

Ukraine

Contributing firm

Pakharenko & Partners

Authors

Antonina Pakharenko-Anderson

Senior Partner

Alexander Pakharenko

Partner

Natalia MacMaithghon

IP Paralegal, Trademarks Department

1. Legal framework

National

Provisions relating to the protection of trademark rights are contained in:

- the Civil Code of Ukraine, effective as of January 1 2004, last amended on January 17 2006;
- the Commercial Code of Ukraine, effective as of January 1 2004, last amended on December 15 2005;
- the Criminal Code of Ukraine, effective as of September 1 2001, last amended on February 9 2006;
- the Code on Administrative Infringements, effective as of December 7 1984, last amended on January 19 2006; and
- the Customs Code of Ukraine, effective as of January 1 2004, last amended on February 7 2006.

Rules on procedure for the enforcement of trademark rights are set out in the following:

- the Civil Procedure Code of Ukraine, effective as of March 18 2004, last amended September 23 2005;
- the Commercial Procedure Code of Ukraine, November 6 1991, last amended on October 13 2005;
- the Criminal Procedure Code, effective as of December 28 1960, last amended on February 7 2006; and
- the Code on Administrative Jurisdiction, effective as of September 1 2005.

The major law governing trademark issues is the Law of Ukraine on the Protection of Rights to Trademarks and Service Marks, in force since July 1 1994, with amendments dating from June 16 1999, February 6 2001 and June 25 2003.

Areas of overlap with related rights are also subject to:

- the Law of Ukraine On the Protection Against Unfair Competition, effective as of June 7 1996, last amended on June 11 2003;
- the Law of Ukraine On the Protection of Rights to Industrial Designs, effective as of December 15 1993, last amended on June 25 2003; and
- the Law of Ukraine On Copyright and Related Rights, effective as of December 23 1993, last amended January 6 2004.

International

International treaties and conventions in force in Ukraine include the following:

- the Paris Convention for the Protection of Industrial Property;
- the Madrid Agreement on the International Registration of Marks;
- the Madrid Protocol on the International Registration of Marks 1989;
- the Nice Agreement on the International Classification of Goods and Services for the Purposes of the Registration of Marks; and
- the Trademark Law Treaty.

In a declaration of September 21 1992 Ukraine declared that the Paris Convention and the Madrid Agreement continue to apply in its territory, and their date of entry into force is considered to be the date of independence (December 25 1991). The provisions of the Madrid Protocol have applied since its effective date, which is December 29 2000.

2. Unregistered marks

Protection

A trademark that has obtained the status of a well-known mark in Ukraine is treated in the same way as if an application for registration had been made on the date on which the Chamber of Appeal of the Ukrainian Trademark Office (the State Department of Intellectual Property) or the

court made the decision that it was well known. The protection also extends to goods and services that are not similar to those for which the mark is recognized as well known if the use of this mark for such goods and services by another party may associate that party with the owner of the well-known mark whose interests are likely to be damaged by such use.

Consequently, the owner of a well-known mark has an exclusive right to use its mark and may prevent any third party from unauthorized use of an identical or confusingly similar mark.

The owner of the well-known mark has the right to file formal objections against later applications pending registration, as well as to file infringement and cancellation actions.

Use requirements

For the mark to be recognized as well known, it has to be sufficiently used to acquire a high degree of fame in Ukraine. The regulations governing the procedure for the recognition of marks as famous by the Chamber of Appeal do not specifically set a margin at which the mark may be considered to be well known; therefore, an expert opinion may be necessary to evidence sufficient use in a certain field and among a specific group of consumers. For example, the fame of a mark among the target consumers may be confirmed based on the results of a poll conducted by an accredited research institution that specializes in sociological and market research. Such a poll must cover at least six major cities in various geographical regions in Ukraine, whose population is no less than 500,000 people. Preference is given to polls conducted in major cities, such as Kiev, Kharkiv, Lviv, Odessa, Dnipropetrovsk, Lugansk, Donetsk and Sevastopol.

The following factors are of particular importance when assessing the fame of a mark:

- the volumes of sales or offering of services;
- the list of regions of Ukraine in which such goods/services are offered for sale;

- the average number of consumers as of the date mentioned in the application for well-known status;
- the target consumers;
- the position of the manufacturer on the market in the specific economic field;
- the volume of exports/imports of the goods for which the mark is used; and
- the value of the mark according to the owner's financial reports.

3. Registered marks

Ownership

Any person or association of persons, or its successor in title, is entitled to obtain a certificate of registration. The definition of 'person' under the Trademark Law is broad and implies any natural person or legal entity.

Intent to use and actual use are not treated as prerequisites for applying for trademark registration. The application itself is taken as an intent to use. At the same time, the Trademark Law provides for cancellation based on non-use.

The current law does not require that the applicant be involved in commercial activity for it to be entitled to apply for registration.

Non-residents enjoy the same rights as nationals and must appoint a representative (a registered patent attorney in Ukraine).

Scope of protection

Protection is granted to marks that are not contrary to public order or human and moral principles, and which are not subject to refusal based on absolute grounds.

According to the Trademark Law, a mark may be comprised of any sign or combination of signs. In particular, these may be word signs, including

proper names, letters, numerals, figurative elements, colours or combinations of colours, as well as any combination of such signs. Three-dimensional marks, sounds, light signals and colours *per se* may also obtain protection.

The following four groups of signs may not obtain protection in Ukraine:

- signs representing or imitating:
 - armorial bearings, flags and other official insignia (emblems);
 - official names of states;
 - emblems and full or abbreviated names of international intergovernmental organizations;
 - official control, warranty and standard marks, and stamps; or
 - decorations and other honorary signs. Such signs may be included in a mark as elements subject to disclaimer, provided that consent has been given by or on behalf of a competent authority or the trademark owner;
- signs that:
 - are usually devoid of distinctive character and have not acquired distinctiveness through use;
 - consist only of signs which are common names for goods and services of a given type;
 - designate the kind, quality, quantity, properties, intended purpose or value of goods and services, or the place and time of production or sale of goods or of rendering of services;
 - are misleading or likely to deceive the public as to the nature of the goods or services, or the person manufacturing the goods or rendering the services;
 - consist only of signs which are symbols or terms of general use; or
 - represent a shape which is due to the natural state of the goods or due to the need to achieve a technical result, or which increases the value of the goods;
- signs that are identical or misleadingly similar to:
 - marks which have been registered or are the subject of an application for registration for similar or related goods and services on behalf of another person in Ukraine;
 - marks of third parties, where such marks are protected without registration under international treaties to which Ukraine is a party, in particular marks recognized as well known under the provisions of Article 6bis of the Paris Convention for the Protection of Industrial Property;
 - trade names known in Ukraine and owned by third persons who had acquired their rights in such trade names before the date on which an application for registration of a trademark for similar goods and services was filed with the Ukrainian Trademark Office;
 - appellations of origin (including spirits and alcoholic beverages) protected under the Law of Ukraine On the Protection of Rights to Appellations of Origin; and
 - certification marks; and
- signs that reproduce:
 - industrial designs of third parties;
 - names of scientific, literary and artistic works famous in Ukraine, or quotations and characters from such works, works of art or parts thereof without the consent of the copyright owners or their successors in title; or
 - surnames, forenames, pseudonyms and names derived therefrom, or portraits or facsimiles of persons known in Ukraine, without the consent of those persons.

4. Procedures

Examination

Trademark applications are subject to examination by the Examining Authority of the Ukrainian

Trademark Office on both a formal and substantive basis. Formal examination is to ensure conformity with formal requirements, while during substantive examination, the authority checks that the mark conforms to the requirements of registrability and, in particular, distinctiveness.

Decisions of the Examining Authority may be appealed to the Chamber of Appeals or a court within two months of the date of receipt of the decision. Decisions of the Chamber of Appeals may be appealed to the courts within two months of the date of receipt of such a decision.

Opposition

Any person may file an opposition against a pending trademark. The opposition will be taken into consideration provided that it was submitted no later than five days before the date of issuance of a decision by the Trademark Office.

The Trademark Office shall forward a copy of the opposition to the applicant. The applicant may submit its arguments against such objection to the Examining Authority within two months of the date of receipt. It may seek to disprove the opposition and not make any changes, amend the application or withdraw it.

The authority takes the opposition into consideration upon issuance of a final decision on the mark. A copy of the decision is forwarded both to the applicant and to the person who filed the opposition.

Both parties may appeal such a decision to the Chamber of Appeal and, ultimately, the courts.

Registration

Once examination is completed and the mark is found to be registrable, the Examining Authority will issue its decision. The owner of the mark has three months from the date of issue to pay the official registration and publication fees.

The Trademark Office publishes the particulars of the registration within one month of the payment of the requisite fees. Upon publication, the Trademark Office officially registers the mark by entering the relevant particulars in the Trademarks Register.

The certificate of registration is valid for 10 years from the filing date. Renewals are for subsequent terms of 10 years.

Removal from register

Under the current law, there is no administrative procedure before the Trademark Office which allows for the removal of a mark from the Trademarks Register through invalidation. A trademark registration may be cancelled only by the courts. A bill on the protection of trademarks, trade names and geographical indications, which is under discussion in Parliament, includes provisions on administrative procedures for the removal of marks from the register.

The administrative procedure for removal before the Trademark Office is available for only:

- Surrender – a trademark owner may at any time surrender its certificate in full or in part by filing a relevant statement of surrender with the Trademark Office. The surrender becomes effective as of the date of publication of a relevant notice in the *Official Bulletin*; and
- Revocation due to non-payment of renewal fees – a registration is revoked in the event of failure to pay the applicable renewal fees. The Trademark Law provides for payment of such fees during the last two months immediately preceding the date of expiry of the certificate. Late payment of the renewal fees is possible with an additional 50% penalty.

Revocation: At the request of a third party, a court may cancel a registration for all or part of the goods and/or services covered if the

trademark was not used in Ukraine within three years of the date of publication of the grant of the certificate.

The mark will not be cancelled if the owner can provide justification for non-use.

Invalidation: A court may cancel a registration due to the fact that, after the filing date, a mark has become a generic name for the goods and/or services set out in the registration.

Cancellation: At the request of a third party, the court may cancel a registration based on the following grounds:

- Absolute grounds for refusal existed at the time of trademark application;
- The application was filed in bad faith; or
- The registration contains elements relating to the representation of the mark or to the list of goods and services which were not present in the application as filed.

The Code on Administrative Jurisdiction, which provides for a period of limitation of one year, affects trademark owners in that, except for non-use revocation actions, all other cancellation actions must now be filed within one year from the registration date.

5. Enforcement

Complexity

Preparation for infringement actions: When preparing for an infringement action in Ukraine, a mark owner must bear in mind, among other things, that it is required to provide proof of the infringer's intent. If the infringer is the manufacturer of counterfeit goods, intent is implied. However, in other cases, such as alleged infringement by a retailer, the court will always demand that the plaintiff provide evidence proving the infringer's intent. Thus, in most

cases mark owners should send warning letters or notices to the infringer.

Criminal proceedings can be initiated only when a certain threshold of "considerable damage" is met. As of February 27 2006 this threshold has been reduced to UAH3,500 (about €550). This lowering of the threshold enables brand owners to request the application of criminal sanctions against individuals as well as large-scale counterfeiting operations.

In addition, mark owners should involve enforcement agencies in the collection of evidence. As of February 2005 police can access the premises of an infringer, but can no longer collect evidence without a special court order. An order can be issued within 24 hours of a request. Further, Ukrainian law requires the submission of evidence provided by an official, independent certified expert. This expert evidence is necessary for all types of legal proceedings, whether administrative, civil or criminal.

Jurisdiction: The implementation of the Code on Administrative Jurisdiction on September 1 2005 has brought some changes to the determination of jurisdiction in each case. Until this date, jurisdiction was decided based on the parties to the proceedings. If both parties were legal entities, the case would fall under the jurisdiction of the commercial courts. If at least one party was an individual, the case would fall under the general jurisdiction.

Pursuant to the code, invalidation actions in which the Trademark Office acts as a defendant fall under the jurisdiction of the administrative courts. The first stage of the formation of the administrative court system has been completed with the creation of the Supreme Administrative Court, which acts as a cassation court.

Until local administrative courts and appellate administrative courts are up and running,

the commercial courts and courts of general jurisdiction remain competent to handle administrative cases following the procedure established by the Code on Administrative Jurisdiction.

Administrative action: Administrative procedures, in particular against acts of unfair competition, may be initiated before the Anti-monopoly Committee of Ukraine. The administrative procedure is initiated by filing a request to the committee or to its regional offices within six months of the date on which the right owner became aware of an infringement.

An alternative way of applying administrative sanctions is through court procedures. The Code on Administrative Offences provides for fines to be imposed on infringers and for the confiscation of goods that infringe IP rights.

Civil action: In civil procedures, the right holder is entitled to claim for payment of an indemnity, including lost profits and moral damages (available through courts of general jurisdiction and commercial courts).

As in many other countries, the plaintiff may file a civil claim in the course of criminal proceedings (before the court investigation has been initiated).

If a criminal case is initiated without the right holder, the latter will be involved in the proceedings as a civil plaintiff who has to file a request for compensation for damages.

After legal proceedings have been initiated, IP owners may apply to secure the claim, in particular in cases where failure to do so may prevent the execution of court orders.

A claim may be secured by:

- seizing property and finances in possession of the infringer;

- limiting activities of the infringer (including limiting its ability to dispose of its finances); and
- prohibiting other persons from performing activities pertaining to the claim.

Preliminary injunctions: Both the commercial and civil procedures provide for the application of provisional measures before the initiation of the proceedings on the merits. These include:

- ordering evidence;
- inspecting premises where an infringement has occurred; and
- seizing property.

The law obliges a plaintiff who applies for an interlocutory injunction to file a claim within 10 days of the date of the injunction order. After a suit has been brought by an applicant before a court, provisional measures are treated as security for the claim.

When filing an application for an interlocutory injunction, the applicant should bear in mind that the court may order it to provide security sufficient to prevent the abuse of provisional measures. The amount of such security is determined by the courts based on the circumstances of the case, but it may not exceed the claimed damages. In circumstances where provisional measures have been revoked, or the plaintiff lost the case, the defendant affected by the provisional measures is entitled to claim for damages suffered due to the adoption of the provisional measures.

Criminal action: If illegal use of a trademark resulted in considerable damage, the infringer may be subject to fines, imprisonment with hard labour for a term of up to two years or imprisonment for the same term with confiscation of the infringing goods, and the equipment and materials used in their manufacture. For crimes committed by officials involving abuse of official status or committed by an organized group of

conspirators, the law provides for a term of imprisonment of three to six years.

Damage is treated as considerable if it amounts to 20 times the 'untaxable minimum citizen's income', (ie, UAH3,500).

Under the current trademark law the illegal use of a trademark relates to the following types of use:

- application of the mark on any goods for which it has been registered, their packaging, signboards related to these goods, labels, tabs, tags or any other items affixed to the goods, storage of goods bearing the mark for the purpose of offering them for sale, offer of these goods for sale, and sale, import and export of these goods;
- use of the mark in relation to rendering or offering any service in respect of which it has been registered; and
- use of the mark in business papers or advertising, as well as on the Internet, including use in domain names.

The trademark is deemed to have been used if it is used in the form of the sign as registered, as well as in a form that differs from the registered sign only in certain elements, provided that this does not detract from the overall distinctive character of the sign.

Border measures: In Ukraine, as in the European Union, rights holders may take measures to prevent infringing goods from entering the market by applying to have their goods registered with Customs. Such registration is valid for six months or one year, with a possibility for further renewal. However, unlike in other jurisdictions, Ukrainian Customs registers goods subject to IP rights rather than the IP rights themselves. In other words, rights holders may apply for registration of the goods bearing their respective trademarks, which they export to Ukraine. Customs will then be authorized to seize suspect goods and notify the rights holder about the seizure.

The current customs regulations do not allow Customs to act *ex officio*.

Changes to the Customs Code under discussion, aim to harmonize the customs registration system with the EU practice. *Ex officio* provisions are also expected to be included.

Timeframe

Administrative proceedings generally take a minimum of three months. If a warning letter is sent, an extra two weeks to a month from the date on which this letter was sent until the time when an action can be started should be added.

As far as court proceedings are concerned, there are no strict terms prescribed by the law. Therefore, the duration of such proceedings depends on each particular case.

6. Ownership changes – legalization requirements

No legalizations are required to record changes of ownership and transfers of rights (assignments and licences) with the Ukrainian Trademark Office. Where a power of attorney is used, this needs to be signed only by an authorized representative of the trademark owner; it need not be notarized.

7. Areas of overlap with related rights

A trademark may also be subject to copyright or design rights, in which case the provisions of the respective copyright and design rights laws are applicable.

If a trademark – for example a logo, label or a three-dimensional mark – is the result of an artistic design, it may be subject to either design

or copyright protection depending on the nature of the design. Brand owners often seek to protect such signs both as trademarks and as designs.

Cases in which trademark rights overlap with copyright include:

- an original label that is subject to copyright protection and which is registered as a trademark at the same time; and
- a trademark corresponding to the title of an artistic work.

8. Online issues

Under the Trademark Law, the use of commercial signs on the Internet, including in domain names, constitutes use of a mark. If such use infringes earlier rights, it may be prevented through available remedies provided for trademarks. In the same way, it is possible to prevent unauthorized or infringing domain registrations. Infringing use in metatags is also thought to be covered by the law. However, no relevant case law exists as yet.

The rules governing the Ukrainian '.ua' country-code top-level domain (ccTLD) (available at www.hostmaster.net.ua/policy) were adopted in 2001.

To ensure that IP rights are protected, supplemental rules have been put into place, which provide that second-level domain names in the '.ua' ccTLD can be registered only by applicants that own the corresponding trademark.

