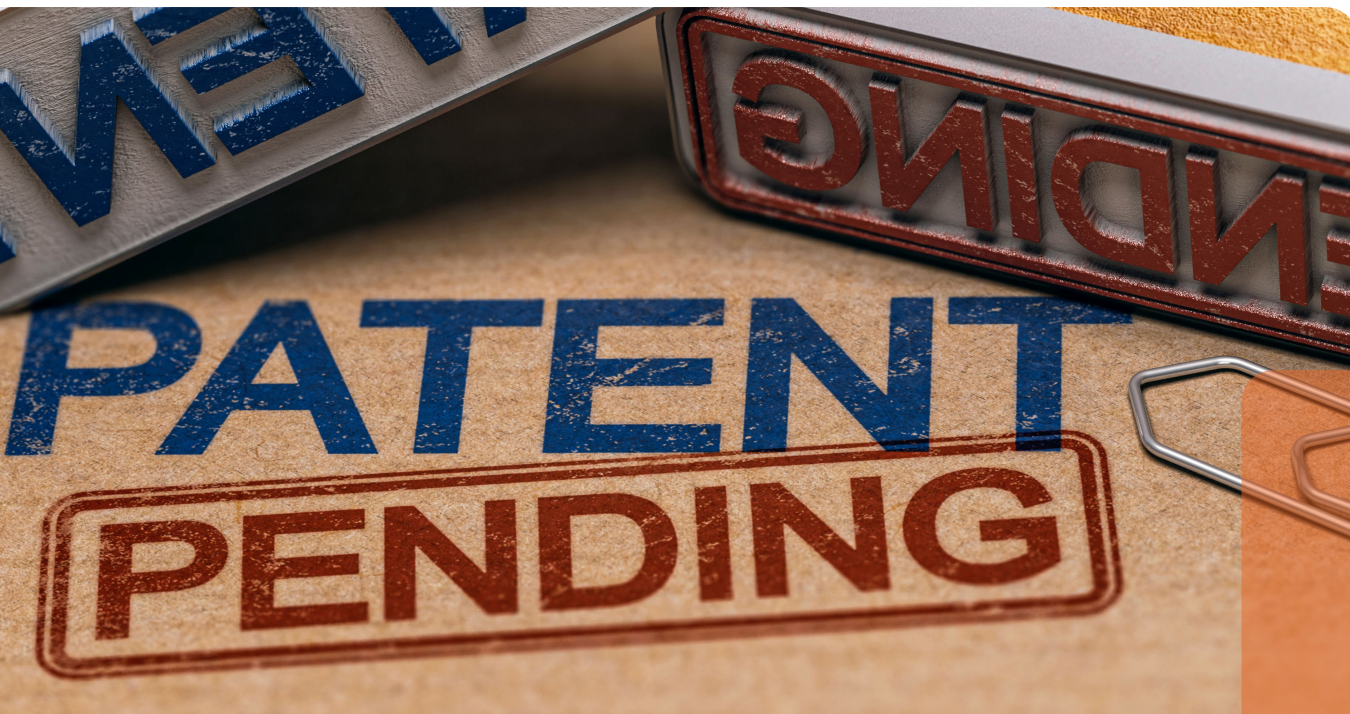


**International
Comparative
Legal Guides**



Patents

2024

14th Edition

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Expert Analysis Chapters

- 1** **Recent Developments in SEP Litigation and FRAND Determination**
Katharine Stephens & Juliet Hibbert, Bird & Bird LLP
- 8** **Unified Patent Court**
Trevor Cook, Bird & Bird LLP
- 17** **Product Prior Art and IPR Estoppel**
Kenneth R. Adamo & Eugene Goryunov, Law Office of KRAdamo & Haynes and Boone
- 20** **Watching Out For Lurking Hazards When Drafting Patent Applications; Using Generative Artificial Intelligence as a Tool**
Dunstan H. Barnes, Wil Rao & Andrew W. Mills, McAndrews, Held & Malloy

Q&A Chapters

- 26** **Australia**
Bird & Bird LLP: Jane Owen & Rebecca Currey
- 35** **Austria**
GRAF ISOLA Rechtsanwälte GmbH: Claudia Csáky
REDL Life Science Patent Attorneys: Gerda Redl
- 43** **Belgium**
Stibbe: Philippe Campolini, Louis Bidaine & Clémence Jonckheere
- 50** **Canada**
CPST Intellectual Property Inc.: Anthony Prenol, Antonio (Tony) Turco, Brett Slaney & Junyi Chen
- 59** **Chile**
COOPER & CIA: Rodrigo Cooper
- 65** **Germany**
Gleiss Lutz: Dr. Matthias Sonntag & Dr. Herwig Lux
- 73** **Ghana**
Minkah-Premo and Co: Renee Panarkuor Kusah
Owusu Ansah, Eunas Kofi Eshun, Eric Vidzah & Edefuah Larbi
- 81** **India**
LexOrbis: Manisha Singh & Rajeev Kumar
- 91** **Ireland**
A&L Goodbody LLP: John Whelan, Sinéad Mitchell King & Sarah Douglas
- 100** **Israel**
Gilat, Bareket & Co., Reinhold Cohn Group:
Adv. Eran Bareket & Adv. Jakob (Koby) Kasulin
- 110** **Japan**
Nagashima Ohno & Tsunematsu: Kenji Tosaki
- 118** **Korea**
Lee International IP & Law: Yoon Suk Shin,
Dong-Hwan Kim, Gon-Uk Huh & Kyu-Bok Lim
- 129** **Kosovo**
IPLegals: Kujtesa Nezaj-Shehu
- 136** **Mexico**
OLIVARES: Sergio L. Olivares, Daniel Sánchez & Rommy Morales
- 146** **Norway**
ACAPO AS: Stein Roar Gjoen & Helen Christie
- 152** **Philippines**
SyCip Salazar Hernandez & Gatmaitan:
Vida M. Panganiban-Alindogan
- 160** **Poland**
JWP Patent & Trademarks Attorneys:
Dorota Rzążewska, Małgorzata Furmańska,
Tomasz Grucelski & Tomasz Gawliczek
- 168** **Spain**
Elzaburu: Colm Ahern
- 175** **Taiwan**
TIPLo Attorneys-at-Law: J. K. Lin & H. G. Chen
- 185** **Turkey/Türkiye**
BRANDIT: Yasemin Aktaş
- 194** **Ukraine**
ADVANCE PARTNERS: Oleg Zhukhevych & Elena Biloshuk
- 203** **United Arab Emirates**
Primecase Hamad Alrahma Advocates & Legal Consultants: Mohammad AlShraideh,
Dr. Mohammed Zaidan & Salem Rawabdeh
- 211** **United Kingdom**
Bird & Bird LLP: Katharine Stephens & Patrick Brown
- 223** **USA**
Mintz: Michael T. Renaud & Matthew A. Karambelas
- 231** **Zambia**
Dentons Eric Silwamba, Jalasi and Linyama Legal Practitioners: Joseph A. Jalasi, Jonathan Chileshe & Ntasi Silwamba

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Elena Biloshuk

ADVANCE PARTNERS

1 Patent Enforcement

1.1 Before what tribunals can a patent be enforced against an infringer? Is there a choice between tribunals and what would influence a claimant's choice?

A patent owner can enforce a patent in general jurisdiction courts and/or commercial courts. The general jurisdiction courts consider disputes with involvement of private individual(s) as party to litigation. The commercial courts consider disputes between legal entities and/or registered private entrepreneurs.

Patent infringement cases enforced before the police authorities are considered by the administrative courts pertaining to minor offences.

The new specialised intellectual property ("IP") court is now at the stage of formation. Once it resumes its work, it will consider patent infringement cases.

1.2 Can the parties be required to undertake mediation before commencing court proceedings? Is mediation or arbitration a commonly used alternative to court proceedings?

Mediation is not mandatory before commencing court proceedings. Mediation and arbitration are not commonly used alternatives to court proceedings.

1.3 Who is permitted to represent parties to a patent dispute in court?

Certified Attorneys at Law, natural persons – rights holders and the persons authorised to act on behalf of the legal entities according to the statutory and other corporate documents.

1.4 What has to be done to commence proceedings, what court fees have to be paid and how long does it generally take for proceedings to reach trial from commencement?

Pre-trial settlements, such as the issue of cease-and-desist letters, are not mandatory according to the laws of Ukraine.

To initiate the court proceeding, the plaintiff has to pay the state fees and file the claim with due regard to all the requirements to its content and the service process, as prescribed by the laws of Ukraine.

The timeframe of patent disputes is one year before the first instance court. The average timeframe of an appeal and second appeal proceeding is from four to six months.

1.5 Can a party be compelled to disclose relevant documents or materials to its adversary either before or after commencing proceedings, and if so, how?

The plaintiff must prepare a copy of the claim with all addendums. In proceedings before the commercial courts, the plaintiff is obligated to send the claim to every party to the proceeding and provide the court with evidence of such a sending. In proceedings before the general jurisdiction courts, the plaintiff provides the court with the claim and copies thereof with all addendums, for each party of the proceeding. Upon receipt thereof, the court sends over the copies to all the parties involved.

Either party may request that the court orders disclosure of evidence that is available with the adverse party or other person that cannot provide them without the court order due to legal restrictions (personal data protection and other restrictions).

1.6 What are the steps each party must take pre-trial? Is any technical evidence produced, and if so, how?

There are no mandatory pre-trial stages in patent litigation.

The plaintiff is obligated to submit all evidence (or copies thereof) with the claim.

The other parties of the proceedings must submit all evidence with the first statement on merits that they submit to the court.

Technical evidence can be presented in the form of the expert conclusion.

Evidence that cannot be submitted with the claim, must be mentioned in the claim.

The court may examine the evidence at the hearing and/or set up other procedures of examining the evidence.

1.7 How are arguments and evidence presented at the trial? Can a party change its pleaded arguments before and/or at trial?

The parties of the proceeding present their arguments and evidence in written form, once they submit their first written statements on merits (the claim, the counterclaim, the statement of defence, the third party's statement). They can further substantiate the evidence during the court hearings.

The late filing of evidence is acceptable if the party has timely informed the court of the evidence that cannot be submitted on time, and the sufficient grounds of the delay. The court may permit the late submission of evidence, this is determined on a case-by-case basis. The evidence that cannot be submitted with the claim must be mentioned in the claim.

The plaintiff can change the claim's subject matter and/or grounds thereof, at the preliminary stage of the court proceeding.

Technical and other evidence that requires specialised expertise is presented in the form of the expert opinion or conclusion.

Besides the written documents, evidence may be submitted in electronic form and in the form of witness testimonials.

Further, the court may order examination of evidence locally if they cannot be reviewed or examined at the trial. It is also possible for the court to review electronic evidence online, during the hearing.

The parties may request that the court orders disclosure of evidence that the adverse parties possess or that are available with the other parties but may not be disclosed to the interested party due to legal restrictions (data privacy and other restrictions).

In IP litigations, the courts may also request evidence in the form of information about the origin and distribution network of goods or provision of services that violate IP rights or for which there are sufficient grounds to believe that the distribution of such goods or the provision of such services violates IP rights.

1.8 How long does the trial generally last and how long is it before a judgment is made available?

The average timeframe of patent disputes is one year before the first instance court. The average timeframe of an appeal and second appeal proceeding is from four to six months.

The court renders the judgment on the last hearing. The short text of the judgment may be announced while the full text thereof can become available within 10 days after the last hearing.

The default judgment can be issued if the defendant is not present at the hearing when the court renders it. Such a judgment can be prepared by the court and its full text sent to the parties.

1.9 Is there any alternative shorter, flexible or streamlined procedure available? If so, what are the criteria for eligibility and what is the impact on procedure and overall timing to trial?

There is no alternative shorter, flexible or streamlined procedure available. Parties can reach amicable settlement at any stage of court proceedings.

1.10 Are judgments made available to the public? If not as a matter of course, can third parties request copies of the judgment?

Judgments are available to the public. They are published on the official online court register. The names and details of the private individuals are not disclosed in the published texts of the judgments due to the personal data protection requirements.

1.11 Are courts obliged to follow precedents from previous similar cases as a matter of binding or persuasive authority? Are decisions of any other jurisdictions of persuasive authority?

The courts are obliged to follow and apply the relevant legal opinions rendered by the Supreme Court and the judgments of the European Court of Human Rights.

The courts may refer to a judgment of the European Court of Justice; however, reference to such case law is not mandatory by the law.

1.12 Are there specialist judges or hearing officers, and if so, do they have a technical background?

There are no specialist judges or hearing officers with technical backgrounds. The laws of Ukraine prescribe that the judge appoints the forensic examination for considering all technical and other issues that require specialised knowledge. The parties to the proceeding have the right to order and provide the court with the forensic examination conclusion as well.

1.13 What interest must a party have to bring (i) infringement, (ii) revocation, and (iii) declaratory proceedings?

To bring (i) infringement, or (ii) revocation proceedings, the plaintiff must prove that their rights and/or legitimate interests have been infringed by the disputed patent or other claim's subject matter. As regards (iii) declaratory proceedings, the procedural laws of Ukraine limit them to certain types of cases in which a party should prove that a certain juridical fact is established by the court. Declaratory proceedings do not apply as regards patent litigation proceedings.

1.14 If declarations are available, can they (i) address non-infringement, and/or (ii) claim coverage over a technical standard or hypothetical activity?

Such declarations are not available.

1.15 Can a party be liable for infringement as a secondary (as opposed to primary) infringer? Can a party infringe by supplying part of, but not all of, the infringing product or process?

The Ukrainian law does not particularly define primary and secondary types of patent infringement. The law prescribes the list of actions pertaining to unauthorised patent use considered as patent infringement. The type and scope of liability depends on the type of infringement and the procedures the aggrieved party enforces.

1.16 Can a party be liable for infringement of a process patent by importing the product when the process is carried on outside the jurisdiction?

The importation of a product made with the use of the patented process constitutes patent infringement.

According to the laws of Ukraine, the use of the patent includes the following actions:

- The manufacturing of a product with the use of a patented invention/utility model, applying such a product, offering it for sale (including Internet sales), selling, import, and otherwise introducing it on the market, or storage of such a product with the purposes previously specified.
- The product is considered as manufactured with the use of a patented process, unless the contrary is proved, if at least one of the following conditions apply:
 - the product manufactured with the use of the patented process is new; and/or
 - there are grounds to believe that the product is manufactured with the use of the patented process and the patent owner cannot identify by reasonable efforts a process that has been used in manufacture of the product.

In case at least one of the said conditions applies, the obligation to prove non-use of the patented process concerning the manufactured product lies with the person suspected of infringement of the rights to the patent.

Thus, the importation of a product made with the use of the patented process should be considered infringement of a patent.

There is also an exclusion from infringement of the patent rights concerning importation. Importation of the goods manufactured with use of the invention (utility model), for research and/or use of the invention (utility model) in research conducted with the aim of preparing and filing information for registration of the medicinal product, shall not be considered as patent infringement.

1.17 Does the scope of protection of a patent claim extend to non-literal equivalents (a) in the context of challenges to validity, and (b) in relation to infringement?

The scope of protection of a patent claim extends to non-literal equivalents, namely:

- the use of non-literal equivalents destroys novelty during invalidation action if equivalency is known from the prior art; and
- the use of each feature of an independent claim or its equivalent shall be considered infringement.

1.18 Can a defence of patent invalidity be raised, and if so, how? Are there restrictions on such a defence e.g. where there is a pending opposition? Are the issues of validity and infringement heard in the same proceedings or are they bifurcated?

The Ukrainian National Office for Intellectual Property and Innovations (“UANIPPO”) considers oppositions against patent applications within six months from the application publication date. There are no restrictions on such a defence; however, review of the defence can be suspended until review of the pending opposition.

During the court proceedings on patent infringement, a defendant may file a statement of defence or a counterclaim requesting the invalidity of a disputed patent, subject to the formal requirements prescribed by the laws. The courts mainly consider the claim and the counterclaim in one proceeding.

1.19 Is it a defence to infringement by equivalence that the equivalent would have lacked novelty or inventive step over the prior art at the priority date of the patent (the “Formstein defence”)?

Ukrainian patent legislation does not prescribe such a defence as the *Formstein* defence. Depending on the knowledge from prior art, the defendant may initiate an invalidation action for lack of novelty or inventive step.

1.20 Other than lack of novelty and inventive step, what are the grounds for invalidity of a patent?

A patent may be invalidated in whole or in part during its validity term if:

- (a) the patented invention does not meet the patentability requirements (industrial applicability, novelty and inventive step);

- (b) the patent claims contain features that were not indicated in the filed patent application;
- (c) the patent application has been filed by a Ukrainian resident abroad without first filing an application in Ukraine; or
- (d) the patent application was filed in violation of rights of a third party(ies).

1.21 Are infringement proceedings stayed pending resolution of validity in another court or the Patent Office?

The patent infringement litigation stays pending until the court or the UANIPIO decision on patent validity is rendered.

1.22 What other grounds of defence can be raised in addition to non-infringement or invalidity?

The defendants can raise the following defences:

- the patent has been used upon the rights holder’s authorisation;
- request a compulsory licence; or
- the patent has been used within permissible exceptions such as:
 - prior use;
 - use for scientific/research purposes;
 - non-commercial use;
 - use in a vehicle (cargo, marine vehicle, aircraft) that is registered in a foreign state while the patent is used exclusively for the purposes of the vehicle’s operation;
 - the patent is used under *force majeure* circumstances, subject to notification of the patent owner as soon as it becomes possible and subject to later payment of remuneration for such a use;
 - the patent is used in the course of importation of goods for research purpose and/or the use in research aimed at preparing and filing information for the registration of the medicinal product; or
 - the patent is used in the production of pharmaceuticals aimed at exportation to third countries.

1.23 (a) Are preliminary injunctions available on (i) an *ex parte* basis, or (ii) an *inter partes* basis? In each case, what is the basis on which they are granted and is there a requirement for a bond? Is it possible to file protective letters with the court to protect against *ex parte* injunctions? (b) Are final injunctions available? (c) Is a public interest defence available to prevent the grant of injunctions where the infringed patent is for a life-saving drug or medical device?

Preliminary injunctions are generally granted on an *ex parte* basis. In certain cases, the court may consider them on an *inter partes* basis.

The courts may request bonds, to be determined on a case-by-case basis.

It is not possible to file a protective letter to overcome or act against injunctions.

Final injunctions may be granted in the form of a court judgment.

A public interest defence is not available.

1.24 Are damages or an account of profits assessed with the issues of infringement/validity or separately? On what basis are damages or an account of profits assessed? Are punitive/flagrancy damages available?

Damages or compensation, or an account of profits can be assessed with the issues of infringement/validity or separately.

The rights holder can claim damages or compensation, as well as expenses necessary to reinstate the pre-existing state affected by the infringement, including lost profit.

Damages can be assessed based on the character and scope of infringement, proved lost profit, profit gained by the infringer, and others.

The amount of compensation is determined based on the scope of the violation, the proved fault and other circumstances that are of significant importance. At the same time, the amount of compensation cannot be less than the amount of remuneration that would have been paid for the licence to use the disputed patent.

If patent infringement has occurred unintentionally and without negligence, the amount of compensation is equal to the amount of remuneration that would have been paid for granting a licence for the use of such a patent.

Punitive damages are not available.

1.25 How are orders of the court enforced (whether they be for an injunction, an award of damages or for any other relief)?

The court renders the decision on merits or a determination on application of a preliminary injunction. The court may obligate the adverse party and third party to perform or refrain from certain actions. Additionally, the winning party may request a state or private executor to control and enforce the court decision.

1.26 What other form of relief can be obtained for patent infringement? Would the tribunal consider granting cross-border relief?

The rights holder may claim damages or compensation, moral damages, as well as request specific performance such as destruction of the infringing products, equipment and materials used for their products, and others.

The courts do not grant cross-border relief.

1.27 How common is settlement of infringement proceedings prior to trial?

Settlement of infringement prior to trial is not very common in Ukraine. Nevertheless, the probability for the parties to reach settlement in the course of litigation is higher.

1.28 After what period is a claim for patent infringement time-barred?

The patent infringement claim is time barred after three years from the date when the plaintiff has become aware that their rights have been infringed.

A late submission of the claim is possible if there are sufficient grounds for inability to timely proceed with the litigation. A possibility to accept a non-timely submitted claim is determined by the court on a case-by-case basis.

1.29 Is there a right of appeal from a first instance judgment, and if so, is it a right to contest all aspects of the judgment?

There is a possibility of filing an appeal and, in certain cases, a second appeal against a court judgment. It is possible to contest all aspects of a judgment.

1.30 What effect does an appeal have on the award of: (i) an injunction; (ii) an enquiry as to damages or an account of profits; or (iii) an order that a patent be revoked?

An appeal does not suspend an injunction until the appeal court renders its judgment.

An appeal suspends the enforcement of the first instance court's judgment until the appeal court renders its judgment.

1.31 Is an appeal by way of a review or a rehearing? Can new evidence be adduced on appeal?

An appeal is considered by way of a review. New evidence is acceptable in certain cases only, if the party proves that such evidence was not available during the proceeding at the first instance court.

1.32 How long does it usually take for an appeal to be heard?

The average timeframe of an appeal and second appeal proceeding is from four to six months.

1.33 How many levels of appeal are there? Is there a right to a second level of appeal? How often in practice is there a second level of appeal in patent cases?

There are two levels of the appeal proceedings. A second appeal can be filed in a limited number of cases, if a breach, or incorrect application, of law is confirmed by the appellant. Similarly, the court determinations can be appealed on the second level in a limited number of cases.

1.34 What are the typical costs of proceedings to a first instance judgment on: (i) infringement; and (ii) validity? How much of such costs are recoverable from the losing party? What are the typical costs of an appeal and are they recoverable?

The costs of proceedings to a first instance court include:

- the court's fees for filing the claim, the counterclaim, the preliminary injunction (depending on the claim's subject matter and amount of claims, as well as the competent court);
- the fees that pertain to the collection of evidence; and
- the attorney's fees.

The costs can be recoverable from the losing party, in full or in part.

In case of partial upholding of the claims, the costs are recovered proportionally to the upheld claims.

1.35 For jurisdictions within the European Union: What is the status in your jurisdiction on ratifying the Unified Patent Court Agreement and preparing for the unitary patent package? For jurisdictions outside of the European Union: Are there any mutual recognition of judgments arrangements relating to patents, whether formal or informal, that apply in your jurisdiction?

There are no specific mutual recognition of judgments arrangements pertaining to patents. The procedures of recognition of the foreign courts' judgments are regulated by the relevant international agreements.

2 Patent Amendment

2.1 Can a patent be amended *ex parte* after grant, and if so, how?

A patent owner may file a request with the Patent Office to correct any mistakes in the specification and claims. A patent owner may also file a request to limit the scope of protection.

The Patent Office shall conduct an examination of a new wording of the claims as to their compliance with the patentability conditions. An official fee shall be paid for the examination.

2.2 Can a patent be amended in *inter partes* revocation/invalidity proceedings?

The court does not amend patent claims during revocation/invalidity proceedings. If a patentee wishes to reduce the scope of a patent, such a patentee must file a corresponding request with the Patent Office.

2.3 Are there any constraints upon the amendments that may be made?

Amendments should not extend the subject matter of the invention beyond the scope of the originally filed application. The following amendments may be made:

- deleting independent claims and corresponding dependent claims; and
- amending features of independent claims, provided that these changes narrow the scope of protection; or introducing features from corresponding dependent claims to the independent claim.

3 Licensing

3.1 Are there any laws which limit the terms upon which parties may agree a patent licence?

Parties are free to choose the terms of a patent licence; however, there are a number of terms that must be specified in the patent licence agreement. Such terms include the rights granted under the agreement, the territory (if the territory is not specified, it is assumed to be the whole territory of Ukraine), the type of licence (if the type of licence is not specified, it is deemed to be a non-exclusive licence) and the term of the licence (if the term is not specified, it is deemed to be for the term of the patent, but not more than five years).

A licence agreement may not be concluded in respect of patent rights that are not valid at the time of the agreement.

A patent licence is not subject to mandatory registration in Ukraine. The parties to the agreement have the right to register the licence with the Patent Office.

A licence agreement shall be executed in writing and shall contain:

- the type of licence (exclusive/non-exclusive);
- the specific rights licensed under the agreement;
- the methods of use of the respective IP object;
- the territory for which the rights are licensed;
- the term for which the rights are licensed; and
- other provisions at the discretion of the parties.

3.2 Can a patent be the subject of a compulsory licence, and if so, how are the terms settled and how common is this type of licence?

The Law provides for the following cases when compulsory licensing is possible:

- If an invention is not used or is used insufficiently in Ukraine for three consecutive years, any person willing and ready to use the invention may apply to the court for permission to use the invention. If the patent owner fails to prove that the failure to use the patented invention is due to reasonable grounds, the court shall issue a decision to grant the interested person a compulsory licence. The court determines the scope of the licence, the period of validity, payment terms and other conditions.
- The patent owner is obliged to grant a licence to use the invention to the holder of a later granted patent if the latter's invention is intended to achieve a different purpose or has significant technical and economic advantages and cannot be used without infringing the earlier rights.
- To ensure health protection, state defence, environmental safety and other public interests, the Government of Ukraine may authorise the use of an invention by a person designated by this authority without the consent of the patent owner in case of unreasonable refusal of the patent owner to grant a licence to use the invention.

4 Patent Term Extension

4.1 Can the term of a patent be extended, and if so, (i) on what grounds, and (ii) for how long?

A Supplementary Protection Certificate ("SPC") may extend a patent right for a maximum of five years. An owner of a patent for: (i) an active pharmaceutical ingredient of a medicinal product, the process for obtaining a medicinal product or application thereof; or (ii) an animal protection product or plant protection product, which requires marketing authorisation in Ukraine, has the right to extend the term of the patent.

An SPC is issued at the request of a patentee, subject to a fee.

The requirements for filing a request for supplementary protection are as follows:

- the patent owner may obtain supplementary protection if an application for marketing authorisation in Ukraine was filed within one year from the date of filing such application for the first time in any country;
- the term of supplementary protection is equal to the period between the date of filing the application with the Patent Office and the date of obtaining the first marketing authorisation in Ukraine, reduced by five years; and
- the Patent Office must receive a request for supplementary protection within six months either from the date of publication of the patent grant or from the date of the first marketing authorisation in Ukraine (whichever is later).

5 Patent Prosecution and Opposition

5.1 Are all types of subject matter patentable, and if not, what types are excluded?

The subject matter of a patent is as follows: a product (e.g., a device, substance, microorganism strain, cell culture of plants and animals, etc.); or a process (method). The subject matter of a utility model is a device or process (method).

The following shall not be considered patentable inventions (utility models):

- plant varieties and animal breeds;
- processes of the reproduction of plants and animals that are biological in their basis, and do not belong to non-biological and microbiological processes as well as products of such process;
- topographies of integrated circuits;
- results of design constructing;
- methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body. This provision shall not apply to products, in particular substances or compositions for use in any of these methods;
- processes for cloning human beings;
- processes for modifying the germ-line genetic identity of human beings;
- use of human embryos for industrial or commercial purposes;
- processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes;
- a human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene. An element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element;
- a product or process related to a plant or animal, the use of which is limited to a certain plant variety or animal breed;
- a product or process which relates to natural biological material which is not isolated from its natural environment or which is not the product of a technical process;
- discoveries, scientific theories and mathematical methods;
- schemes, rules and methods for games, contests, auctions, exercises, methods of intellectual, economical and commercial (planning, financing, supply, accounting, credit, forecasting, valuation, etc.) activity;
- computer programs;
- methods of presentation of information (e.g., in form of tables, charts, diagrams, acoustic signals, pronunciation of words, visual demonstrations, audio and video discs, symbols, including road signs, routes, codes, fonts, etc., schedules, instructions, projects and plans of constructions, buildings, areas); and
- the appearance of products (including products, buildings, areas), directed for meeting purely aesthetic needs.

5.2 Is there a duty to the Patent Office to disclose prejudicial prior disclosures or documents? If so, what are the consequences of failure to comply with the duty?

The Patent Office does not require applicants to disclose prejudicial prior disclosures or documents.

5.3 May the grant of a patent by the Patent Office be opposed by a third party, and if so, when can this be done?

A pre-grant opposition may be filed within six months from the date of publication of the patent application.

A post-grant opposition may be filed within nine months from the date of publication of the patent with the Board of Appeals of the Patent Office.

5.4 Is there a right of appeal from a decision of the Patent Office, and if so, to whom?

The applicant may file an appeal against the decision of the Patent Office to the Board of Appeals within two months from the date of issuance. The decision of the Appeals Chamber may be further appealed in court.

5.5 How are disputes over entitlement to priority and ownership of the invention resolved?

Disputes over priority and ownership of an invention are resolved in court. Under the Patent law, if several inventors have independently created the same invention, the right to apply for a patent belongs to the applicant whose application has the earliest filing date or, if priority is claimed, the earliest priority date, unless this application is pending, withdrawn or a decision is issued to refuse to grant a patent.

5.6 Is there a "grace period" in your jurisdiction, and if so, how long is it?

The grace period for novelty is six months before the date of filing an application with the Patent Office (or before the priority date, if claimed).

5.7 What is the term of a patent?

The term of a patent is 20 years from the application filing date.

5.8 Is double patenting allowed?

Although the Law does not explicitly prohibit double patenting, it is not allowed for the same invention, as patent examiners consider the novelty of the subject matter claimed in the applications being searched, including applications filed by the same inventor and/or applicant.

5.9 For jurisdictions within the European Union: Once the Unified Patent Court Agreement enters into force, will a Unitary Patent, on grant, take effect in your jurisdiction?

Not applicable to our jurisdiction.

6 Border Control Measures

6.1 Is there any mechanism for seizing or preventing the importation of infringing products, and if so, how quickly are such measures resolved?

The border control measures apply with regard to inventions and may not apply in the case of unauthorised use of utility models.

To control the importation/exportation of goods with the use of a patent, the rights holder can register the patent with the Customs Registry of Intellectual Property Objects (“Customs Registry”).

Upon entry of a patent in the Customs Registry, customs control the import and export of the goods with its use.

Customs may suspend the shipment of goods suspected in patent infringement for 10 working days, with possible extension of this term for an additional 10 working days.

Once the shipment is suspended, customs notify the rights holder who has a right to inspect the shipment or review information thereof and apply the following procedures concerning the infringing goods:

- request destruction of the shipment at the border (subject to consent of the shipment owner); or
- take samples of the goods and report to customs if the patent rights have been breached. In such a case, customs may initiate the administrative proceeding on the ground of violation of the customs rules. As a result, the penalty may apply, while the infringing goods may be confiscated.

7 Antitrust Law and Inequitable Conduct

7.1 Can antitrust law be deployed to prevent relief for patent infringement being granted?

Although patent enforcement may result in a market monopolisation or other actions that may be considered as breach of the antitrust legislation, nevertheless, the antitrust law may not be deployed to prevent relief for patent infringement being granted.

7.2 What limitations are put on patent licensing due to antitrust law?

The antitrust laws of Ukraine do not expressly limit patent licensing. At the same time, the issue of exclusive license may result in anticompetitive behaviour, market monopolisation or other acts that may be considered as infringing under the antitrust laws. Nevertheless, this may not affect the validity and enforceability of licences.

7.3 In cases involving standard essential patents, are technical trials on patent validity and infringement heard separately from proceedings relating to the assessment of fair reasonable and non-discriminatory (FRAND) licences? Do courts set FRAND terms (or would they do so in principle)? Do courts grant FRAND injunctions, i.e. final injunctions against patent infringement unless and until defendants enter into a FRAND licence?

Ukrainian law does not provide for the concept of a FRAND licence.

There are no FRAND injunctions as such in procedural law.

At the same time, the laws prescribe that a patent owner is obligated to grant a licence to the owner of another patent,

based on the use of the primary invention (utility model), if the new invention is intended for another purpose or has significant technical and economical advantages, and if the new invention may not be used without infringement of the earlier patent. Such a licence shall be granted in the scope that is required for the use of a new invention.

8 Current Developments

8.1 What have been the significant developments in relation to patents in the last year?

The most important developments resulted from the adoption of the Law “On Amendments to Certain Legislative Acts of Ukraine on Strengthening the Protection of Intellectual Property Rights” (Law 2974-IX), which entered into force on 15 April 2023.

This Law implements the provisions of the Association Agreement between Ukraine and the European Union, the European Atomic Energy Community and their Member States (the “Association Agreement”), which introduced a number of procedures and remedies for the enforcement of IP rights under the Association Agreement and Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 “On the Protection of Intellectual Property Rights” (the “Enforcement Directive”).

Among the key amendments introduced by Law 2974-IX, the most significant are the following:

A plaintiff or a third party in an IP infringement case may now apply to the court to oblige: a person infringing the IP rights based on sufficient grounds; a person who offered, received, possessed and/or used goods or provided services infringing IP rights for commercial purposes; or third parties who may be involved in the infringement (producers, manufacturers, distributors, etc.), to disclose information about the origin and distribution network of the infringing goods or services, as well as which of these goods or services are the object of the infringement, or in respect of which there are reasonable grounds to believe that the distribution of such goods or services infringes IP rights.

Such information should include (i) the name and address of the persons believed (on reasonable grounds) to be the manufacturers, distributors or other prior owners of such goods or providers of such services, including persons engaged in wholesale or retail trade in such goods or providing such services, and (ii) the quantity and value of the goods or services manufactured, delivered, supplied, received or ordered.

Law 2974-IX also provides for the implementation of the provisions of Articles 239 “Alternative Measures” and 240 “Compensation for Damages” of the Association Agreement into Ukrainian law.

The court may, at the request of the infringer, order a one-time monetary payment, provided that the IP rights were infringed unintentionally and without negligence and that the application of the above remedies is disproportionate to the damages caused to the claimant.

The amount of such payment shall be determined by the court as the amount of remuneration that would have been paid for obtaining permission to use the disputed IP rights and which reasonably satisfies the claimant.

In addition, at the request and at the discretion of the owner of a patent (utility model), or design, or trademark, the infringer, in addition to compensation for damages, is obliged to either compensate for property damage or pay compensation.

The amount of damages is determined by the court taking into account the lost profits or income received by the infringer as a result of the infringement of IP rights.

The amount of compensation shall be determined by the court taking into account the scope of the infringement, the fault of the infringer and other circumstances of material importance, and may not be less than the amount of remuneration that would have been paid for obtaining a permit to use the disputed IP rights.

If the infringement of IP rights occurred unintentionally and without negligence, the amount of compensation shall be equal to the amount of remuneration that would have been paid for granting such permission.

8.2 Are there any significant developments expected in the next year?

It is expected that the amendments to the patent legislation that have come into force in recent years will be supplemented by the adoption of bylaws that would regulate proceedings before the Board of Appeals of the Patent Office, for obtaining SPCs and changes related to patent prosecution and official fees.

Additionally, the Law of Ukraine “On the protection of the interests of individuals in the field of intellectual property during the martial law introduced in connection with the armed aggression of the Russian Federation against Ukraine” of 1 April 2022, is aimed at ensuring that the patent holders can restore or preserve their rights for the filed patent applications. Namely, from the date of the martial law enactment in connection with the protection of IP rights before the Patent Office, and for the procedures for acquiring these rights, are suspended until the abolishment of the martial law. This pertains to: time limits for submitting an objection against the patent application or action of an international registration in Ukraine, appealing a Patent Office decision on an application in court or to the Appeals Chamber; and submitting an application for recognition of invention rights as invalid, time limits during which it is possible to renew missed deadlines and others. From the day following the day of a martial law cancellation, the course of the noted terms continues, taking into account the time that has passed before their suspension.

8.3 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

The recent Supreme Court judgment rendered in case no. 910/9215/21 confirms that the claims filed in a patent infringement proceeding must refer to real facts of infringement and not be based on assumptions or a possibility of potential infringement that may occur in the future. Such general and assumptive claims may not be satisfied.

In a present case, the plaintiff requested stoppage of unauthorised patent use by means of refusal in marketing authorisation and further production of a particular medicinal product. Additionally, the plaintiff demanded a prohibition for the defendant to use the patent in any other medicinal product that the defendant may produce. In the course of the litigation, the courts have established that as of now, there is only one medicinal product that the defendant has tried to register and further produce, with the use of the plaintiff’s patent.

At the same time, the first instance and the appeal courts have satisfied the claim in part of prohibiting the defendant from using the disputed patent in any other medicinal product with no indication of which product it actually is.

The Supreme Court has, however, found that such a claim may not lead to actual enforcement of the patent rights, to stop infringement or restore the infringed rights. Such a claim is based on assumptions about possible potential future infringement that does not take place at present.

The Supreme Court has, therefore, confirmed a number of earlier issued similar judgments and found that the courts may satisfy only such claims that pertain the particular established facts of infringement.

As far as the lower instances’ courts shall apply the Supreme Court’s legal opinions delivered in the same type of cases, the present judgment shall influence the development of the related case law in the near future.



Oleg Zhukhevych is an experienced Attorney with in-depth experience and a proven track record in IP. Being involved in IP practice for over 18 years, Oleg has gained extensive experience in complex matters ranging from obtainment of legal protection to IP objects, development of clients' IP portfolios and handling all issues from managing IP portfolios to challenging law enforcement projects that combine multiple legal actions. Representative matters include M&A, strategic partnerships, and IP licensing and technology transfer deals on behalf of clients ranging from start-ups to *Fortune 100* companies. His IP litigation and dispute resolution expertise covers all types of proceedings before the courts in Ukraine and administrative proceedings before appeal bodies of the National Intellectual Property Office in Ukraine. Oleg is equally an expert in patent, trade mark and copyright litigation covering infringement proceedings, invalidity and establishment of ownership proceedings in Ukraine.

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Elena Biloshuk is an experienced Attorney at Law and IP lawyer best known for her tailored solutions in strategic counselling and IP enforcement procedures, starting from pre-trial settlements and leading to litigation before the courts of all instances, representation before the police and other state authorities, as well as assistance with border control measures.

Elena is particularly strong at building up and efficiently applying the strategies aimed at prevention or tackling ongoing IP infringements. She is also experienced in drafting and negotiating of various types of IP transactions, including cross-border agreements.

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