

LAW OF UKRAINE

On Protection of Rights to Marks for Goods and Services

This Law regulates relations arising in connection with the acquisition and use of rights to trademarks in Ukraine.

Section I

GENERAL PROVISIONS

Article 1. Definition of Terms and Abbreviations

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

- “*National Intellectual Property Office*” (hereinafter referred to as the NIPO) is the state organization that is a part of the state system of intellectual property legal protection appointed at the national level by the Cabinet of Ministers of Ukraine as the one exercising powers in the intellectual property field prescribed by this Law, other laws in the intellectual property field, by acts of the central executive body ensuring the state policy formation and implementation in the intellectual property sphere, as well as by the statute, and has the right to represent Ukraine in international and regional organizations;
- “*person*” shall mean a natural or a legal person;
- “*trademark*” shall mean a sign according to which the goods and services of some persons are distinguished from the goods and services of other persons;
- “*certificate*” shall mean a trademark certificate of Ukraine;
- “*registered trademark*” shall mean a trademark for which a certificate has been issued or which has the international registration valid in the territory of Ukraine;
- “*application*” shall mean the application documents as a whole required for issuing a certificate;
- “*applicant*” shall mean a person who has filed an application or has acquired the rights of an applicant under another procedure determined by the Law;
- “*priority of an application (priority)*” shall mean the primacy in filing an application;
- “*priority date*” shall mean the date of the earlier filing with the NIPO or the relevant Office of a State party to the Paris Convention for the Protection of

Industrial Property or the Agreement Establishing the World Trade Organization, on which a priority claim is based.

- “*Register*” shall mean the State Register of Certificates of Ukraine for Trademarks maintained electronically;
- “*Appeals Chamber*” shall mean a collegial body of the NIPO for processing of appeals against the NIPO decisions on acquisition of intellectual property rights, requests on a total or partial invalidation of intellectual property rights, requests on declaration of a trademark to be well known in Ukraine and processing of other matters within its competence according to this Law, other laws and regulations of Ukraine;
- “*state system of intellectual property legal protection*” shall mean the central executive body ensuring the state policy formation and implementation in the intellectual property sphere, the NIPO and a system of scientific, educational, information and other state institutions, establishments, organizations of relevant specialization, falling under the sphere of management of the central executive body ensuring the state policy formation and implementation in the intellectual property sphere;
- “*domain name*” shall mean a name used for addressing computers and resources on the Internet;
- “*Nice Classification*” shall mean the International Classification of Goods and Services for the Purposes of the Registration of Marks;
- “*Attestation Commission*” shall mean a collegial body of the NIPO, the main purpose of which is to carry out the attestation of persons who have expressed their intention to acquire the right to practice activities of a representative on intellectual property matters (patent attorney);
- “*Appeals Commission*” shall mean a collegial body of the NIPO, the main purpose of which is to consider complaints of candidates for representatives on intellectual property matters (patent attorneys) against the decisions of the Attestation Commission and to consider complaints against the actions of representatives on intellectual property matters (patent attorneys);
- “*Application Database*” shall mean a database maintained electronically, which contains information on applications and their current processing as determined by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere, is open and viewable by any person on the official website of the NIPO;
- “*Bulletin*” shall mean the official electronic bulletin of the NIPO;

- “*WIPO*” shall mean the World Intellectual Property Organization;
- “*collective trademark*” shall mean a sign which serves to distinguish the goods and services of members of the association, which means any association irrespective of its organizational and legal form and composition and the existence of which does not contradict the legislation of the state where it has been created, from the goods and services of other persons;
- “*international registration*” shall mean the international registration of a trademark made 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 March 20, 1883.

Article 2. Powers of the Central Executive Body Ensuring the State Policy Formation and Implementation in the Intellectual Property Sphere

1. The powers of the central executive body ensuring the state policy formation and implementation in the intellectual property sphere shall include:

- ensuring legal regulation in the field of protection of rights to marks for goods and services;
- determination of key propriety areas for development of the sphere of protection of rights to marks for goods and services;
- interaction and coordination with central executive bodies, other state authorities in the process of formation and implementation of the state policy in the intellectual property sphere, and towards strengthening the enforcement of intellectual property rights;
- elaboration of proposals for improving the legislation in the field of intellectual property legal protection;
- conduct of international cooperation in the field of intellectual property legal protection and representation of Ukraine's interests on the matters relating to protection of rights to marks for goods and services in international organizations;
- conclusion of international agreements on cooperation in the field of intellectual property legal protection in conformity with the law;

- ensuring the implementation of international programs and projects realization in the field of intellectual property legal protection in accordance with international agreements;
- ensuring the fulfillment of obligations arising from Ukraine's membership in international organizations in the field of intellectual property legal protection;
- interaction with the corresponding authorities of foreign states and international organizations in accordance with the standard procedure;
- approval of regulations on representatives on intellectual property matters (patent attorneys), on the Attestation Commission of the NIPO and the procedure for attestation of representatives on intellectual property matters (patent attorneys), on the Appeals Commission, on the State Register of Representatives on Intellectual Property Matters (Patent Attorneys);
- coordination of the NIPO activities in the intellectual property sphere;
- monitoring of the NIPO compliance with legislation in the intellectual property sphere, use of the income from payment of fees for the actions connected with the intellectual property rights protection.

2. The central executive body ensuring the state policy formation and implementation in the intellectual property sphere performs other powers in accordance with the Law.

Article 2¹. Powers of the National Intellectual Property Office (NIPO) in the Field of Protection of Rights to Marks for Goods and Services (Trademarks)

1. The functions of the NIPO shall be performed by a legal entity of public law (state organization) established by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere, and defined by the Cabinet of Ministers of Ukraine.

2. The authoritative powers delegated to the NIPO shall include:

- receipt of applications, examination thereof, taking decisions on applications;
- issuance of certificates for trademarks, state registration of trademarks;
- publication of official information on trademarks and filed applications for trademarks in the Bulletin, maintenance of the Register and the Application Database, entry of data into the Register, provision of extracts and abstracts in electronic and/or paper format;

- conduct of international cooperation in the field of intellectual property legal protection and representation of interests of Ukraine in respect of the legal protection of trademarks before the World Intellectual Property Organization and other international organizations in accordance with the law;
- training, attestation and registration of representatives on intellectual property matters (patent attorneys);
- maintaining the State Register of Representatives on Intellectual Property Matters (Patent Attorneys);
- provision of information and explanations concerning the implementation of the state policy in the sphere of legal protection of trademarks.

3. The NIPO shall also perform:

- the functions of the "National Office" provided for under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks;
- information and publishing activities in the field of intellectual property legal protection;
- analysis of the national and global best practices of enforcement of the law in the sphere of legal protection of trademarks, development of proposals to improve legislation in this field and submission of such proposals to the central executive body ensuring the state policy formation and implementation in the intellectual property sphere;
- approval of guidelines on examination of applications and the state registration of trademarks;
- organization and implementation of training, retraining and advanced training activities for personnel of the state system of intellectual property legal protection;
- other functions and powers provided by this Law, other laws and regulations of Ukraine, the statute.

The NIPO has the right to get any information, documents and materials from ministries, other central and local executive bodies, local authorities free of charge to perform the assigned powers and functions.

4. The NIPO shall act in accordance with this Law, other laws of Ukraine, acts of the central executive body ensuring the state policy formation and implementation in the intellectual property sphere, and the statute approved by the central

executive body ensuring the state policy formation and implementation in the intellectual property sphere.

5. In order to ensure implementation of the authoritative powers delegated to the NIPO, the head officer of the NIPO is authorized to sign title establishing documents.

6. For the purpose of preparing recommendations on the matters within the competence of the NIPO, it undertakes scientific research, involving experts and consultants.

7. The NIPO's head officer in charge shall be assigned and released from the holding position by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere.

In the capacity of the NIPO's head officer in charge can be assigned a citizen of Ukraine residing in Ukraine for the last five years, proficient in the state language, with a good command of one of the official languages of the World Intellectual Property Organization (WIPO), with a university degree in law and/or in intellectual property sphere, with not less than ten years' work experience in the intellectual property sphere and not less than five years' experience at a senior management level.

A person who, pursuant to a court decision, has been deprived of the right to engage in activities connected with performance of the state functions or to hold relevant positions, and has been charged with administrative offences for corruption or corruption-related offenses, can not be the NIPO's head officer in charge within three years from the date of entry into force of the relevant court decision.

The NIPO's head officer in charge shall be assigned to the position on the basis of results of an open competition conducted by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere, in accordance with the established procedure for a competitive selection of officers of economic operators of the state sector of economy.

The NIPO's head officer in charge shall have one first deputy and two deputies appointed by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere, on the recommendation of the NIPO's head officer in charge.

8. The Supervisory Board shall be the supervisory body of the NIPO and is formed to include:

- two representatives of the Verkhovna Rada of Ukraine;

- two representatives of the central executive body ensuring the state policy formation and implementation in the intellectual property sphere;
- one representative of the central executive body ensuring the state policy formation and implementation in the fields of science and education;
- one representative of public organizations of representatives on intellectual property matters (patent attorneys);
- one representative of the National Academy of Sciences of Ukraine.

The Supervisory Board may include two representatives of international and/or regional intellectual property organizations in an advisory capacity.

The personal composition of the Supervisory Board shall be approved by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere.

The Supervisory Board members shall perform their duties on a voluntary basis.

The Chairperson of the Supervisory Board and the Deputies shall be elected by the members of the Supervisory Board from among them. A representative of the central executive body ensuring the state policy formation and implementation in the intellectual property sphere can not be the Chairperson of the Supervisory Board.

The powers of the Supervisory Board shall include the supervision of financial and economic activities of the NIPO, the implementation of the finance plan, the use of funds formed with receipts from payment of fees for the actions connected with intellectual property rights protection.

The Supervisory Board shall have the right:

- to request and receive any information from the NIPO, except for the information with limited access;
- to hear reports of the NIPO's head officer in charge on the status of the implementation of its powers, on the implementation of financial and economic activities, on the implementation of the budget, on the use of funds formed with receipts from payment of fees for the actions connected with intellectual property rights protection, as well as the plan of the NIPO activities;
- to submit recommendations to the NIPO, mandatory for consideration;

- to inform the central executive body ensuring the state policy formation and implementation in the intellectual property sphere about the revealed violations.

The term of powers of the Supervisory Board members, except for the Chairperson, shall last for two years and can be renewed for no more than one period. Upon expiration of the term of office of a member of the Supervisory Board, the relevant body or organization that delegated him shall, within one month, delegate a new representative to the Supervisory Board or decide to extend the term of office of the member of the Supervisory Board.

Early termination of powers of a member of the Supervisory Board may be applied at the request of the authority that delegated him. The powers of a member of the Supervisory Board are also terminated at the initiative of the Supervisory Board in case of:

- submitting a letter of resignation for termination of powers;
- inability to perform one's duties, including on health grounds;
- termination of relations with the delegating authority;
- entry into force of a court sentence against the member;
- death or on the basis of a court decision declaring the member incapable, of limited legal capacity, missing or to be deceased;
- application of administrative penalties for corruption or corruption-related offenses.

The authority that has delegated a member of the Supervisory Board, whose powers have been terminated, is required to delegate a new representative to the Supervisory Board within one month from the date of early termination of powers of the previous representative.

The Supervisory Board shall act in accordance with this Law and the Regulations on the Supervisory Board approved by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere.

The form of work of the Supervisory Board shall be a session on which the minutes are drawn up a copy of which is sent to the NIPO and the central executive body ensuring the state policy formation and implementation in the intellectual property sphere. A session of the Supervisory Board shall be considered valid if a simple majority of the Supervisory Board members is present.

The placement as well as organizational and material support of the Supervisory Board shall be provided by the NIPO.

9. Each year, the NIPO publishes financial statements on its official website, including annual financial statements, audit reports on annual financial statements, reports on its activities, including the finance plan execution and a finance plan for the following year.

Financial or consolidated financial statements of the NIPO shall be subject to auditing, which is carried out by the decision of the central executive body ensuring the state policy formation and implementation in the intellectual property sphere.

10. The NIPO can not have acquisition of income from its activities as the objective. The activities of the NIPO are funded from income from payment of fees for the actions connected with the protection of intellectual property rights, as well as other sources not prohibited by the law.

The NIPO procures goods, works and services pursuant to and as specified in the procedures established by the Law of Ukraine "On Public Procurements".

11. A qualified electronic signature may be used on the documents accepted or approved by the NIPO in accordance with this Law. Electronic submission of documents to the NIPO and issuance of documents is carried out in accordance with the legislation in the field of electronic documents and electronic document management, electronic trust services, this Law and the regulations established by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere.

Article 2². Guarantees of Independence of the Appeals Chamber and Examiners of the National Intellectual Property Office

1. The activities of the Appeals Chamber shall be based on the principles of legality, impartiality, independence, transparency, reliability, collegiality and qualified personnel support.

2. The main principles governing the processing of appeals and requests by the Appeals Chamber shall be the rule of the law, legitimacy as well as the equality of participants in the proceedings before the law and the Appeals Chamber.

3. The powers of the Appeals Chamber, member requirements, the procedure for processing of appeals against the NIPO decisions on acquisition of intellectual property rights by the Appeals Chamber, the procedure for organizational and technical support of the Appeals Chamber and other matters within its competence shall be determined by the Rules of the Appeals Chamber, approved by the central

executive body ensuring the state policy formation and implementation in the intellectual property sphere.

4. Independence of the NIPO examiner and correctness of his decision shall be ensured by:

- compliance with the regulations established by the law for appointment and carrying out of examination;
- prohibition of interference in the examination process by any person;
- arrangement of conditions necessary for the activity of the NIPO examiner, his material, social and other support;
- enabling the Appeals Chamber to review the examination opinions;
- enabling the possibility to participate in the examination procedure for an applicant and third parties in cases provided by the Law.

Article 2³. Attestation Commission

1. The Attestation Commission is a collegial body of the NIPO, which is formed to determine the professional level of persons who have expressed their intention to acquire the right to practice the activities of a representative on intellectual property matters (patent attorney).

2. The Attestation Commission shall consist of employees of the NIPO, the central executive body ensuring the state policy formation and implementation in the intellectual property sphere, and of the representatives on intellectual property matters (patent attorneys) who have not less than ten years of practical experience in the field of intellectual property legal protection.

3. The authorities of the Attestation Commission, its composition, formation procedure, member requirements, term of membership and the rules and procedures of its activity are determined by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere.

4. The Attestation Commission shall act on the basis of this Law and the regulations approved by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere.

Article 2⁴. Appeals Commission

1. The Appeals Commission is a collegial body of the NIPO, which is formed to process appeals of the candidates for representatives on intellectual property

matters (patent attorneys) against the decisions of the Attestation Commission, appeals against the actions of representatives on intellectual property matters (patent attorneys), and in order to monitor the compliance of patent attorneys with legal requirements.

2. The Appeals Commission shall consist of employees of the NIPO, the central executive body ensuring the state policy formation and implementation in the intellectual property sphere, distinguished scientists working in the intellectual property domain and representatives on intellectual property matters (patent attorneys) with not less than ten years of practical experience in the field of intellectual property legal protection.

3. The authorities of the Appeals Commission, its composition, formation procedure, member requirements, term of membership and the rules and procedures of its activity are determined by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere.

4. The Appeals Commission shall act on the basis of this Law and the regulations approved by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere.

Article 3. International Agreements

If any international agreement of Ukraine, consent to be bound by which is granted by the Verkhovna Rada of Ukraine, has set rules other than those provided by the legislation of Ukraine on trademarks, the rules of the international agreement shall apply.

Article 4. Rights of Foreign and Other Persons

1. Foreign persons and stateless persons have equal rights with persons of Ukraine provided by this Law in accordance with international agreements of Ukraine the binding nature of which has been approved by the Verkhovna Rada of Ukraine.

2. Foreigners, stateless persons, foreign legal entities and other persons having the place of permanent residence or permanent location outside Ukraine shall exercise their rights in relations with the NIPO through representatives on intellectual property matters (patent attorneys) registered under the regulations approved by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere.

Section II

LEGAL PROTECTION OF TRADEMARKS

Article 5. Terms of Legal Protection Provision

1. The legal protection is provided to a trademark that is not contrary to public order and generally accepted principles of morality, requirements of the *Law of Ukraine On Condemnation of the Communist and National-Socialist (Nazi) Totalitarian Regimes in Ukraine and Prohibition of Propaganda of Their Symbols* and is not subject to grounds for refusal of legal protection defined by this Law.

2. Any sign or any combination of signs may be the subject of a trademark. Such signs may be, in particular, words, including personal names, letters, numerals, figurative elements, colors, the shape of products or their packaging, sounds, provided that such signs are suitable to distinguish the goods or services of one person from the goods or services of other persons, are appropriate for their reproduction in the Register in such a way as to enable clear and precise scope of the granted legal protection. The names or pseudonyms of persons who held administrative posts in the Communist Party (the position of a Secretary for the District Committee and above), in the highest agencies of the state power and administration of the USSR, the Ukrainian Soviet Socialist Republic (Ukrainian Socialist Soviet Republic), other union or autonomous Soviet republics (except the cases related to the development of the Ukrainian science and culture), who worked in the Soviet state security agencies, the names of the USSR, the Ukrainian Soviet Socialist Republic (Ukrainian Socialist Soviet Republic), other Soviet Union republics and their derivatives, names connected with the activities of the Communist Party, the establishment of the Soviet power in the territory of Ukraine or in the separate administrative and territorial units, persecution of the participants in the struggle for independence of Ukraine in the XX century can not be the subject of a trademark.

3. The acquisition of the right to a trademark shall be certified by a trademark certificate. The validity period of a certificate is ten years from the date of filing an application to the NIPO and may be extended by the NIPO at the request of the certificate holder every ten years, provided that the respective fee is paid under the procedure of Article 18(2) of this Law. The procedure for extending the validity period of the certificate shall be determined by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere.

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

The acquisition of rights to a trademark, which has the international registration or which is recognized to be well known in Ukraine, shall not be required to be certified with a relevant certificate.

4. The scope of the granted legal protection is defined by the reproduction of a trademark and by the list of goods and services, which are recorded in the Register,

and is certified by the certificate that shall contain a copy of the reproduction of the trademark recorded in the Register and the list of goods and services.

5. Any person, associations of persons, or their successors shall have the right to obtain a certificate in accordance with the procedure determined by this Law.

6. An applicant whose application has the earlier date of filing to the NIPO or, if the application priority has been claimed, the applicant whose application has the earlier date of priority shall have the right to obtain a certificate, provided that the application is not considered withdrawn, was not withdrawn, or the NIPO did not take a decision to refuse a trademark registration where the possibilities to appeal such a decision are exhausted.

Article 6. Grounds for Refusal of Legal Protection

1. According to this Law, the legal protection shall not be granted for signs that represent or imitate:

- state armorial bearings, flags and other state symbols (emblems);
- full or abbreviated official names of states or international two-letter codes of states;
- emblems and abbreviated or full names of international intergovernmental organizations;
- official control, guarantee or testing seals, stamps;
- decorations and other honorable distinctions.

The said signs may be included as non-protected elements of a trademark, provided that there is the consent of the relevant authorized body or the owners thereof. The authorized body for granting permission to use the official name and international two-letter code of the Ukrainian state in a trademark shall be a collegial body established by the NIPO.

2. According to this Law, the legal protection shall also not be provided for signs which:

- are usually not distinctive in nature and have not obtained such a character through their use;
- consist only of signs that are generally used in the modern language or in fair and constant trade practices on goods and services;

- consist only of signs or data which are descriptive while using in terms of goods and services referred to in the application or due to them, show the type, quality, composition, quantity, properties, intended purpose, value of goods and services, geographical origin, the place and time of production or selling of goods or provision of services, or other specifications of goods or services;
- may mislead the public with regard to the goods or services, namely, as to their nature, quality or geographical origin;
- may mislead the public with regard to the person manufacturing the product or rendering the service;
- consist exclusively of signs that are commonly used symbols and terms;
- represent only the form imposed by the nature of a product itself or by the necessity to obtain a technical result, or by the form which gives substantial value to a product;
- 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 agreement of Ukraine before the date of filing an application for a trademark containing such a sign, and if the claimed sign concerns a plant variety of the same or related species;
- contain geographical indications (including for wines and spirits) registered or applied for registration in Ukraine, or which are granted legal protection in compliance with the relevant international agreement of Ukraine, prior to the date of filing an application for a trademark which contains such an indication, and if the priority has been claimed - prior to the date of priority for the same or related goods, if when using the sign applied for reputation of a geographical indication is used and/or the sign applied for misleads the public as to the special quality, characteristics and true origin of the product.

The signs referred to in paragraphs two, three, four, seven and eight of this clause may be included in a trademark as non-protected elements in the event that these signs are not dominative in the image of the trademark.

The signs referred to in paragraphs two, three, four, seven and eight of this clause may be granted legal protection in the event that they have acquired distinctive character as a result of their use prior to the date of application.

3. Signs shall not be registered as trademarks when as of the date of filing an application or, if the priority is claimed, as of the date of priority, they are identical or similar to such an extent that they may be confused, in particular, associated with:

- trademarks that were earlier registered or filed for the registration in Ukraine in the name of another person for identical or similar goods and services;
- trademarks of other persons if such trademarks are protected without registration in the territory of Ukraine on the basis of the international agreements of Ukraine, namely, the trademarks recognized as well-known in compliance with Article 6^{bis} of the Paris Convention in terms of identical or similar goods and services;
- trademarks of other persons, if such trademarks are protected without registration in the territory of Ukraine on the basis of the international agreements of Ukraine, namely, the trademarks recognized as well-known in compliance with Article 6^{bis} of the Paris Convention in terms of non-related goods and services, if the use of a trademark by another person in regard to such non-related goods and services indicates the connection between them and the owner of a well-known trademark and may harm the interests of such owner;
- trade names that are known in Ukraine and belong to other persons who have acquired the right to the said names before the date of filing the applications with the NIPO with respect to identical or similar goods and services;
- conformity marks (certification marks) registered in accordance with the established procedure;
- trademarks used by another person in a foreign state, if an application is filed on his own behalf by an agent or a representative of such person within the meaning of Article 6^{septies} of the Paris Convention without such person's authorization and there are no proofs that justify such filing if there is an opposition by such person.

4. Signs shall not be registered as trademarks if they reproduce:

- industrial designs the rights to which belong to other persons in Ukraine;
- titles of scientific, literary and artistic works known in Ukraine or quotations and characters from the said works as well as the artistic works and their fragments without the consent of copyright holders or their successors in title;
- surnames, first names, pseudonyms and their derivatives, portraits and facsimiles of persons known in Ukraine without their consent.

5. Signs that contradict the requirements of Article 5(2) of this Law and the Law of Ukraine *On Condemnation of the Communist and National-Socialist (Nazi)*

Totalitarian Regimes in Ukraine and Prohibition of Propaganda of Their Symbols shall not be granted legal protection and shall not be registered as trademarks.

6. Signs referred to in paragraphs two to five and seven of Article 6(3) and paragraph two of Article 6(4) may be registered as trademarks, if consent is given by a certificate holder of the earlier registered trademark or the holder of the other earlier acquired right and there is no possibility to mislead the consumers.

Section III

PROCEDURE FOR OBTAINING A TRADEMARK CERTIFICATE

Article 7. Application

1. A person willing to obtain a trademark certificate shall file an application with the NIPO.

An application may be filed on paper or electronically. The method of filing an application shall be chosen by an applicant.

Applications filed in electronic form are subject to electronic record keeping in compliance with the legislation in the field of electronic documents and electronic document management, this Law and the rules established on their basis by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere. Applications in electronic form shall be filed subject to the identification of an applicant (representative on intellectual property matters or other authorized person of the applicant) with the use of a qualified electronic signature.

2. On behalf of an applicant, an application may be filed through a representative on intellectual property matters or other authorized person.

3. An application shall relate to one trademark.

4. An application shall be drawn up in the Ukrainian language and shall contain:

- a request for registration of a trademark;
- an image of the sign that is applied for;
- a list of goods and services for which a trademark is claimed by an applicant that are grouped according to the Nice Classification.

5. The applicant(s) and his address shall be indicated in a request for a trademark registration.

A relevant checkmark shall be made in a request for a collective trademark registration together with the indication of the list of persons entitled to use such trademark. The request for registration of a collective trademark shall also be accompanied by the document that sets out the terms of its use.

6. If an applicant claims the protection of a color or combination of colors as a distinctive feature of a trademark, he is obliged to:

- make a statement of that and indicate the color or combination of colors to be protected in the application;
- provide color reproductions of the specified trademark in the application. The number of copies of such reproductions shall be prescribed by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere;
- provide examples of using the trademark, if the claimed sign is a color as such.

7. An application shall be drawn up and filed in accordance with the rules established by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere.

8. The filing of an application shall be subject to payment of the respective fee. The fee amount shall be determined with consideration of a number of applicants and the Nice Classification classes related to the goods and services indicated in the application, as well as the peculiarities of the sign claimed for. The aforementioned fee shall be paid before the day of expiry of two months upon the date of filing the application. This period may be extended but for no more than six months, provided that the relevant request is filed and the respective fee for filing the request has been paid prior to the expiry of this period.

Article 8. Application Filing Date

1. The date of filing an application shall be the date on which the NIPO received the documents containing at least:

- a request for a trademark registration in no particular form, set forth in the Ukrainian language;
- information on the applicant and his address, set forth in the Ukrainian language;
- a sufficiently clear image of the sign that is claimed;
- the list of goods and services for which the trademark is claimed, set forth in the Ukrainian language.

2. The date of filing an application shall be established according to Article 10(10) and 10(11) of this Law.

Article 9. Priority

1. An applicant shall have the right to claim the priority of an earlier filing for the same trademark relating to the same goods and services or those covered by the list of goods and services to which the earlier filing relates, within the six-month period from the date of the earlier filing with the NIPO or the relevant Office of a State party to the Paris Convention or the Agreement Establishing the World Trade Organization, provided that there is no priority claimed in respect of the earlier application.

2. The priority of a trademark used in an exhibit, presented at official or officially recognized international exhibitions in the territory of a State party to Paris Convention or the Agreement Establishing the World Trade Organization, may be determined by the date of commencement of the first open display of the exhibit at the exhibition, where the claimed trademark was used or presented, provided that the NIPO has received an application within the six-month period from the said date.

3. An applicant willing to use the priority right, during three months from the day of application filing with the NIPO, shall file a priority claim, with reference to the filing date and the number of an earlier application along with the copy thereof with the Ukrainian translation or the document confirming the trademark presentation at the exhibition, provided that this application has been filed or the display was held in the territory of a State party to Paris Convention or the Agreement Establishing the World Trade Organization. The mentioned materials may be changed within the said period. If these materials are filed untimely, the priority right of the application shall be lost, and the applicant shall be notified whereof.

Article 10. Examination of an Application

1. The examination of an application consists of the formality examination and substantive examination (examination by substance) and is carried out by the NIPO according to this Law and regulations issued in compliance with this Law by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere.

2. The examining authority carries out information activity required for examination of applications and is the Centre of International Exchange of Publications according to the Convention concerning the International Exchange of Publications, adopted on December 3, 1958 by the General Conference of the United Nations Educational, Scientific and Cultural Organization.

3. The final results of the examination of an application that is not considered to be withdrawn or is not withdrawn or of a trademark under the international registration are presented in the grounded examination opinion which shall take effect on the day of its approval by the NIPO.

Based on such an opinion regarding the application, the NIPO shall make a decision on the registration of the trademark for all the goods and services listed in the application or on a refusal of the registration of the trademark for all the goods and services listed in the application, or on the registration of the trademark for some of the goods and services listed in the application and on a refusal of the registration of the trademark for another part of the goods and services listed in the application. The decision of the NIPO on the application shall be sent to the applicant.

After the examination opinion on a trademark under the international registration is approved, the NIPO shall make a decision on the grant or refusal to grant legal protection to the trademark under the international registration in Ukraine for all the listed goods and services or on the grant of legal protection to the trademark under the international registration in Ukraine for some of the listed goods and services.

A request on the grant of legal protection to a trademark under the international registration in Ukraine shall be sent to the International Bureau of WIPO.

If upon approval of the examination opinion on the trademark under the international registration the NIPO has made a decision on refusal to grant legal protection to the trademark under the international registration in Ukraine for all the listed goods and services or on the grant of legal protection to the trademark for some of the listed goods and services, a relevant statement shall be sent to the International Bureau of WIPO.

An applicant has the right to request copies of the materials, which were opposed to the relevant application, within one month from the date of receiving the decision by the NIPO. For the holder of the international registration, such term shall be two months from the date of sending the declaration on refusal to grant legal protection to the trademark under the international registration in Ukraine for all specified goods and services or on the grant of legal protection to the trademark for some of the said goods and services to the International Bureau of WIPO by the NIPO.

The said copies shall be sent to the applicant or the holder of the international registration respectively within one month.

4. An applicant shall have the right, on his own initiative or on the NIPO invitation, personally or via his representative to participate in consideration of the

matters arising in the course of examination under the procedure specified by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere.

5. An applicant shall have the right to correct errors in an application and to change the name and address, the address for correspondence and the name and address of his representative as well as to make changes on narrowing the list of goods and services.

An applicant is allowed to make changes in the application that are connected with the change of the person filing the application by the consent of other applicants indicated in the application. A person who wishes to become an applicant may also make such changes by the consent of all the applicants.

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

A request for correction of an error or making any of the mentioned changes is subject to payment of the respective fee, provided that an error is not obvious or technical, and a change was made for reasons within the control of the person filing the application.

6. The examining authority may demand from an applicant to submit additional materials if the examination is impossible without such materials or where it has reasonable grounds to doubt the veracity of the indications given or elements presented in the application documents.

The applicant shall have the right to request copies of the materials, which were opposed to the application, from the NIPO, within a month from the date of receiving a notification or an opinion with the demand to submit additional materials.

The applicant shall submit additional materials within two months from the date of receiving a notification or an opinion or copies of the materials, which were opposed to the application. In the event the applicant fails to provide the materials within the established term, the application shall be deemed to have been withdrawn, which shall be communicated to the applicant by a notification.

The term for submission of additional materials shall be prolonged but no more than by six months, in the event a relevant request is submitted 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 additional materials and a fee for its submission is paid, the rights of the applicant concerning the application shall be restored.

7. If an applicant has submitted additional materials, in the course of examination it is determined whether these materials do not go beyond the substance of the sign revealed in the application and the list of goods and services presented in the application.

Additional materials go beyond the substance of the sign revealed in the application if they contain features that should be included to the sign that is claimed as a trademark.

Additional materials are not taken into consideration in the course of the examination in a part that goes beyond the substance of the sign revealed in the application or broadens the list of goods and services in the application and may be presented by the applicant as an individual application after receiving the relevant notification of the NIPO.

8. Within three months from the date of publication, in the Bulletin in compliance with Part 10 of this Article, of information regarding an application or international registration of a trademark, or territorial extension of the international registration to Ukraine made after the international registration, any person shall have the right to file a grounded opposition to the application or validity of the international registration in Ukraine to NIPO with regard to non-compliance of the sign represented therein with the terms of providing legal protection established by this Law.

Filing of an opposition is subject to payment of the respective fee.

Requirements for an opposition shall be determined by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere. An opposition shall be filed together with a copy thereof.

The examining authority shall send a copy of the opposition to the applicant.

The applicant shall have the right to notify the NIPO of his opinion on the opposition within two months after receipt thereof. The applicant may overcome the opposition and leave the application unchanged, make changes in the application, or withdraw the application. For the holder of an 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 opposition to the International Bureau of WIPO.

9. In the course of the formalities examination:

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

the application is examined for conformity with the formal requirements of Article 7 of this Law and the regulations issued by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere in compliance with this Law;

the fee paid for filing the application is checked for conformity with the prescribed formalities.

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 filing the application with the established requirements, a notice on the determined date of the application filing shall be sent to the applicant and information, which is determined by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere, 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 data that is subject to publication shall include the following information (if available): the application number; the filing date; the exhibition priority date; the number of the previous application in accordance with the Paris Convention; the filing date 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 and the list of goods and services; index (indexes) of the International Classification of the Figurative Elements of Marks; an image of the mark; colors claimed (a color or combination of protected colors); the applicant (name or full name and address of the applicant (applicants)); the representative (name, full name and registration number of the representative on intellectual property matters (patent attorney) or other authorized person); the addressee (mailing address).

Simultaneously with the publication in the Bulletin, information on the application shall be entered into the Application Database. The procedure of keeping the Application Database and composition of information contained therein shall be determined by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere. The information contained in the Application Database shall include the following data (if available): the application number; the filing date; the exhibition priority date; the number of the previous application in accordance with the Paris Convention; the filing date 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 and the list of goods and services; index (indexes) of the International Classification of the Figurative Elements of Marks; an image of the mark; colors claimed (a color or combination of protected colors); the applicant (name or full name and address of the applicant (applicants)); the representative (name, full

name and registration number of the representative on intellectual property matters (patent attorney) or other authorized person); the addressee (mailing address).

As soon as the information on the application is published, any person shall have the right to review application materials within the procedure established by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere. A fee shall be paid for familiarization with the application materials.

Information on the international registration of a trademark or on the territorial extension of the protection to Ukraine after the international registration shall be published in the Bulletin after the receipt by the NIPO of a notice of the International Bureau of WIPO on the international registration of a trademark or on the territorial extension of the protection to Ukraine after the international registration.

11. If application materials do not meet the requirements of Article 8 of this Law, an applicant is immediately notified of that. If the applicant remedies the nonconformity within two months from the date of receiving the notification, the date on which the NIPO received the corrected application materials is considered to be the date of filing the application. Otherwise, the application is considered to be not filed, and the applicant is notified accordingly.

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

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

14. If the application does not meet formal requirements of Article 7 of this Law and the regulations issued by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere on the basis of this Law, or if the filing fee paid does not comply with the requirements, a notification shall be sent to the applicant with proposals to remedy irregularities.

If irregularities concern the grouping of goods and services, the notification shall contain the list of goods and services grouped by the NIPO and if necessary, the amount of the filing fee to be additionally paid shall be indicated in such notification. When a certain good or service is presented in the application as a term, which does not provide the possibility to classify it in a certain class of the Nice Classification, the applicant is proposed to replace this term or remove it. If the applicant fails to fulfill the request, the said term would not be included to the list of goods and services grouped by the NIPO.

Remedying of the irregularities indicated in the notification is due within the period and under the procedure established in Part 6 of this Article in respect of additional materials.

15. During the substantive examination, compliance of the sign to be protected with the conditions of providing legal protection set forth in this Law shall be verified, and oppositions filed in accordance with Part 8 of this Article shall be considered.

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

A filed opposition shall be considered within the grounds provided for therein and taking into account the applicant's reply, if provided, within the established term.

Results in respect of the opposition shall be specified in the examiner's opinion on the application. A copy of the NIPO decision made on the basis of such examiner's opinion shall be sent to the person that filed the opposition.

If based on the outcomes of the processing the NIPO makes a decision on registration of a trademark for all the goods and services referred to in the application or for some of the goods and services referred to in the application and refusal to register the trademark for the rest of the goods and services referred to in the application, pendency of the application shall be suspended until the expiry of the term set forth in paragraph two of Article 15(1) of this Law for opposing of such a decision by a person, which filed an opposition pursuant to Article 10(8) of this Law.

16. If, based on the substantive examination and opposition processing results, if any, there are reasons to consider that the claimed sign does not meet the requirements for granting the legal protection in whole or in part, the NIPO shall send to the applicant a grounded provisional opinion with an exhaustive list of grounds for non-compliance of the sign applied for with the conditions of granting legal protection in whole or in part, such a provisional opinion may be sent only once with the proposal to provide a substantiated response to support the registration of a trademark.

A response by the applicant shall be provided within the period and under the procedure prescribed by paragraph six of this Article in respect of additional materials, and it is taken into consideration when the examination opinion on the application is prepared.

If based on the substantive examination findings there are grounds to think that the trademark under the international registration does correspond to the terms of providing legal protection in whole or in part, the NIPO shall notify a provisional refusal to provide legal protection to the International Bureau of WIPO. In such a case, a response of the holder of the international registration shall be given under the procedure set forth in Part 6 of this Article within the period of three months from the date of sending such notification by the NIPO.

Article 11. Withdrawal of an Application

An applicant shall have the right to withdraw an application at any time before the date of paying the state duty for granting a certificate.

Article 11¹. Division of an Application

1. Before the NIPO makes a decision on an application, an applicant shall have the right to divide the application into two or more applications (divisional applications) by setting apart the goods and services listed in that application so that each of the divisional applications shall not contain the goods and services similar to the goods and services listed in other applications.

2. Division of an application shall be accomplished by the applicant with filing a request for making relevant changes in the application and a divisional application (applications), provided that respective fees are paid for filing the request and the application.

3. The date of filing the divisional application shall be the same as the date of filing the divided application. The priority date of the divisional application shall be determined the same as the priority date of the divided application, if there is a ground for that.

Article 12. Publication on Granting a Certificate

On the basis of the decision on registration of a trademark and provided that the document confirming payment of the state duty for granting a certificate and the fee for publication on granting a certificate are available, information concerning granting a certificate determined under the specified procedure is published in the Bulletin. An applicant shall pay the said duty and fee after receiving the decision on registration of a trademark.

If within three months from the date of receiving the decision on registration of a trademark by an applicant a document on the payment of the state duty for granting a certificate and the fee for publication on granting a certificate in the amount and under the procedure defined by the legislation were not received by the NIPO, the

publication would not be provided, and the application would be considered withdrawn.

The term for receiving a document on the payment of the state duty for granting a certificate and the fee for publication on granting a certificate shall be prolonged but not more than by six months, provided that a relevant request is submitted and the fee for submission thereof is paid prior to the expiry of the above term. If the term for receiving a document on the payment of the state duty for granting a certificate and the fee for publication on granting a certificate is missed for serious reasons, rights of the applicant in respect of the application shall be restored in the event that a relevant request is filed within six months upon expiry of the aforementioned term together with the document on the payment of the state duty for granting a certificate and the fee for publication on granting a certificate and the fee for filing the request.

At the same time with sending an application on provision of legal protection to a trademark under the international registration in Ukraine to the International Bureau of WIPO, the relevant information shall be published in the Bulletin.

Article 13. Registration of a Trademark

1. At the same time with the publication of the data concerning granting a certificate, the NIPO provides the state registration of a trademark. The procedure of keeping the Register and composition of information contained in the Register shall be determined by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere.

2. After recording the data in the Register, any person has the right to access this information under the procedure specified by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere and to obtain an abstract of the data concerning a certificate from the Register upon a request, provided that the fee for submission of the said request is paid.

3. Errors in the data recorded in the Register shall be corrected on the initiative of the certificate holder or the NIPO.

Changes to the Register may be recorded on the initiative of the certificate holder according to the specified list of possible changes.

A fee shall be paid for the submission of a request on correction of an error or any amendment, subject to the fact that the error is not obvious or technical, and the amendment occurred due to the circumstances depending on the applicant.

Article 14. Granting a Certificate

1. The NIPO shall grant a certificate within a month after the state registration of a trademark. A certificate shall be granted to a person that has the right to obtain the certificate. If several persons have the right to obtain a certificate, they shall obtain a single certificate.
2. The form of a certificate and the contents of the data indicated therein shall be specified by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere.
3. A granted certificate may be corrected by the NIPO upon the request of the certificate holder for correcting obvious errors with the following notification on that in the Bulletin.
4. In case a certificate is lost or damaged, the certificate holder shall be granted a certificate duplicate under the procedure determined by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere. Granting a duplicate of a certificate is subject to payment of the respective fee.

Article 15. Appellation against the NIPO Decision

1. An applicant may appeal to the court or the Appeals Chamber against the NIPO decision on the application within two months from the date of receipt of the NIPO decision or the copies of documents requested according to Article 10(3) of this Law. For the international registration holder, this term shall be three months from the date of sending the statement of refusal to provide legal protection to the trademark under the international registration in Ukraine for all the listed goods and services or to provide legal protection to the trademark in respect of some of the listed goods and services to the International Bureau of WIPO by the NIPO.

A person who has filed an opposition in accordance with Article 10(8) of this Law, may appeal the NIPO decision to the Appeals Chamber within two months from the date of receipt of a copy of the decision sent to such a person in compliance with paragraph four of Article 10(15) of this Law.

3. An applicant shall be deprived of the right to appeal the decision of the NIPO with the Appeals Chamber in the event of payment of the state duty for granting a certificate.
4. An appeal against the NIPO decision in the Appeals Chamber is accomplished by filing an opposition with respect to the decision under the procedure determined by this Law and the regulations of the Appeals Chamber on the basis thereof, approved by the NIPO. Filing an opposition shall be subject to payment of the respective fee. If the fee is not paid within the period specified in Part 1 of this

Article, the opposition is considered to be not filed and the person who has filed the opposition is sent a notification.

5. Where the Appeals Chamber receives the opposition and payment of the fee for filing an opposition, the processing of the application shall be suspended until the decision of the Appeals Chamber is approved.

In the case of filing an opposition against the NIPO decision on the application in accordance with paragraph two of Part 1 of this Article, a notification and a copy of such opposition shall immediately be sent to the applicant. The applicant shall have the right to submit a substantiated response to the opposition to the Appeals Chamber in the manner and within the period of time established by the regulations of the Appeals Chamber.

6. An opposition against the NIPO decision on the application shall be considered according to the Appeals Chamber regulations within two months from the date of receipt of the opposition and of the fee payment document for filing an opposition, within the scope of the reasons presented in the opposition and in the course of discussion of the opposition and taking into account the applicant's reply, in case of its receipt. The period for consideration of the opposition may be extended on the initiative of the applicant or the person who has filed an opposition in accordance with paragraph two of Part 1 of this Article, but for no more than two months, provided that the relevant request is submitted and the fee is paid with respect to the request.

7. On the results of the consideration of the opposition, the Appeals Chamber shall make a grounded decision that shall be approved by the order of the NIPO and sent to the applicant and to the person who has filed the opposition, in case the opposition is filed by the person in accordance with paragraph two of Part 1 of this Article.

If the opposition was satisfied in whole or in part, the fee for filing the opposition shall be returned to the applicant in the amount of 50 percent of the fee set for filing an opposition.

In case the opposition is filed by a person who is not the applicant, the Appeals Chamber shall send a duplicate copy of such decision to the applicant based on the outcomes of the opposition consideration.

9. The applicant or a person who has filed an opposition in accordance with paragraph two of Part 1 of this Article may appeal to the court against the Appeals Chamber decision approved by the NIPO within two months from the date of receipt of the decision.

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

Section IV

RIGHTS AND OBLIGATIONS DERIVING FROM A CERTIFICATE

Article 16. Rights deriving from a Certificate

1. The rights deriving from a certificate are effective from the date of filing an application.

2. The certificate holder has the right to use the trademark and exercise other rights provided by this Law.

3. When using the trademark, the relations between several persons the holders of the certificate shall be defined by an agreement between them. If such agreement is not available, each certificate holder may use the trademark at his own discretion, but none of them has the right to grant a permission (a license) for the use of the trademark and transfer the trademark property right to another person without consent of other certificate holders.

4. The following shall be considered to be the use of a trademark:

applying thereof on any product for which the trademark is registered, a package containing such product, a signboard related to the product, a label, a tab, a tag or another item attached to the product, storing such product with the mentioned application of the trademark with the purpose of offering for sale, offering it for sale, selling, importing (coming-in) and exporting (coming-out);

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

using thereof in business documentation or in advertising and in the Internet.

A trademark is considered to be used if it was applied in the form of the registered trademark as well as in the form differing from the registered mark only by certain elements if that does not change the distinctive features of the trademark taken as a whole.

5. A certificate holder has the exclusive right to prohibit other persons, unless otherwise is stated in this Law, to use without his consent:

a sign that is identical with the registered trademark with respect to the goods and services listed in the certificate;

a sign that is identical with the registered trademark with respect to the goods and services related to those listed in the certificate, if such a use may result in confusion of the said sign and the trademark, in particular, if there may appear an association of such sign with the trademark;

a sign that is similar to the registered trademark with respect to the goods and services listed in the certificate, if such a use may result in confusion of the said signs, in particular, if there may appear an association of such sign with the trademark;

a sign that is similar to the registered trademark with respect to the goods and services related to those listed in the certificate, if such a use may result in confusion of the said signs, in particular, if there may appear an association of such sign with the trademark.

6. The exclusive right of a certificate holder to prohibit the other persons to use the registered mark without his consent does not apply to:

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

the use of the trademark for a product put into the civil circulation under this trademark by the certificate holder or by his consent, provided that the certificate holder has no essential reasons to prohibit such use in connection with the following sale of the product, in particular in case of change or deterioration of the product after putting it into the civil circulation;

the use of signs, in 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 goods or services, provided the lack of signs of violating rights of the trademark certificate holder;

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

application of the trademark in 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 a trademark is applied according to fair business practice and with the observance of provisions of the legislation on the protection against unfair competition;

noncommercial use of the trademark;

all the forms of broadcasting the news and commenting upon the news;

fair use of names or addresses of the said persons;

the use of the trademark in comparative advertising, which is carried out in accordance with the legislation on advertising, protection against unfair competition and is not related to unfair business practices.

The exclusive right of a certificate holder to a trademark, which contains a geographical indication, to prohibit the other persons to use the registered trademark without his consent shall not apply to fair use of the relevant geographical name by other persons.

7. A certificate holder may transfer, by an agreement, the property right to a trademark to any person in whole or with respect to a part of the goods and services listed in the certificate.

8. A certificate holder has the right to grant a permission (a license) to use a trademark to any person under a licensing agreement.

The licensing agreement shall contain, inter alia, information about the ways of using the trademark, the territory and term for which the use of it is allowed, and the clause stating that the quality of goods and services manufactured or rendered under the licensing agreement shall not be lower than the quality of goods and services of the certificate holder, and that the certificate holder will provide the control over the fulfillment of the said requirement.

9. A trademark assignment agreement and a licensing agreement are considered to be valid if they were concluded in writing and signed by the parties.

Each party of an agreement shall have the right to notify an indefinite circle of persons about transferring the property right to a trademark or granting a license for using a trademark. Such a notification is provided by publishing the information in the Bulletin in the scope and under the procedure determined by the NIPO with simultaneous recording of this data in the Register.

Publication of information about transferring the property right to a trademark in whole and about granting a license to use a trademark as well as about the changes to the data on the license grant proposed by the party to the agreement is subject to payment of respective fees.

In the case of publishing information about transferring the property right to a trademark with respect to a part of the goods and services listed in a certificate the

NIPO shall grant a new certificate in the name of the person to which the said right was transferred, provided that the document confirming the state duty payment for granting a new certificate is available.

10. A certificate holder has the right to place a warning marking alongside of a trademark in the form of the circled Latin character "R" that indicates that the trademark is registered in Ukraine.

11. A certificate holder that carries out re-selling activity, under an agreement with the manufacturer of goods or the person rendering services, has the right to use his own trademark alongside of the trademark of the said persons as well as instead of their trademark.

Article 17. Obligations Deriving from a Certificate

A certificate holder shall exercise the rights deriving from a certificate in good faith.

Section V

CEASING OF EFFECT AND INVALIDATION OF A CERTIFICATE

Article 18. Ceasing of a Certificate Effect

1. A certificate holder may at any time renounce the certificate in whole or in part upon a request submitted to the NIPO. The renunciation shall be effective from the date of publishing the relevant information in the Bulletin.

2. A certificate effect is ceased in the case of non-payment of the renewal fee. A request for prolongation of the certificate and each renewal fee are to be received by the NIPO within the last six months of the period of validity.

The renewal fee may be paid and the payment document may be submitted to the NIPO within six months after the expiry of the established period. In this case, the amount of the fee is increased by 50 percent.

A certificate effect is ceased from the first day of the period of validity for which the fee has not been paid.

3. A certificate shall be ceased by court judgement:

in connection with transformation of the trademark into a commonly used sign for goods and services of a certain type after the date of publishing information on granting the certificate;

if following the use of the trademark by the certificate holder or by other person upon his consent, it 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 cessation of the trademark applies to certain goods or services, the certificate shall cease to have effect only with regard to such goods or services.

4. If a trademark is not used in Ukraine, in whole or with respect to a part of the goods and services listed in the certificate, continuously within five years from the date of publishing the information on granting 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 has the right to appeal to the court with a request for previous cessation of the certificate in whole or in part.

For the purposes of applying this clause, 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 NIPO on provision of legal protection to the trademark under the international registration in Ukraine.

In such a case, effect of the certificate or international registration in Ukraine may be ceased in whole or in part unless the certificate holder gives good cause for such non-use. The said valid reasons are the circumstances preventing the use of the trademark despite the will of the holder of the certificate or the international registration, in particular, such as limitation of import or other requirements to goods and services that are determined by the legislation.

For the purposes of this clause the use of the trademark by the certificate holder is also considered to be the use of this trademark by another person by permission of the certificate holder.

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

The certificate may not be ceased if, within the period from the expiry of a five-year term of non-use of the trademark until filing the action for previous cessation of the certificate, the trademark has come into use or its use was resumed, except for the case when preparation to the use or resuming of the use of the trademark had started within three months prior to filing such action and after the certificate holder has learned about a possibility to file it.

Article 19. Invalidation of a Certificate

1. A certificate may be invalidated in whole or in part by the court in the following cases:

- a) the registered trademark does not meet the requirements for granting legal protection;
 - b) the certificate contains elements of the trademark reproduction and the list of goods and services that were not presented in the filed application;
 - c) the certificate was granted in the result of filing an application with infringement of other persons' rights.
2. If a certificate is considered to be invalid in whole or in part, the NIPO shall inform about that in its Bulletin.
 3. A certificate or its part that have been considered to be invalid, are considered to be those that didn't take effect from the date following the application filing date.
 4. A person who is the owner of a trademark in a foreign state, the right to which has been obtained in Ukraine by the agent or the representative without the owner's consent, may claim the recognition of the certificate to such trademark invalid, in case the agent or the representative fail to justify their actions by relevant proofs.
 5. If a certificate has been invalidated and the court has established that the application had been filed with violation of other persons' rights, the court may decide on compensation of losses by the certificate holder in favor of the person that suffered from losses caused by the actions resulting from the registration of the trademark with violation of that person's rights.

Section VI

ENFORCEMENT OF RIGHTS

Article 20. Infringement of the Certificate Holder Rights

1. Any encroachment on the rights of a certificate holder that are defined in Article 16 of this Law, including the actions that shall be agreed with the certificate holder but are carried out without his consent, as well as a preparation for such actions, is considered to be the infringement of the certificate holder rights resulting in prosecution according to the current legislation of Ukraine.

The use of trademarks and signs specified in Article 16(5) of this Law in domain names without the certificate holder consent is also considered to be the infringement of the rights.

2. On the request of the certificate holder, the said infringement shall be terminated and the infringer is obliged to indemnify the actual damage to the certificate holder.

The certificate holder may also demand to remove the illegally used trademark or sign, which is similar to it to the extent that the trademark and the sign may be confused, from the product, from its packaging, or to liquidate the manufactured reproductions of the said trademark or the sign, which is similar to it to the extent that they may be confused.

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

Article 21. Methods of the Rights Enforcement

1. The enforcement of rights to a trademark is provided in courts or under other procedure determined by the legislation.

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

The courts, according to their competence, shall resolve, in particular, disputes concerning:

determination of the certificate holder;

conclusion and execution of licensing agreements;

infringement of the certificate holder rights.

Article 22. Re-Registration Right

No person but the former holder of a certificate has the right to re-register a trademark within two years after cessation of the certificate in accordance with Article 18(1) and (2) of this Law except for the cases when the holder of the ceased certificate grants consent for registration of the trademark that was applied for.

Section VII

CONCLUSIVE PROVISIONS

Article 23. State Duty and Fees

The amount of and the procedure for paying the state duty for granting certificates to trademarks are determined according to the legislation.

Funds received from the payments of the state duty for granting certificates to trademarks shall be credited to the budgets within the procedure provided for in the Budget Code of Ukraine.

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

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

Article 24. Registration of a Trademark in Foreign Countries

1. Any person has the right to register a trademark in foreign countries.
2. In the case of registration of a trademark in foreign countries, according to the Madrid Agreement Concerning the International Registration of Marks or/and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, an application for the international registration, as well as the relevant requests on the territorial extension and on the renewal of the international registration, shall be filed via the NIPO, provided that the respective national fee is paid for filing each of requests.

The request on the territorial extension after the international registration and request on the renewal of the international registration may be submitted directly to the International Bureau of WIPO, in the event that the international registration has been done exclusively in compliance with the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

3. The applicant or another person by consent of the applicant shall pay expenses with respect to the international registration of a trademark in foreign countries.

Article 25. Protection of Rights to a Well-Known Trademark

1. The protection of rights to a well-known trademark is provided according to Article 6^{bis} of the Paris Convention and this Law and is based on the recognition of the trademark to be well known by the Appeals Chamber or the court. The trademark may be recognized well-known regardless of its registration in Ukraine.
2. While determining whether a trademark is well known in Ukraine, the following factors may be considered, if applicable:

degree of notability and recognition of the trademark in the relevant public sector;

duration, scope and geographical area of any use of the trademark;

duration, scope and geographical area of any propagation of the trademark, including advertising, making public, and display at fairs or exhibitions of goods and/or services with respect to which the trademark is used;

duration, scope and geographical area of any registrations and/or applications for registration of a trademark, provided that the trademark is used or recognized;

evidence of the successful assertion of rights to the trademark, in particular the territory where the trademark is recognized to be well known by authorized organizations;

the value associated with the trademark.

3. The procedure for recognizing a trademark to be well known in Ukraine by the Appeals Chamber shall be determined by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere. Submission of the request for recognizing a mark to be well known mark is subject to payment of the respective fee.

The decision of the Appeals Chamber on the recognition of a trademark to be well known in Ukraine may be protested in court.

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

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

President of Ukraine

L. KRAVCHUK

Kyiv, December 15, 1993

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