

UZBEKISTAN

Announcement on the Protection of Industrial Property in Uzbekistan*

The situation of industrial property protection in Uzbekistan is summarized below.

I. Legislation

(1) The State Patent Office of Uzbekistan was established on October 1, 1992.

(2) The Government of Uzbekistan adopted, on September 15, 1992, a Decree on the provisional protection of industrial property rights. On June 2, 1993, the Law on Trademarks and Service Marks of Uzbekistan entered into force.

II. Membership in Treaties

(3) On May 5, 1993, Uzbekistan deposited a declaration of continued application of the Convention Establishing the World Intellectual Property Organization (WIPO). The Government of Uzbekistan deposited on August 18, 1993, a declaration to the effect that the Paris Convention for the Protection of Industrial Property, the Madrid Agreement Concerning the International Registration of Marks and the Patent Cooperation Treaty (PCT) continue to be applicable to Uzbekistan.

III. Applications for Industrial Property Rights Filed with the State Patent Office of Uzbekistan

(4) Applications for the grant of patents for inventions, patents for utility models, patents for industrial designs and for the registration of marks may be filed with the Uzbek State Patent Office in order to establish a filing or priority date.

IV. Industrial Property Rights Granted by the Patent Office of the Soviet Union

(5) The owner of a patent for invention, an inventor's certificate or an industrial design patent or certificate

granted by the Patent Office of the Soviet Union may file with the Uzbek State Patent Office, before January 1, 1994, a request for the grant of a patent, provided that:

(i) at the time the request is made, in the case of inventions, 20 years and, in the case of industrial designs, 15 years have not yet expired from the filing date of the application with the Patent Office of the Soviet Union and that the patent or certificate concerned was still valid on October 1, 1992;

(ii) in the case of patents for invention or inventor's certificates, a copy of the Soviet patent or inventor's certificate and a copy of the description of the invention certified by a notary or other competent authority is enclosed; where the grant was decided but not effectively made, a copy of the decision of the Patent Office of the Soviet Union that the Soviet patent or certificate should be granted, together with a copy of the description of the invention, must be enclosed;

(iii) the prescribed fee is paid.

(6) The owner of a trademark certificate granted or renewed by the Patent Office of the Soviet Union may file with the Uzbek State Patent Office, before January 1, 1994, a request for the grant of a trademark certificate, provided that:

(i) on December 24, 1991, 10 years had not expired from the filing date of the application for a trademark certificate or from the date of renewal of the registration with the Patent Office of the Soviet Union;

(ii) the prescribed fee is paid.

V. Applications for Industrial Property Rights Filed With the Patent Office of the Soviet Union or With the Patent Office of the Russian Federation Before October 1, 1992

(7) An applicant of an application for a patent for invention, for an inventor's certificate, for an industrial design patent or certificate or for a trademark certificate filed, before February 1, 1992, with the Patent Office of the Soviet Union, or before October 1, 1992, with the Patent Office of the Russian Federation with the express or implied intention of obtaining protection also in Uzbekistan and claiming priority (including Convention priority), may file with the Uzbek State Patent Office, before January 1, 1994, a request for the grant of a patent for

*Source: Communication from the Uzbek authorities.

invention, industrial design patent or trademark certificate, provided that:

(i) a copy of the pending application, certified by a notary or other competent authority, with an official indication of the date of receipt of the application by the Patent Office of the Soviet Union or the Patent Office of the Russian Federation is enclosed;

(ii) the prescribed fee is paid.

The request is considered equivalent to an application filed with the Uzbek State Patent Office and shall have the benefit of the filing date or priority date of the application referred to above.

VI. Effects in Uzbekistan of International Applications Under the Patent Cooperation Treaty (PCT)

(8)(a) On August 18, 1993, Uzbekistan deposited a declaration of continuation the effect of which is that the Patent Cooperation Treaty (PCT) is applied by Uzbekistan. Nationals and residents of Uzbekistan can therefore file international applications, and Uzbekistan can be designated and elected in international applications filed from that date.

(b) On September 29, 1992, the Assembly of the PCT Union adopted, with effect on October 1, 1992, new Rules 32.1 and 32.2 of the Regulations under the PCT, concerning the extension of international applications to certain successor States.

(c) For the purposes of determining the status of international applications with respect to Uzbekistan, one has to distinguish between

(i) international applications designating the Soviet Union which were filed before December 25, 1991 (see (d), below);

(ii) international applications—irrespective of the designations they contain—which were filed between December 25, 1991, and October 18, 1993 (see (e) to (g), below);

(iii) international applications specifically¹ designating Uzbekistan filed on or after August 18, 1993 (see (h), below).

(d) As regards any international application whose international filing date is before December 25, 1991, and in which the Soviet Union has been designated, the “national filing effect” of any such application under Article 11(4) of the PCT will, pursuant to the deposit by

Uzbekistan of its declaration of continuation, be recognized in Uzbekistan. The conditions under which any such international application, or any patent or inventor’s certificate resulting therefrom and granted by the Patent Office of the Soviet Union or by the Patent Office of the Russian Federation, may continue to have effect in Uzbekistan are the following:

(i) if a patent for invention or an inventor’s certificate has been granted by the Patent Office of the Soviet Union or by the Patent Office of the Russian Federation on the basis of the international application, the conditions referred to in paragraph (5), above, are applicable;

(ii) if the applicant has entered the national phase before the Patent Office of the Soviet Union or the Patent Office of the Russian Federation but a patent for invention or an inventor’s certificate has not been granted by either of those Offices, the conditions referred to in paragraph (7), above, are applicable, provided that the applicant files, before January 1, 1994, with the Uzbek State Patent Office, a request to the effect that the international application be further processed according to Uzbek legislation; the request must be accompanied by a copy of the Russian translation of the international application submitted to the Patent Office of the Soviet Union or the Patent Office of the Russian Federation as well as a declaration that the application is still pending before the Patent Office of the Russian Federation; however, where a decision to grant a patent has been issued, only the requirements referred to in paragraph (7), above, apply;

(iii) if the applicant has not entered the national phase before the Patent Office of the Soviet Union or the Patent Office of the Russian Federation and if the time limit for entering the national phase had not expired on December 24, 1991, the applicant must, before January 1, 1994, or, if Uzbekistan is elected under Chapter II of the PCT within 19 months from the priority date, before January 1, 1994, or before the expiration of 31 months from the priority date, whichever is later, furnish to the Uzbek State Patent Office a translation of the international application into Uzbek or Russian and evidence that the prescribed fee (see paragraph (13), below) has been paid to the latter Office.

(e) As regards any international application whose international filing date is later than December 24, 1991, and earlier than October 19, 1993,² its effects may be extended to Uzbekistan (irrespective of the designations it contains) through the performance by the applicant of the following acts:

² With the exception of any such international application whose international filing date is on or after August 18, 1993, and in which Uzbekistan is specifically designated: in such a case, the procedure described in (e) to (g) is not applicable, and the procedure described in (h) applies. It should be noted that Uzbekistan can be specifically designated only in those international applications filed on or after August 18, 1993.

¹ In this announcement, an international application is regarded as “specifically” designating Uzbekistan either if Uzbekistan has been designated under Rule 4.9(a) of the Regulations under the PCT or if the designation of Uzbekistan has been confirmed under Rule 4.9(c) of those Regulations.

(i) filing a request for extension with the International Bureau of the World Intellectual Property Organization (WIPO);

(ii) paying to the International Bureau of WIPO an extension fee of 185 Swiss francs, payable in Swiss francs.

(f) The applicant in respect of each and every international application referred to in (e), above, or his agent or common representative if there is one, will receive a written notification from the International Bureau of WIPO drawing his attention to the fact that he can, by filing a written request for extension, extend the effects of the international application to Uzbekistan. The notification will, in particular, specify the modes of payment of the extension fee of 185 Swiss francs. The request for extension must contain the identification of the international application by its international application number. A form which may be used for the purpose of requesting extension to Uzbekistan will be attached to the notification. The request for extension must be in English or French, and may be sent by telefax or telex. The request for extension and the corresponding payment must reach the International Bureau of WIPO before the expiration of three months from the date of the notification sent by the International Bureau of WIPO; if either the request or the fee is received later, the request will be refused. It is recommended that applicants await the notification from the International Bureau of WIPO and use the form attached to it, although requests and payments may be made without waiting for the notification from the International Bureau of WIPO.

(g) If the conditions described in (e) and (f), above, are fulfilled, Uzbekistan will be considered as having been designated in the international application on its international filing date. For entering the national phase before the Uzbek State Patent Office, the applicant must furnish to that Office, within the following time limit, both a translation of the international application into Uzbek or Russian and evidence that the prescribed fee (see paragraph (13), below) has been paid:

(i) before January 1, 1994, or before the expiration of 21 months from the priority date, whichever is later, if Uzbekistan is not elected under Chapter II of the PCT before the expiration of 19 months from the priority date and if item (iii) does not apply;

(ii) before January 1, 1994, or before the expiration of 31 months from the priority date, whichever is later, if Uzbekistan is elected under Chapter II of the PCT before the expiration of 19 months from the priority date;

(iii) before January 1, 1994, or before the expiration of 31 months from the priority date, whichever is later, if a request for extension to Uzbekistan is made after, but the demand was made before, the expiration of 19 months from the priority date, and if a later election of Uzbekistan is made together with the request for extension or within three months from the date of request for extension.

(h) As regards any international application whose international filing date is on or after August 18, 1993, and in which Uzbekistan is specifically designated, the applicant, in order to enter the national phase before the Uzbek State Patent Office, must furnish to that Office, within the following time limit, both a translation of the international application into Uzbek or Russian and evidence that the prescribed fee (see paragraph (13), below) has been paid to the said Office:

(i) before the expiration of 21 months from the priority date if Uzbekistan is not elected under Chapter II of the PCT within 19 months from the priority date;

(ii) before the expiration of 31 months from the priority date if Uzbekistan is elected under Chapter II of the PCT within 19 months from the priority date.

VII. Effects in Uzbekistan of International Registrations Under the Madrid Agreement Concerning the International Registration of Marks

(9)(a) On August 18, 1993, Uzbekistan deposited a declaration of continuation the effect of which is that the Madrid Agreement Concerning the International Registration of Marks is applied by Uzbekistan.

(b) On September 29, 1992, the Assembly of the Madrid Union adopted, with effect on October 1, 1992, a new Rule 38 of the Regulations under the Madrid Agreement, concerning the effect of international registrations in certain successor States.

(c) Pursuant to the deposit of the declaration of continuation and to the decision of the Assembly, certain international registrations may have effect in Uzbekistan, subject to the conditions described below. The international registrations concerned are those which have a territorial extension to the Soviet Union effective from a date prior to September 1, 1991.

(d) The conditions referred to above are the following:

(i) the filing of a request with the International Bureau of WIPO;

(ii) the payment to the International Bureau of WIPO of a fee, the amount of which is 62 Swiss francs per international registration.

(e) The owner of each and every international registration concerned, or his representative (if the owner has a representative whose name appears in the International Register), will receive a written notice from the International Bureau of WIPO calling his attention to the fact that he can, by filing a written request, obtain the continuation of the effect of the international registration in Uzbekistan. The notice will, in particular, specify the modes of payment of the fee. The request must contain the identi-

cation of the international registration concerned by means of its international registration number. A form (in French) will be attached to the notice and may be used. The request must be in English or French, and may be sent by telefax or telex. The request and the corresponding payment must reach the International Bureau of WIPO before the expiration of six months from the date of the notice sent by the International Bureau of WIPO; if either the request or the fee is received later, the request will be refused. Requests and payments may be made without waiting for the notice of the International Bureau of WIPO.

(f) If the conditions described above are fulfilled, the international registration concerned will, with respect to Uzbekistan, have effect as from the effective date of the territorial extension to the Soviet Union and will benefit from any priority validly claimed with regard to such extension.

(10) For each international registration which has a territorial extension to the Russian Federation effective from a date prior to August 18, 1993, the owner may request the Uzbek State Patent Office, before January 1, 1994, that the said registration be processed as an application under Uzbek legislation. The request must be accompanied by an extract from the International Register established by the International Bureau of WIPO, by a declaration that, to the best knowledge of the owner, the international registration still has effect in the Russian Federation, and by an application filed according to Uzbek legislation.

(11) For each international registration not covered by paragraph (9)(c) or (10), above, protection in Uzbekistan under the Madrid Agreement can only be obtained by filing, through the intermediary of the national Office of the country of the owner, a request for territorial extension

under Rule 20 of the Regulations under the Madrid Agreement. It is to be noted that requests for territorial extension to Uzbekistan are possible at present.

VIII. Procedural Provisions

(12) If an applicant does not have his ordinary residence or principal place of business in Uzbekistan, he must authorize a representative in Uzbekistan, and all requests, applications and other documents must be filed through the intermediary of such a representative.

(13) The list of persons who can act as representatives and the official fees applicable to the procedures referred to under paragraphs (4), (5), (6), (7), (8) and (10) are available from the Uzbek State Patent Office.

(14) The request part of any application must be filed in Uzbek or Russian. Other parts of any application may be presented in other languages, provided that a translation into Uzbek or Russian is presented within two months from the filing date.

IX. Address of the Patent Office

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Uzbekistan

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