duty for the registration of industrial designs shall be credited to the budgets within the procedure provided for in the [Budget Code of Ukraine](#)”;

28) in [Article 29](#):

in the title, the word "Patenting" is replaced with the word "Registration";

in subparagraph 1, the words "to patent" are replaced with the words "to register";

subparagraph 2-1 is inserted as follows:

"21. An application for international registration, which is submitted in compliance with the [Hague Agreement Concerning the International Registration of Industrial Designs](#), shall be sent by the applicant directly to the International Bureau of WIPO";

in subparagraph 3, the word "patenting" is replaced with the word "registration";

29) in the text of the [Law](#), the word "patent" in all cases and numbers is replaced with the word "certificate" in a relevant case and number;

4. In the [Law of Ukraine](#) "On Protection of Rights to Marks for Goods and Services" (Herald of the Verkhovna Rada of Ukraine, 1994, No. 7, Article 36, as amended):

1) in the [preamble](#), the words “ownership of the marks for goods and services (hereinafter referred to as the “mark”)” are replaced with the words “rights to trademarks”;

2) in [Article 1](#):

the title and indent one are amended as follows:

“Article 1. Definition of terms and abbreviations

1. The terms used in this Law shall have the following meanings”;

indents four to six, ten and eleven are amended as follows:

“trademark shall mean a designation according to which goods and services of some persons are distinguished from goods and services of other persons;

certificate shall mean a certificate of Ukraine to the trademark;

registered trademark shall mean a trademark to which the certificate has been issued or which has international registration valid in the territory of Ukraine”;

“date of priority shall mean the date of application submission to the Institution or relevant public authority of the state party to the [Paris Convention for the Protection of Industrial Property](#) or the [Agreement Establishing the World Trade Organization](#) under which the priority is stated”;

Register shall mean the State Register of Certificates of Ukraine to the Trademarks maintained electronically”;

indents seventeen through twenty-two are inserted as follows:

“Application Database shall mean an electronic database, which contains information on the application and current paperwork on it as determined by the central executive authority, which ensures formulation of the state policy in the field of intellectual property, is open and available for viewing by any person on the official website of the Institution;

Bulletin shall mean the official electronic bulletin of the Institution;

WIPO shall mean the World Intellectual Property Organization;

collective trademark shall mean a designation, according to which the goods and services of the members of the union of persons, which is understood as any combination of persons irrespective of the organizational and legal form and composition and the existence of which does not contradict the legislation of the state where it has been organized, differ from the goods and services of other persons;

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

Paris Convention shall mean the [Paris Convention for the Protection of Industrial Property](#) of 20 March 1883;

3) in [Article 2](#):

in subparagraph 1:

in indent three, the words “their state registration” are replaced with the words “state registration of trademarks”;

in indent four, the words “on the marks for goods and services” are replaced with the words “on the registered trademarks and applications submitted for the trademarks in the Bulletin”;

after indent ten, a new indent is inserted as follows:

"ensure maintenance of the Application Database".

In view of this, indent eleven is considered to be indent twelve;

subparagraph 3 is inserted as follows:

"3. A qualified electronic signature may be used on the documents, which are received or approved by the Institution in compliance with the Law. Submission of documents in electronic form to the Institution and issuance of documents in electronic form by it shall be carried out in compliance with the legislation in the sphere of electronic documents and electronic document circulation, this Law and rules established by the central executive authority, which ensures formulation of the state policy in the field of intellectual property".

4) [subparagraph 1](#) of Article 3 after the words “treaty of Ukraine” is supplemented with the words “, consent to be bound by which is granted by the Verkhovna Rada of Ukraine”;

5) in [Article 4](#):

in the title, the words “foreigners and stateless persons” are replaced with the words “foreigners and other persons”;

in subparagraph 1, the words “Foreigners and stateless persons” are replaced with the words “Foreign persons and stateless persons”, and the word “citizens” – with the word “persons”;

in subparagraph 2, the words “Foreigners and stateless persons” are replaced with the words “Foreigners, stateless persons, foreign legal entities and other persons having the place of permanent residence or permanent location outside Ukraine”, and the words “(patent attorneys)” – with the words “(patent attorneys)”;

6) in [Article 5](#):

in subparagraph 1, the words “principals of humanity and morality” are replaced with the words “generally accepted principles of morality”;

the second sentence of subparagraph 2 is amended as follows: “Such designations may be, inter alia, words, including proper names, letters, numbers, pictorial elements, colours, shape of goods or their packaging, sounds, provided that such designations are good to distinguish the goods or services of one person from goods or services of other persons, good for their entry in the Register in such a way as to enable a clear and precise scope of the legal protection provided”;

in subparagraph 3:

in indent one, the word “Ownership” is replaced with the words “Acquisition of right”;

indent three is inserted as follows:

"Acquisition of rights to the trademark, which has international registration or which is recognized as well-known in Ukraine, shall not be certified with a relevant certificate”;

7) in [Article 6](#):

in subparagraph 1:

indent three is amended as follows:

“official full or abbreviated names of the states or international two-letter codes for the states”;

in the second sentence of indent seven, the words “with regard to the name of the state” are replaced with the words “for granting permission to use an official name and international letter code of the state of Ukraine in the trademark”;

in subparagraph 2:

in indent three, the words "are generally used as the designations for goods and services of a certain type" are replaced with the words “consist only of the designations that are generally used in the modern language or in the honest and well-established trade practice on goods and services”;

indents four and five are replaced with three new indents as follows:

“consist only of the designations or data, which are descriptive while using in terms of the goods and services referred to in the application or due to them, certify the type, quality, composition, quantity, properties, intended purpose, value of goods and services, geographical origin, place and time of production or sale of goods or provision of services, or other specifications of the goods or services;

may mislead with regard to the goods or services, namely, in terms of their characteristic, quality or geographical origin;

may mislead with regard to the person manufacturing the goods or rendering the service”;

Therefore, indents six to eight are considered to be indents seven to nine, respectively;

two new indents are inserted after indent eight as follows:

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

contain geographical indications (including alcohol and alcoholic beverages) registered or applied for registration in Ukraine or which are provided with legal protection in compliance with a relevant international treaty of Ukraine, prior to the date of application submission on the trademark, which contains such indication, and if the priority has been stated, before the date of priority for the same or related goods, if, when using the designation applied for, the reputation of the geographical indication is used and/or the designation applied for is misleading as to the special quality, characteristics and true origin of the goods”.

In view of this, indent nine is considered to be indent eleven;

in indent eleven, the words “six and seven” are replaced with the words “seven and eight”;

a new indent is inserted as follows:

“Designations referred to in indents two, three, four, seven and eight of this subparagraph may be provided with legal protection in the event they acquired distinctive ability as a result of their use prior to the date of application submission”;

in subparagraph 3:

paragraph one after the word “which” is supplemented with the words “as of the day of application submission or, if the priority is stated, as of the day of the priority”, and after the word “confused” – with the words “, namely, associated”;

indent three is replaced with two new indents as follows:

“trademarks of other persons, if such trademarks are protected without registration in the territory of Ukraine on the basis of international treaties of Ukraine, namely, trademarks, which are recognized as well-known in compliance with [Article 6](#) bis of the Paris Convention on the same or related goods and services;

trademarks of other persons, if such trademarks are protected without registration in the territory of Ukraine on the basis of international treaties of Ukraine, namely, trademarks, which are recognized as well-known in compliance with [Article 6](#) bis of the Paris Convention on non-related goods and services, if the use of the trademark by another person in relation to such non-related goods and services indicates a connection between them and the holder of a well-known trademark and may harm the interests of such holder”.

Therefore, indents four to six are considered to be indents five to seven, respectively;

in indent five, the word “official” is replaced with the word “commercial”;

indent six is deleted;

indent eight is inserted as follows:

“trademarks, which are used by the other person in a foreign state, if the application is submitted on own behalf by the agent or representative of such person within the meaning of [Article 6](#) septies of the Paris Convention without permission of such person and there are no proofs that justify such submission, in the presence of objections of such person”;

subparagraph 6 is inserted as follows:

"6. Designations referred to in indents two to five and seven of subparagraph 3 and indent two of subparagraph 4 of this Article may be registered as trademarks, if consent is given by the certificate holder of the previously registered trademark or holder of the other previously acquired right and there is no opportunity to mislead the consumers”;

8) in [Article 7](#):

indents two and three are inserted in subparagraph 1 as follows:

"The application may be submitted on paper or electronically. The way of application submission shall be the choice of the applicant.

Electronic paperwork shall be carried out on the applications submitted electronically in compliance with the legislation in the sphere of electronic documents and electronic document circulation, this Law and rules established on their basis by the central executive authority, which ensures formulation of the state policy in the field of intellectual property. Applications in electronic form shall be submitted subject to the identification of the applicant (representative for intellectual property cases or other trustee of the applicant) with the use of a qualified electronic signature";

in subparagraph 3, the words "one mark" are replaced with the words "one trademark";

indent two is inserted in subparagraph 5 as follows:

“A relevant mark shall be made in the collective trademark registration application together with the indication of the list of persons having the right to use such trademark. A document that sets out the terms of using the collective trademark shall be attached to the collective trademark registration application”;

in subparagraph 6:

in indent one, the words “its mark” are replaced with the words “its trademark”;

in indent three, the words “specified mark” are replaced with the words “specified trademark”;

indent four is inserted as follows:

“give examples of using the trademark, if the designations applied for are a colour as such”;

subparagraphs 7 and 8 are amended as follows:

"7. The application shall be drawn up and submitted in accordance with the rules established by the central executive authority, which ensures formulation of the state policy in the field of intellectual property.

8. A fee shall be paid for submission of the application, which amount shall be established, taking into consideration a number of applicants and classes of the Nice Classification, which cover the goods and services mentioned in the application, as well as the peculiarities of the indication applied for. The aforementioned fee shall be paid before the day of expiry of two months upon the day of application submission. This term shall be prolonged but no more than by six months, in the event a relevant request is lodged and a fee for the submission of it is paid prior to the expiry of such term”;

9) in [Article 8](#):

in indent five of subparagraph 1, the word “mark” is replaced with the words “trademark is applied, which shall be made in the Ukrainian language”;

subparagraph 3 is deleted;

10) in [Article 9](#):

subparagraphs 1 and 2 are amended as follows:

"1. The applicant shall have the right to the priority of a previous application for the same trademark with regard to the same goods and services or those covered by the list of the goods and services referred to in the previous application within the period of six months from the date of submission of the previous application to the Institution or a relevant public authority being a party to the [Paris Convention](#) or the [Agreement Establishing the World Trade Organization](#), if the priority has not been stated for the previous application.

2. The priority of the trademark used in the exhibit, presented at official or officially recognized international exhibitions in the territory of the state being a party to the [Paris Convention](#) or the [Agreement Establishing the World Trade Organization](#) may be established by the date of commencement of the first open showcasing an exhibit at the exhibition, where the trademarks applied for has been used or presented, if the application was received by the Institution within the period of six months from the aforementioned date”;

the first sentence of subparagraph 3 is amended as follows: "The applicant willing to use the priority right, during three months from the day of application submission to the Institution, shall provide an application on the priority with reference to the date of submission and number of a previous application along with the copy thereof with the translation to the Ukrainian language or a document, which evidences presentation of the of the aforementioned trademark at the exhibition, if such application or presentation respectively was submitted or held within the territory of the state being a party to the [Paris Convention](#) or the [Agreement Establishing the World Trade Organization](#)";

11) in [Article 10](#):

in subparagraph 1, the words “shall have the status of the scientific and technical expert” are deleted;

subparagraph 3 is amended as follows:

"3. Final expert examination findings on the application, which is not deemed to have been revoked or has not been revoked or the trademark under the international registration, shall be specified in a justified conclusion on expert examination, which shall enter into force upon the day of its approval by the Institution.

On the basis of such conclusion, the Institution shall make a decision regarding the application for registration of the trademark for all goods and services referred to in the application or refusal to register the trademark for all goods and services referred to in the application, or registration of the trademark to the extent of the goods and services referred to in the application and refusal to register the trademark for the other part of the goods and

services referred to in the application. A decision of the Institution on the application shall be sent to the applicant.

As soon as the conclusion of the expert examination on the trademark under the international registration is approved, the Institution shall make a decision on provision or refusal to provide legal protection to the trademark under the international registration in Ukraine for all specified goods and services, or the provision of legal protection to the trademark under the international registration in Ukraine in terms of a share of the said goods and services.

The application for provision of legal protection to the trademark under the international registration in Ukraine shall be sent to the International Bureau of WIPO.

If upon approval of the conclusion of the expert examination on the trademark under the international registration the Institution makes a decision on refusal to provide legal protection to the trademark under the international registration in Ukraine for all specified goods and services or the provision of legal protection to the trademark in terms of a share of the said goods and services, a relevant statement shall be sent to the International Bureau of WIPO.

The applicant shall have the right to request copies of the materials that are opposed to the application accordingly within the period of one month from the day of receiving a relevant decision of the Institution by it. For the holder of international registration, such term shall be two months from the day of sending to the International Bureau of WIPO by the expert examination institution the refusal to provide legal protection to the trademark under the international registration in Ukraine for all specified goods and services or the provision of legal protection to the trademark in terms of a share of the said goods and services.

The above copies shall be sent to the applicant or holder of international registration accordingly within one month";

in subparagraph 6:

sentences two to four of indent three are replaced with the sentence as follows: "In the event the applicant fails to provide the materials within the established term, the application shall be deemed to have been revoked, which shall be communicated to the applicant by notice";

indents four and five are inserted as follows:

"The term for submission of additional materials shall be prolonged but no more than by six months, in the event a relevant request is lodged and a fee for the submission of it is paid prior to the expiry of such term.

If, regardless of taking appropriate measures by the applicant, the term for submission of additional materials is missed but during six months from the time of expiry of such term a relevant request is submitted along with the additional materials and a fee for its submission is paid, the rights of the applicant concerning the application shall be restored";

in subparagraph 8:

indents one and three are amended as follows:

"8. "Within the period of three months from the date of publication of information in the Bulletin in compliance with subparagraph 10 of this article regarding the application or international registration of the trademark, or territorial coverage of Ukraine by international registration made after the international registration, any person shall have the right to provide the expert examination institution with a justified objection to the application or validity of international registration in Ukraine with regard to non-correspondence of the indication specified in them with the term of providing legal protection established in the Law";

"Requirements for the objection shall be determined by the central executive authority, which ensures formulation of the state policy in the field of intellectual property. The objection shall be filed together with its copy";

indent five is supplemented with sentence three as follows: "For a holder of international registration, the aforementioned term shall be three months from the date of sending a notice of preliminary refusal to provide legal protection together with the copy of the objection to the International Bureau of WIPO";

indent six is deleted;

in indent four of paragraph 9, the words "document on payment of the fee" are replaced with the words "fee paid";

subparagraph 10 is amended as follows:

"10. In the event of compliance of the application materials with the requirements stipulated in Article 8 of the present Law and the fee paid for submission of the application with the established requirements, a notice of the established date of application submission shall be sent to the applicant and information, which is determined by the central executive authority, which ensures formulation of the state policy in the field of intellectual property, shall be published in the Bulletin with respect to the application within the period of five business days from the date of sending such notice. The composition of information that is subject to publication shall include the following information (if any): application number; date of filing an application; date of the exhibition priority; number of the previous application in accordance with the [Paris Convention](#); date of submission of the previous application in accordance with the Paris Convention; two-letter code of the state party to the Paris Convention; index (indexes) of the Nice Classification for the purposes of the registration of marks and a list of goods and services; index (indexes) of the International Classification of the Figurative Elements of Marks; image of the mark; colours (colour or combination of protected colours) applied for; applicant (name or full name and address of the applicant [applicants]); representative (name, full name and registration number of the representative in matters of intellectual property [patent attorney] or other authorized person); addressee (mailing address).

Simultaneously with the publication in the Bulletin information on the application shall be inputted into the Application Database. A procedure of keeping the Application Database and composition of information contained therein shall be determined by the central executive authority, which ensures formulation of the state policy in the field of intellectual property. The information contained in the Application Database shall include the following information (if any): application number; date of filing an application; date of the exhibition

priority; number of the previous application in accordance with the [Paris Convention](#); date of submission of the previous application in accordance with the Paris Convention; two-letter code of the state party to the Paris Convention; index (indexes) of the Nice Classification for the purposes of the registration of marks and a list of goods and services; index (indexes) of the International Classification of the Figurative Elements of Marks; image of the mark; colours (colour or combination of protected colours) applied for; applicant (name or full name and address of the applicant [applicants]); representative (name, full name and registration number of the representative in matters of intellectual property [patent attorney] or other authorized person); addressee (mailing address).

As soon as the information on the application is published, any person shall have the right to familiarize with the materials of the application within the procedure established by the central executive authority, which ensures formulation of the state policy in the field of intellectual property. A fee shall be paid for familiarization with the application materials.

Information on international registration of the trademark or on territorial coverage of Ukraine by international registration conducted after the international registration shall be published in the Bulletin after the receipt of a notice of the International Bureau of WIPO by the Institution on the international registration of the trademark or territorial coverage of Ukraine by international registration after the international registration”;

in subparagraph 12, the words “document on payment of the fee” are replaced with the words “fee paid”;

in subparagraph 14:

in indent one, the words “document on payment of the fee” are replaced with the words “fee paid”;

in indent three, the word “established” is replaced with the words “and under the procedure prescribed by”;

subparagraph 15 is amended as follows:

"15. During the qualification expert examination, compliance of the designation applied for with the conditions of providing legal protection set forth in this Law shall be verified, and objections filed in accordance with subparagraph 8 of this Article shall be considered.

While verifying the compliance of the designation applied for with the conditions of providing legal protection set forth in this Law, the information database of the expert examination institution shall be used together with the materials of applications, reference and search unit and relevant official publications.

The submitted objection shall be considered within the motives provided for therein and taking into account the applicant’s reply in the event of its providing within the established term.

Results of objection consideration shall be specified in the expert examination conclusion on the application. A copy of the Institution’s decision made on the basis of such expert examination conclusion shall be sent to the person that lodged the objection.

If based on the outcomes of such consideration the Institution makes a decision on registration of the trademark for all goods and services referred to in the application or part of the goods and services referred to in the application and refusal to register the trademark for the other part of the goods and services referred to in the application, the consideration of the application shall be suspended until the expiry of the term set forth in indent two of subparagraph 1 of Article 15 of this Law for appealing of such a decision by the person, which filed an objection pursuant to subparagraph 8 of Article 10 of this Law”;

in subparagraph 16:

indent one after the word “If” is supplemented with the words “based on the findings of qualification expert examination and consideration of objection, if any”, and after the words “justified preliminary conclusion” is supplemented with the words “with an exhaustive list of grounds for non-compliance of the designation applied for with the conditions of granting legal protection in whole or in part, such a preliminary conclusion may be sent only once”;

in indent two, the word “established” is replaced with the words “and under the procedure prescribed by”;

indent three is inserted as follows:

“If based on the qualification examination findings there are grounds to think that the trademark under the international registration does correspond to the terms of providing legal protection either in full or partially, the expert examination institution shall send a notice of preliminary refusal to provide legal protection to the International Bureau of WIPO. In such a case, a reply of the holder of international registration shall be given under the procedure set forth in subparagraph 6 of this article within the period of three months from the date of sending such notice by the expert examination institution”;

12) in [subparagraph 1](#) of Article 11-1, the words “The applicant shall have the right” are replaced with the words “Before decision-making by the Institution on the application, the applicant shall have the right”;

13) in [Article 12](#):

in indent one, the word "documents" is replaced with the word "document";

in indent two, the words "documents" and "fee" are replaced with the words "document" and "fee", respectively;

indent three is replaced with two indents as follows:

The term for receiving a document on payment of the state duty for issuance of the certificate and payment of the fee for publication on issuance of the certificate shall be prolonged but not more than by six months, if a relevant request is submitted and a fee for the submission of it is paid prior to the expiry of the above term. If the term for the receipt of a document on payment of the state duty for issuance of the certificate and payment of the fee for publication on issuance of the certificate is missed due to valid reasons, rights of the application concerning the application shall be restored in the event that a relevant request is lodged during six months upon expiry of the aforementioned term together with the document on

payment of the state duty for issuance of the certificate and payment of the fee for publication on issuance of the certificate and also the fee for submission of the request.

Simultaneously with sending an application on provision of legal protection to the trademark under the international registration in Ukraine to the International Bureau of WIPO, relevant information on it shall be published in the Bulletin";

14) in [Article 13](#):

the second sentence of subparagraph 1 is amended as follows: "A procedure of keeping the Register and composition of information contained in the Register shall be determined by the central executive authority, which ensures formulation of the state policy in the field of intellectual property";

in subparagraph 3:

the second sentence of indent two is deleted;

indent three is inserted as follows:

“A fee shall be paid for the submission of an application on correction of an error or any amendments, subject to the fact that the error is not obvious or technical, and the amendment occurred due to the circumstances depending on the applicant”;

15) in [Article 15](#):

in the title, the words "under the application" are replaced with the word "Institution";

in subparagraph 1:

indent one is supplemented with the second sentence as follows: “For the holder of international registration, this term shall be three months from the day of sending to the International Bureau of WIPO by the expert examination institution the refusal to provide legal protection to the trademark under the international registration in Ukraine for all specified goods and services, or the provision of legal protection to the trademark in terms of a share of the said goods and services”.

indent two is inserted as follows:

“A person, who has filed an objection in accordance with subparagraph 8 of Article 10 of this Law, may appeal the decision of the Institution to the Appeals Chamber within two months from the day of receiving a copy of the decision sent to this person in compliance with indent four of subparagraph 15 of Article 10 of this Law”;

subparagraph 2 is deleted;

subparagraph 3 is amended as follows:

"3. The applicant shall be deprived of the right to claim the decision of the Institution with the Appeals Chamber in the event of payment of the state duty for certificate issuance";

in subparagraph 4:

in the first sentence, the words “central executive authority, which ensures formulation of the state policy in the field of intellectual property” are replaced with the word “Institution”;

in the third sentence, the word “applicant” is replaced with the words “person who has filed the objection”;

in subparagraph 5:

the words “payment document” are replaced with the word “payment”;

indent two is inserted as follows:

"If the objection to the decision of the Institution on the application is filed in accordance with indent two of subparagraph 1 of this Article, notice and a copy of such objection shall immediately be sent to the applicant on such an objection. The applicant shall have the right to submit to the Appeals Chamber a substantiated reply to the objection in the manner and within the period of time established by the regulations of the Appeals Chamber”;

in subparagraph 6:

in sentence one, the word “applicant” is deleted, and after the words “its consideration” insert the words “and taking into account the applicant’s reply, in case of its receipt”;

sentence two after the word "applicant" is supplemented with the words and figure "or a person who has filed an objection in accordance with indent two of subparagraph 1 of this Article”;

in subparagraph 7:

indent one is supplemented with the words and figure “and in case the objection is filed by a person in accordance with indent two of subparagraph 1 of this Article to the person who has filed the objection”;

indent two is supplemented with the words and figures “in the amount of 50 percent of the fee set for objection submission”;

indent three is inserted as follows:

“In case of submitting an objection by the person, who is not an applicant under the application, the Appeals Chamber shall send the second counterpart of such decision to the applicant based on the outcomes of objection consideration”;

subparagraph 8 is deleted;

subparagraph 9 after the word "Applicant" is supplemented with the words and figure "or a person who has filed an objection in accordance with indent two of subparagraph 1 of this Article”;

subparagraph 10 is inserted as follows:

"10. Decisions of the Appeals Chamber shall enter into force from the day of approval by the order of the Institution and shall be subject to publication in full on the official website of the Institution”;

16) in [Article 16](#):

the second sentence of subparagraph 1 is deleted;

in subparagraph 3:

in the first sentence, the word “who” is replaced with the word "which";

in the second sentence, the word "property" is deleted;

in subparagraph 4:

in indent two, the words "the application of it" are replaced with the words "its application";

in indents three and four, the word "it" is replaced with the word "it";

in indent five, the words “used, if its” are replaced with the words “used, if its”;

indents two to five of subparagraph 5 are amended as follows:

“indication identical to the registered trademark with regard to the goods and services specified in the certificate;

indication identical to the registered trademark with regard to the goods and services related to the ones specified in the certificate, if as a result of such use this indication and the trademark may be confused, in particular, if the association of such indication with the trademark may occur;

indication similar to the registered trademark with regard to the goods and services specified in the certificate, if as a result of such use these indications may be confused, in particular, if the association of such indication with the trademark may occur;

indication similar to the registered trademark with regard to the goods and services related to the ones specified in the certificate, if as a result of such use these indications may be confused, in particular, if the association of such indication with the trademark may occur”;

in subparagraph 6:

three new indents are inserted after indent four as follows:

“use of indications throughout the course of trade, which are related to the type, quality, quantity, purpose, value, geographical origin, time of production of goods or provision of services or other specifications of the goods or services, provided the lack of signs of violating rights of the trademark certificate holder;

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

application of the trademark in the comparative advertising exclusively for the purpose of distinguishing the goods and services in order to objectively emphasize their distinctions subject to the fact that such the trademark is applied according to the fair business practice and with the observance of provisions of the legislation on the protection from unfair competition”.

In view of this, indents five to eight are considered to be indents eight to eleven, respectively;

indent twelve is inserted as follows:

“The exclusive right of the certificate holder to the trademark, which contains a geographical indication, to prohibit the other persons to use without its consent the registered trademark shall not cover fair use of the relevant geographical name by other persons”;

subparagraph 7 is amended as follows:

"7. The certificate holder may assign the exclusive intellectual property rights to the trademark in favour of any person either in full or with regard to a certain share of the goods and services referred to in the certificate on the basis of a relevant agreement”;

indent two of subparagraph 8 is amended as follows:

“A license agreement shall contain, inter alia, information about the ways of using the trademark, territory and term, for which it is allowed to use it, and the clause stating that the quality of the goods and services produced or rendered within the framework of the license agreement shall not be worse than the quality of the goods and services of the certificate holder and that it shall control the execution of this clause”;

subparagraph 10 after the word "mark" is supplemented with the words "in the form of the Latin-script letter "R" circled;

in subparagraph 11, the words “its mark” are replaced with the words “its trademark”;

17) in [Article 18](#):

in subparagraph 1, the words "official bulletin of the Institution" are replaced with the word "Bulletin";

in subparagraph 2:

in the second sentence of indent one, the words “Document on payment of the fee” are replaced with the words “A request for prolongation of the certificate and a fee”;

in the first sentence of indent two, the words "document on its payment" are replaced with the words "request for prolongation of the certificate”;

subparagraphs 3 and 4 are amended as follows:

"3. The certificate shall be terminated by court judgement:

due to transformation of the trademark to the generally used sign of a certain type of goods or services after the date of publishing information on issuance of the certificate;

if as a result of using the trademark by the certificate holder or by other person based on its permission, I may mislead the public, in particular, in terms of the origin, quality or geographical origin of the goods and services for which it has been registered.

If the basis for invalidation of the certificate applies to certain goods or services, the certificate shall be terminated only with regard to such goods or services.

4. If the trademark is not used in Ukraine in full or with regard to a share of the goods and services referred to in the certificate continuously within the period of five years from the date of publishing information on issuance of the certificate or if the use of the trademark has been suspended from the other date after such publication for the continuous term of five years, any person shall have the right to go to court with a relevant statement on premature invalidation of the certificate either in full or partially.

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

In this case, the certificate or international registration in Ukraine may be invalidated either in full or partially only provided the fact that the holder of the certificate or international registration does not specify valid reasons behind such non-use. Such valid reasons shall be the circumstances preventing from using the trademark depending on the will of the holder of the certificate or international registration, hereinafter mentioned, i.e. the limitation of import or other requirements to the goods and services established in the legislation.

For the purpose of this item, use of the trademark by the certificate holder shall be deemed to be the use of it by the other person as permitted by the certificate holder.

Use of the trademark by the person entitled to use the collective mark shall be deemed to be the use by the certificate holder.

The certificate may be invalidated, if within the term from the expiry of a five-year term of non-use of the trademark until the submission of the claim on premature termination of the certificate the use of it started or restored, except for the case when preparation to the commencement of the use or restoration of use of the trademark started within three months prior to filing such claim and after the time the certificate holder knew about a possibility of submitting it";

18) in [Article 19](#):

in subparagraph 3, the words "from the day" are replaced with the words "from the day following the day";

subparagraphs 4 and 5 are inserted as follows:

"4. A person, which is a holder of the trademark in a foreign state, the right to which has been obtained in Ukraine by its agent or representative without permission, may claim the recognition of the certificate to such trademark, in case the agent or representative does not justify their actions by relevant proofs.

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

19) in [indent two](#) of subparagraph of Article 20, the words “used mark” are replaced with the words “used trademark”, and the word “him” – with the word “it”;

20) text of [Article 22](#) is amended as follows:

No one but a former holder of the certificate shall have the right to re-register the trademark within the period of two years after the termination of the certificate in accordance with sub-items 1 to 2 of Article 18 of the present Law, except for the cases when the holder of the terminated certificate grants consent for registration of the trademark applied for”;

21) [paragraph two](#) of Article 23 is amended as follows:

"Funds received from payment of the state duty for the issuance of certificates for the trademarks shall be credited to the budgets within the procedure provided for in the [Budget Code of Ukraine](#)".

22) in [subparagraph 2](#) of Article 24:

the word “mark” is replaced with the word “trademark”, and the word “extension” – with the words “coverage after international registration”;

indent two is inserted as follows:

“The application on territorial coverage after international registration and application on prolongation of international registration may be submitted directly to the International Bureau of WIPO, in the event that the state registration has been done exclusively in compliance with the Madrid Agreement Concerning the International Registration of Marks”;

23) in [Article 25](#):

the title and subparagraph 1 are amended as follows:

“Article 25. Protection of rights to a well-known trademark

1. Rights to a well-known trademark shall be protected in compliance with [Article 6 bis](#) of the Paris Convention and this Law on the basis of recognition of the trademark as well-known by the Appeals Chamber or court. The trademark may be recognized as well-known regardless of its registration in Ukraine”;

in subparagraphs 2 and 3, the words "known" and "recognized" in all cases are replaced with the words ""known" and "recognized" in a relevant case;

subparagraph 4 is amended as follows:

"4. If the trademark is recognized as well-known under the legal procedure a person, which trademark is recognized as well-known, shall inform the Institution of such decision.

Information on well-known trademarks, which are recognized as such by the Appeals Chamber or court, shall be entered into the list of trademarks well-known in Ukraine by the Institution and published in the Bulletin. The list of trademarks well-known in Ukraine shall be for reference purposes, available for the public and published on the official website of the Institution";

24) in the text of the [Law](#):

the words "mark for goods and services" in all cases and numbers are replaced with the word "trademark" in the relevant case and number;

the word "registered mark" in all cases and numbers is replaced with the words "registered trademark" in the relevant case and number;

the word "mark" in all cases and numbers is replaced with the word "trademark" in the relevant case and number, except for indents sixteen and twenty-one of Article 1, indent seven of subparagraph 3 of Article 6 and subparagraph 2 of Article 24;

the words "official bulletin" in all cases is replaced with the word "Bulletin" in the relevant case.

5. In [point "x"](#) of subparagraph 6 of Article 3 of the Decree of the Cabinet of Ministers of Ukraine No. 7-93 dated 21 January 1993 "On the State Duty" (Herald of the Verkhovna Rada of Ukraine, 1993, No. 13, Article 113, as amended):

in indent two, the words "patent for industrial design" are deleted;

in indent five, the words "mark for goods and services" are replaced with the words "trademark";

indents sixteen through eighteen are inserted as follows:

"for registration of industrial designs:

for individuals (legal entities) permanently residing (located) in Ukraine – 1 tax-exempt minimum wage of citizens;

for individuals (foreign legal entities) permanently residing (located) outside Ukraine – 100 US dollars".

II. Final and Transitional Provisions

1. This Law shall enter into force on the day following the day of its publication.
2. The regulatory legal acts adopted prior to the entry into force of this Law, before bringing them into line with this Law, shall be valid to the extent that does not contradict this Law.
3. Expert examination of applications for industrial designs, whose expert examination is pending as of the day of entry into force of this Law, shall be conducted in the manner prescribed by this Law, and compliance of industrial designs on such applications with the conditions of legal protection shall be determined according to the law effective as of the day of application submission.
4. Expert examination of applications for marks for goods and services, whose formal expert examination is pending as of the day of entry into force of this Law, shall be conducted in the manner prescribed by this Law, and compliance of designations on such applications with the conditions of legal protection shall be determined according to the law effective as of the day of application submission.
5. Expert examination of applications for marks for goods and services, whose formal expert examination is completed as of the day of entry into force of this Law, shall be conducted in the manner prescribed by this Law, except for the publication of such applications envisaged by this Law, where compliance of designations on such applications with the conditions of legal protection shall be determined according to the law effective as of the day of application submission.
6. Patents and certificates issued on applications, which are received by the Institution prior to the entry into force of this Law, shall be valid.
7. Within the period of six months from the day of entry into force of this Law, the Cabinet of Ministers of Ukraine shall do the following:

bring its regulatory legal acts into line with this Law;

ensure that the ministries, other central executive authorities bring their regulatory legal acts into line with this Law.

President of Ukraine V. ZELENSKYY
Kyiv
21 July 2020
No. 815-IX