

**International  
Comparative  
Legal Guides**



# Trade Marks

# 2024

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# Ukraine



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### 1 Relevant Authorities and Legislation

#### 1.1 What is the relevant trade mark authority in your jurisdiction?

The state organisation “Ukrainian National Office for Intellectual Property and Innovations” (UANIPIO) is the relevant trade mark authority in Ukraine and since November 8, 2022 has performed the functions of the National Intellectual Property Authority (NIPA).

#### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The main laws and international treaties are:

- I. National legislation:
  - the Constitution of Ukraine, 1996;
  - the Civil Code of Ukraine, 2003;
  - the Law of Ukraine “On Protection of Rights to Marks for Goods and Services”, 1993 (Trade Mark Law, amended in 2023);
  - the Rules on Drafting, Filing and Consideration of Trade Mark Applications, approved by Order of the State Department for Intellectual Property, 1995 (amended in 2011);
  - the Law of Ukraine “On Protection of Interests of Persons in the Sphere of Intellectual Property during Martial Law”, 2022;
  - the Law of Ukraine “On Amendments to Certain Legislative Acts of Ukraine on Legal Protection of Intellectual Property”, 2023;
  - the Law of Ukraine “On Condemnation of the Communist and National-Socialist (Nazi) Totalitarian Regimes in Ukraine and Prohibition of Propaganda of Their Symbols”;
  - the Law of Ukraine “On Condemnation and Prohibition of the Propaganda of Russian Imperial Policy in Ukraine and the Decolonization of Toponymy”; and
  - the Law of Ukraine “On Emblems of the Red Cross, the Red Crescent and the Red Crystal”.

- II. International legislation:
  - the EU-Ukraine Association Agreement, 2014;
  - the Paris Convention for the Protection of Industrial Property, 1883–1967 (Paris Convention);
  - the Madrid Agreement Concerning the International Registration of Marks, 1891–1967 (Madrid Agreement);
  - the Nice Agreement Concerning the International Classification of Goods and Services (ICGS) for the Purposes of the Registration of Marks, 1957–1977 (Nice Agreement);
  - the Vienna Classification, 1973;
  - the Nairobi Treaty on the Protection of the Olympic Symbol, 1981;
  - the Protocol Relating to the Madrid Agreement, 1989;
  - the Agreement on Trade-Related Aspects of Intellectual Property Rights, 1994;
  - the Trademark Law Treaty, 1994; and
  - the Singapore Treaty on the Law of Trademarks, 2006.

### 2 Application for a Trade Mark

#### 2.1 What can be registered as a trade mark?

Any sign or combination of signs may be the subject of a trade mark. Such signs may include, in particular: words; personal names; letters; numerals; figurative elements; colours; the shape of products or their packaging; and sounds, provided that such signs are suitable to distinguish the goods or services of one person from those of other persons, and are appropriate for their reproduction in the Register in such a way as to enable clear and precise scope of the granted legal protection.

#### 2.2 What cannot be registered as a trade mark?

- I. In accordance with the Trade Mark Law, legal protection in Ukraine is not granted to designations 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 organisations;
  - official control, guarantee or testing seals, stamps; or
  - decorations and other honourable distinctions.
- II. Legal protection is not granted to designations that:
- are usually devoid of distinctive character and have not obtained such distinctiveness through their use;
  - consist exclusively of signs that are generally used in modern language or in fair and constant trade practices on goods and services;
  - consist exclusively of signs or data that are descriptive while used in terms of goods and services referred to in the application or due to them, indicate 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;
  - can be misleading with regard to goods or services, in particular as to their nature, quality or geographical origin;
  - can be misleading 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 stipulated by the nature of a product itself or by the necessity to obtain a technical result, or by the form that gives substantial value to a product;
  - reproduce the name of a plant variety registered or applied for registration in Ukraine or which has been registered in accordance with an international agreement of Ukraine before the filing date of an application for a trade mark containing such sign, and if the claimed sign concerns a plant variety of the same or related species; or
  - contain geographical indications (including spirits and alcoholic beverages) 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 filing date of an application for a trade mark that contains such indication, and if the priority has been claimed, prior to the priority date for the same or related goods, if, when using the applied sign, the reputation of a geographical indication is used and/or the applied sign is misleading as to the special quality, characteristics and true origin of the product.
- III. Legal protection will not be granted to marks that, on the date of filing of an application or, in case priority is claimed, on the priority date, are identical or misleadingly similar to such an extent that they can be confused or, in particular, may be associated with:
- trade marks that were registered earlier or filed for registration in Ukraine on behalf of another person for identical or similar goods and services;
  - trade marks of other persons if these trade marks are protected without registration according to the international agreements to which Ukraine is a party, in particular, trade marks recognised as well known in accordance with Article 6-*bis* of the Paris Convention as regards identical or similar goods and services;
  - trade marks of other persons if these trade marks are protected without registration according to the international agreements to which Ukraine is a party, in particular, trade marks recognised as well known in accordance with Article 6-*bis* of the Paris Convention regarding non-related goods and services, if the use of a trade mark by another person in regard to such non-related goods and services indicates the connection between them and the owner of a well-known trade mark 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 said names before the date of filing the application to the NIPA with respect to identical or similar goods and services;
  - conformity (Certification) marks registered in accordance with the prescribed procedure; or
  - trade marks that are used by another person in a foreign country, if an application is filed in its own name by an agent or a representative of such person in the context of Article 6-*septies* of the Paris Convention without authorisation of such person and there is no proof justifying such filing provided there is an opposition by such person.
- IV. Legal protection will not be granted to designations that reproduce:
- industrial designs that are registered in Ukraine and belong to other persons (protection is granted in case consent to trade mark registration is given by the design rights holder and there is no probability of misleading consumers by such registration);
  - titles of scientific, literary and artistic works known in Ukraine or quotations and characters from said works, as well as the artistic works and their fragments, without the consent of copyright holders or their legal successors; and
  - surnames, first names, pseudonyms and their derivatives, portraits and facsimiles of persons known in Ukraine, without their consent.
- V. Legal protection shall not be granted to, and shall not be registered as trade marks, signs that contradict the requirements of Article 5(2) of the Trade Mark 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”.

### 2.3 What information is needed to register a trade mark?

To register a trade mark in Ukraine, it is necessary to file an application with the UANIPIO including the following information:

- the name and address of the applicant(s) in the language of origin and their transliteration in Ukrainian Cyrillic characters;
- an image of the mark being claimed as a trade mark and a description thereof;
- a list of goods/services for which a mark should be registered, classified in accordance with the current edition of the Nice Classification (NCL). The list of goods/services should be translated into the Ukrainian language;
- the number, date and country code of the previous application to the same trade mark or date of exhibition if conventional or exhibition priority is claimed in accordance with the Paris Convention;
- a copy of the previous application with its translation into the Ukrainian language or a document that confirms the demonstration of the mark at an exhibition (in case conventional or exhibition priority is claimed);
- a Power of Attorney for representation of the applicant's interests; and
- a document confirming payment of the official filing fee.

#### 2.4 What is the general procedure for trade mark registration?

In accordance with the Trade Mark Law, a trade mark application undergoes two stages of examination – formal and substantive:

##### I. Formal examination:

During this stage, the UANIPIO checks whether the filed application corresponds to the formal requirements of the Trade Mark Law, contains all of the required information, checks the payment of the official filing fee (which must be paid within two months from the date of filing the application), and determines the filing date of the application. When the above formalities are met, the claimed list of goods/services is examined for compliance with the current edition of the NCL. In case of any inaccuracies with the claimed wording, the examiner issues the Office action (examiner's request). The applicant should provide a response to the request within two months from its receipt. If necessary, this term may be extended for an additional period of three or six months.

If the application meets all formal requirements, a conclusion of formal examination is issued, and the application moves on to the stage of substantive examination.

##### II. Substantive examination:

At this stage, the claimed designation is examined as to its conformity with the conditions for granting legal protection (absolute and relative grounds). If there are any reasons to consider that the claimed mark does not meet the requirements for granting legal protection, fully or partially, the UANIPIO sends a grounded provisional refusal to the applicant with the suggestion to submit a motivated response thereto. The applicant has two months to reply to the provisional refusal (three months for marks filed through the Madrid System). If necessary, this term may be extended for an additional period of three or six months.

In case the examiner finds no grounds for refusal and the claimed designation meets the criteria for granting legal protection, the examiner issues a decision on registration of a trade mark.

Based on the grant of protection decision, and provided that the official registration fees are paid, a trade mark certificate is issued, and general information about the registered trade mark is published in the Official Bulletin and on the UANIPIO's website.

#### 2.5 How is a trade mark adequately represented?

The image of the mark whose registration is applied for is filed in the form of a photocopy or print size 8 × 8 cm.

If a three-dimensional mark is claimed, its image is submitted in such a perspective that allows the entire object to be visualised. In addition, images of all the necessary projections are submitted to ensure comprehensive imagination of the mark.

If a label is claimed as a trade mark, it is filed as an image of the mark, provided that its size does not exceed 14 × 14 cm.

Photocopies or prints should be easily contrasted, sharply defined and submitted in the colour (or combination of colours) described in case the colour(s) is claimed in the application materials.

If a sound mark is filed for registration, it should be presented in the form of a phonogram (only sound marks that can be translated into musical notes, in particular in the form of a chord, musical work or its fragment are acceptable for registration).

If a colour or combination of colours is filed for registration as a trade mark, prints are to be submitted with the surface on which it is applied.

#### 2.6 How are goods and services described?

The goods/services for which the mark is intended to be registered should be clearly listed and grouped in accordance with the current edition of the NCL. The application must be filed with the list of goods/services stated in the Ukrainian language. In case of filing an application with the list of goods/services stated in a foreign language, the filing date of the application will be determined by the UANIPIO upon the date of receiving the translation of the list of goods/services. Multi-class applications are available according to the Trade Mark Law.

#### 2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Apart from traditional standard character trade marks, figurative marks and combined marks, Ukrainian legislation provides the registration only of sound marks, colours and three-dimensional marks that may be deemed "exotic" to some extent.

To register sound marks, colours and three-dimensional marks, the following requirements should be fulfilled:

- Sound marks: considering that current Ukrainian legislation allows registration of marks, which can be graphically represented, only sound marks that can be translated into musical notes, particularly in the form of a chord, musical work or its fragment are acceptable for registration. For registering a sound mark, a musical notation of sounds that are a sign must be provided, a description of the sound designation in which it is noted, in particular, a musical instrument on which a piece of music or its fragment is performed, and the recording of such mark in electronic form.
- Colour *per se*: typically, such designations do not possess distinctiveness; however, they may be suitable for obtaining legal protection assuming the applicant provides evidence that the mark acquired distinctive character as a result of its use. In case a colour or combination of colours is applied for registration as a trade mark, a verbal description of the colour must be provided along with the application. In particular, the description should contain the exact name(s) of the colour(s) applied as a trade mark. Along with the name, its code can be indicated in an internationally recognised colour identification system; for example, the Pantone Matching System, RAL or Focoltone colour scale. In this case, in the trade mark application itself, the image of the mark is reproduced as a colour or combination of colours. The application may also include a description that notes, in particular, how the colour or combination of colours is applied in connection with the claimed goods/services and examples of such use.
- Three-dimensional marks: three-dimensional marks cannot simply repeat the appearance of a known subject, but should be characterised by its original appearance, and its shape should not be determined solely by functional destination. In case a three-dimensional mark is applied for registration, the general view of the mark should be stated in the application and all additional views should be stated in the appendix to the application.

#### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

No, proof of use is not required for trade mark registrations and/or renewal purposes.



### 2.9 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Ukrainian trade mark registration covers the entire territory of Ukraine.

### 2.10 Who can own a trade mark in your jurisdiction?

The owner of a trade mark may be a natural person or legal entity. Joint ownership is also available. Foreign applicants have the same rights and obligations as Ukrainian applicants.

Foreign applicants residing or having a permanent location outside Ukraine exercise their rights in their relations with the relevant governmental authority through local representatives (registered trade mark attorneys).

### 2.11 Can a trade mark acquire distinctive character through use?

In accordance with the provisions of Trade Mark Law, legal protection is not granted to marks that are usually devoid of any distinctive character and have not obtained such character as a result of their use. This means that a mark without inherent distinctive character can acquire distinctiveness through its extensive use. To prove that a trade mark has acquired distinctiveness, it is necessary to submit to the UANIPIO the relevant documents confirming the trade mark's use prior to the filing date of an application.

### 2.12 How long on average does registration take?

In case of a smooth registration process (no Office actions and no oppositions by third parties are raised), the registration of a trade mark takes, on average, 20–24 months.

### 2.13 What is the average cost of obtaining a trade mark in your jurisdiction?

The average cost (official fee) for registration of a black-and-white word, figurative or combined trade mark in one class of the NCL in the name of one applicant will be about USD 300. An additional official fee in the amount of USD 20 should be paid in the event that a colour is claimed in the trade mark image.

Fees for the legal representation of an applicant by a trade mark attorney may need to be added to the aforementioned expenses.

### 2.14 Is there more than one route to obtaining a registration in your jurisdiction?

For obtaining trade mark registration in Ukraine, another route besides the local procedure described above is available; namely, designating Ukraine in an application for international trade mark registration as provided for by the Madrid System for the International Registration of Marks, which is governed by the Madrid Agreement and related Protocol.

### 2.15 Is a Power of Attorney needed?

The Trade Mark Law provides that foreign applicants residing or having a permanent location outside Ukraine exercise their

rights in their relations with the relevant governmental authority through registered trade mark attorneys. Thus, for representation of an applicant's interests before the UANIPIO, a Power of Attorney is required. In accordance with the existing practice, a trade mark application may be filed without a Power of Attorney upon its further submission to the UANIPIO.

### 2.16 If so, does a Power of Attorney require notarisation and/or legalisation?

A Power of Attorney does not require notarisation and/or legalisation. Nevertheless, it must be notarised in case it is executed by the right of substitution.

### 2.17 How is priority claimed?

Priority of a previous application on the same mark may be claimed within six months following the filing date of the previous application to the relevant body of a Member State of the Paris Convention, provided that the priority on the previous application was not claimed earlier. A declaration of priority is filed during filing of a trade mark application or within three months following the filing date of the application (a certified copy of the previous application with its translation into Ukrainian should be submitted to the UANIPIO within said term as well).

Priority of a mark that was used in an exhibit shown at an official or officially recognised international exhibition in the territory of a Member State of the Paris Convention may be determined by the opening date of the exhibition, provided that the application is filed to the UANIPIO within six months from said date. A document that confirms demonstration of the mark at an exhibition should be submitted to the UANIPIO within three months from the filing date of the application.

### 2.18 Does your jurisdiction recognise Collective or Certification marks?

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

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

In accordance with the Trade Mark Law, designations are refused registration if they:

- I. contradict public order, principles of humanity and morality, or requirements of the Laws of Ukraine "On Condemnation of the Communist and National-Socialist (Nazi) Totalitarian Regimes in Ukraine and Prohibition of Propaganda of Their Symbols" and "On Condemnation and Prohibition of the Propaganda of Russian Imperial Policy in Ukraine and the Decolonization of Toponymy";
- II. represent or imitate:
  - state armorial bearings, flags, and other state symbols (emblems);
  - full or abbreviated official names of states or international codes of states;
  - emblems and abbreviated or full names of international intergovernmental organisations;

- official control, guarantee or testing seals, stamps; or
  - decorations and other honourable distinctions;
- III. are usually devoid of distinctive character and have not obtained such distinctiveness through their use;
  - IV. consist only of signs that are generally used in modern language or in fair and constant trade practices on goods and services;
  - V. consist only of signs or data that are descriptive while used in connection with goods and services referred to in the application or in association with them, indicate 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;
  - VI. can be misleading with regard to goods or services, in particular as to their nature, quality or geographical origin;
  - VII. can be misleading with regard to the person manufacturing the product or rendering the service;
  - VIII. consist exclusively of signs that are commonly used symbols and terms; or
  - IX. represent only the form stipulated by the nature of a product itself or by the necessity to obtain a technical result, or by the form that gives substantial value to a product.

### 3.2 What are the ways to overcome an absolute grounds objection?

To overcome a provisional refusal based on absolute grounds, it is necessary to submit a motivated response to the UANIPIO within two months from the date of receiving the provisional refusal. The term for submitting such response to the international registration holder will be three months from the date of sending a provisional refusal of trade mark protection to the International Bureau of the World Intellectual Property Organization (WIPO) by the UANIPIO.

The term for submitting the response may be extended by an additional three or six months provided that the relevant request is filed to the UANIPIO. Reinstatement of the missed term for filing a response to a provisional refusal is also possible.

The arguments provided in response to the provisional refusal are considered by the UANIPIO examiner and taken into account when making a final decision on the application.

It is worth noting that:

- the signs in item II of question 3.1 may be included in the trade mark application as non-protected elements of a trade mark, provided that consent of the relevant authorised body or the owners thereof has been given. The UANIPIO performs functions of the authorised body for granting permission to use the official name and international code of Ukraine in the trade mark and/or to include in the image of the trade mark an imitation of the small State Coat of Arms of Ukraine;
- the signs described in items III, IV, V, VIII, IX of question 3.1 (except misleading signs) may be included in a trade mark (in part) as non-protectable elements if they do not occupy the dominant position within this trade mark; and
- the signs described in items III, IV, V, VIII, IX of question 3.1 (except misleading signs) may be granted legal protection if they have acquired distinctiveness as a result of their use prior to the filing date of the application.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A final decision on a trade mark application may be appealed by the applicant.

### 3.4 What is the route of appeal?

An applicant is entitled to appeal a final decision on a trade mark application to the court or to the Appeals Chamber of the UANIPIO within two months from the date of receiving the relevant decision. For the international registration holder, this term is three months from the date of sending final refusal of trade mark protection (total or partial) to the International Bureau of WIPO by the UANIPIO.

The filed appeal against the final decision on the trade mark application is considered by the Appeals Chamber within two months from the date of receiving the appeal and the document confirming payment of the respective official fee. The term for consideration of the appeal may be extended on the initiative of the applicant, but for no more than two months, provided that the relevant request is filed and the official fee is paid with respect to the request.

The Appeals Chamber's decision may be appealed to the court within two months from the date of its receipt by the applicant.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

- I. In accordance with the Trade Mark Law, legal protection is not granted to marks that, on the date of filing of an application or, in case priority is claimed, on the priority date, are identical or misleadingly similar to such an extent that they can be confused or, in particular, may be associated with:
  - trade marks that were earlier registered or filed for registration in Ukraine on behalf of another person for identical or similar goods and services;
  - trade marks of other persons if these trade marks are protected without registration according to the international agreements to which Ukraine is a party, in particular, trade marks recognised as well known in accordance with Article 6-bis of the Paris Convention as regards identical or similar goods and services;
  - trade marks of other persons if these trade marks are protected without registration according to the international agreements to which Ukraine is a party, in particular, trade marks recognised as well known in accordance with Article 6-bis of the Paris Convention regarding non-related goods and services, if the use of a trade mark by another person regarding such non-related goods and services indicates a connection between them and the owner of a well-known trade mark 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 said names before the date of filing the application to the UANIPIO with respect to identical or similar goods and services;
  - conformity (Certification) marks registered in accordance with the prescribed procedure; or
  - trade marks that are used by another person in a foreign country, if an application is filed in its own name by an agent or a representative of such person in the context of Article 6-septies of the Paris Convention without authorisation of such person and there is no proof justifying such filing provided there is an opposition filed by such person.

It is worth noting that signs that are identical or misleadingly similar to such an extent that they can be confused with the abovementioned: (1) earlier registered or filed trade marks; (2) well-known trade marks; (3) trade names; and (4) trade marks that are used by another person in a foreign country (Article 6-*septies* of the Paris Convention) may be registered in Ukraine provided that consent is given by the holder of the relevant rights, cited in the course of trade mark examination, assuming there is no probability of misleading consumers.

II. Legal protection will not be granted to designations that reproduce:

- industrial designs that are registered in Ukraine and belong to other persons (protection is granted in case consent to trade mark registration is given by the design rights holder and there is no probability of misleading consumers by such registration);
- titles of scientific, literary and artistic works known in Ukraine or quotations and characters from said works, as well as the artistic works and their fragments, without the consent of copyright holders or their legal successors; and
- surnames, first names, pseudonyms and their derivatives, portraits and facsimiles of persons known in Ukraine, without their consent.

III. Legal protection in Ukraine is not granted to designations that:

- reproduce the name of a plant variety registered or applied for registration in Ukraine or which has been registered in accordance with an international agreement of Ukraine before the filing date of an application for a trade mark containing such sign, and if the claimed sign concerns a plant variety of the same or related species; and
- contain geographical indications (including spirits and alcoholic beverages) 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 filing date of an application for a trade mark that contains such indication, and if the priority has been claimed, prior to the priority date for the identical or similar goods, if, while using the applied sign, the reputation of a geographical indication is used and/or the applied sign is misleading as to the special quality, characteristics and true origin of the product.

#### 4.2 Are there ways to overcome a relative grounds objection?

To overcome the provisional refusal issued on relative grounds, it is necessary to submit a motivated response to the UANIPIO within two months from the date of receipt of the provisional refusal. For international registration holders, the term for responding will be three months from the date of sending provisional refusal of trade mark protection to the International Bureau of WIPO by the UANIPIO.

This term may be extended for an additional period of three or six months provided that the relevant extension request is duly filed to the UANIPIO. Reinstatement of the missed term for filing a response is also available.

The motivated response to the provisional refusal should contain the arguments in favour of trade mark registration. In accordance with current practice, documents confirming active use of the trade mark in Ukraine (confirming that the sign gained distinctiveness) are considered a strong argument in favour of the registration of a trade mark.

The UANIPIO examiner takes into account all the arguments provided in response and makes a final decision on the application.

#### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A final decision on a trade mark application may be appealed by the applicant.

#### 4.4 What is the route of appeal?

Please see the answer to question 3.4 above.

## 5 Opposition

#### 5.1 On what grounds can a trade mark be opposed?

Trade mark application may be opposed on the absolute and relative grounds discussed in sections 3 and 4 above.

#### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

In accordance with the provisions of the Trade Mark Law, any person has the right to file a grounded opposition to the UANIPIO in respect of the unconformity of the designation presented in the application with the requirements of granting legal protection according to the present law. Submission of the opposition is subject to payment of the official fee.

#### 5.3 What is the procedure for opposition?

The opposition against trade mark application/international registration should be filed to the UANIPIO within three months from the date of its publication in the relevant bulletin.

As soon as the opposition is filed, the UANIPIO sends a copy to the applicant of the opposed application. The applicant is entitled to file a response to the arguments stated in the opposition within two months from the date of receipt of the opposition. The applicant may decline the opposition and leave the application unchanged, make amendments to the application, or withdraw it.

It is worth noting that for the holder of an international registration, the term for replying to the opposition is three months from the sending date of a UANIPIO notification to the International Bureau of WIPO about provisional refusal of protection along with the copy of the opposition.

The filed opposition is considered by the UANIPIO at the stage of substantive examination. As a result of the opposition consideration, the UANIPIO may issue one of the below listed decisions to include in the application and send to the opposer:

- grant of protection to the subject sign for all claimed goods/services;
- grant of protection to the subject sign regarding some of the claimed goods/services; or
- total refusal of grant of protection to the subject sign.

In case the UANIPIO issues a grant of protection decision for all goods/services or their part, the examination of the application can be suspended to provide a possibility for the opposer to appeal the issued decision to the Appeals Chamber. The opposer has two months from the receiving date of the grant of protection decision to submit an appeal that is subject to official



fee payment. The applicant of the opposed application has the right to submit a grounded response to the filed appeal.

The filed appeal is considered within two months from its receipt by the UANIPIO within the scope of argumentation stated in the appeal and arguments provided during its consideration and taking into account the applicant's response to such appeal (if any). The term of the appeal consideration may be extended to an additional two months by the applicant or opposer who filed the appeal.

The results of the opposition consideration are presented in the grounded UANIPIO decision. The copy of such decision is sent to all participants of the appeal consideration.

The Appeals Chamber's decision may be appealed to the court within two months from the date of receipt of the decision.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

As soon as the substantive examination is successfully completed, the UANIPIO examiner issues a decision on registration of a trade mark and sends it to the applicant.

As prescribed by the Trade Mark Law, the applicant has three months from the date of receiving the decision for payment of the official registration and publication fees. In case of necessity, the term for payment of the official fees may be subject to an extension of an additional period of three or six months, provided that the relevant extension request is submitted to the UANIPIO before the expiration of the set term. Reinstatement of the missed term is also available.

Based on the official registration fees being paid, the UANIPIO makes a trade mark registration and publishes the relevant data in the Official Bulletin and online register. The registration certificate is granted within a month from the registration of the trade mark.

### 6.2 From which date following application do an applicant's trade mark rights commence?

The rights deriving from a trade mark registration certificate are effective from the filing date of an application.

### 6.3 What is the term of a trade mark?

The validity period of the trade mark registration certificate is 10 years from the date of filing the application.

### 6.4 How is a trade mark renewed?

The trade mark may be renewed for 10 years each time at the request of the trade mark owner, provided that the respective fee is paid.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

In accordance with Ukrainian legislation, registration of a trade mark assignment agreement is mandatory. The assignor or assignee is entitled to apply for registration of a trade mark assignment with the UANIPIO. The assignment registration

request should be filed by the representative in the case that the trade mark is assigned to a non-resident of Ukraine. Registration of the trade mark assignment agreement is subject to payment of the official fee.

For registration of a trade mark assignment, an assignment agreement or notarised extract from the agreement, a Power of Attorney (if necessary), and confirmation of the official fee payment should be filed with the UANIPIO along with the relevant request.

Registration of a trade mark assignment is not allowed if it may cause the deception of consumers with respect to goods and services, or of the person manufacturing goods or rendering services.

### 7.2 Are there different types of assignment?

A trade mark right can be assigned in full or with respect to some goods/services.

### 7.3 Can an individual register the licensing of a trade mark?

A licence agreement can be registered; however, the registration is not compulsory.

The licensor or licensee is entitled to apply for registration with the UANIPIO; such registration is subject to the official fee payment.

For registration of a licence agreement, the following documents should be filed to the UANIPIO along with the relevant request:

- agreement or notarised extract from the agreement;
- Power of Attorney (if necessary); and
- confirmation of the official fee payment.

Furthermore, to be registered, the licence agreement or an extract thereof should contain a condition that the quality of goods and services manufactured or provided under a licence agreement may not be lower than the quality of the goods and services of the trade mark owner, and that the latter will exercise control over fulfilment of this condition.

### 7.4 Are there different types of licence?

A trade mark owner may issue, to any person, an exclusive, non-exclusive or sole licence for the use of a registered mark.

An exclusive licence is issued to only one licensee and excludes the possibility for the licensor to use the trade mark in a field that is restricted by this licence and to grant licences to other entities.

A non-exclusive licence does not exclude the possibility of the licensor using the trade mark in a field that is restricted by this licence and granting licences to other entities.

A sole licence is issued to only one licensee and excludes the possibility for the licensor to grant the licences to other entities in the areas that are restricted by this licence; however, this does not rule out the possibility of use of the trade mark by the licensor.

A licensee using the mark based on the licence agreement may issue a licence to a third party to use the mark if the relevant power is prescribed by the licence agreement.

### 7.5 Can a trade mark licensee sue for infringement?

A trade mark licensee can sue for trade mark infringement provided that the relevant consent has been given by the trade mark owner.

#### 7.6 Are quality control clauses necessary in a licence?

The Trade Mark Law prescribes that the licence agreement should contain a provision that the quality of goods or services manufactured or rendered according to the licence agreement will not be lower than the quality of goods and services provided by the trade mark owner. The trade mark owner controls the fulfilment of said provision.

#### 7.7 Can an individual register a security interest under a trade mark?

Yes, a security interest under a trade mark can be registered in the relevant state register.

#### 7.8 Are there different types of security interest?

There are both private (based on agreement conditions) and public (based on a court or enforcement agency decision or the legislative provision) types of security interest.

## 8 Revocation

#### 8.1 What are the grounds for revocation of a trade mark?

The following grounds exist for the court's revocation of trade mark registration:

- a mark has been transformed into a sign that has become commonly used as a sign for goods and services of a certain type after the filing date of the application;
- a mark has been transformed into a sign that can mislead the public, in particular with regard to the origin, quality or geographical origin of the goods and services for which it has been registered; and
- a mark has not been used in Ukraine fully or with respect to a part of goods and services listed in the trade mark certificate within five years from the date of publishing the information on granting the certificate or from another date after the publication date.

Moreover, trade mark registration is revoked automatically in case of the missed term for payment of the relevant official renewal fee.

#### 8.2 What is the procedure for revocation of a trade mark?

For the court's revocation of the trade mark, any interested party should initiate a court proceeding against the owner of the disputed registration and the UANIPIO (as the relevant governmental authority administrating the Trade Mark Register).

To prove non-use of the disputed mark, a claimant should conduct non-use research prior to filing a claim.

#### 8.3 Who can commence revocation proceedings?

Any person or entity is entitled to commence revocation proceedings, provided that evidence of the infringed rights of the claimant by the disputed registration is submitted to the court.

#### 8.4 What grounds of defence can be raised to a revocation action?

If a revocation action is based on the ground that the disputed mark has been transformed into a sign that became commonly used as a sign for goods and services of a certain type, the trade mark owner may use the following arguments:

- initiate conducting of an examination by the certified expert or request an additional forensic examination; and/or
- provide the court with evidence confirming that the disputed trade mark possesses distinctiveness and is associated by consumers with the trade mark owner.

If the revocation action is based on non-use grounds, the owner of the disputed trade mark can provide the court with evidence confirming that the mark has been used within the period indicated by the plaintiff. For this purpose, any documents confirming the trade mark's use could be submitted to the court, for instance: simple copies of advertisements meant for use in Ukraine; brochures; copies of agreements; invoices for the supplied goods; and documents related to use of the trade mark in exhibitions and other commercial activities, etc.

Moreover, according to the Trade Mark Law, a trade mark owner may provide the court with valid reasons for such non-use, namely:

- conditions that block the use of the mark independently of the will of the trade mark owner, such as the limitation of import of goods or other requirements for goods and services that are determined by the legislation; and/or
- the possibility of deception with respect to the person manufacturing the goods or rendering services, while the plaintiff or another person uses the mark for the goods and services for which revocation of the registration was initiated.

#### 8.5 What is the route of appeal from a decision of revocation?

The owner of the revoked trade mark has a right to appeal a first instance court decision to the appeal court. A decision of the appeal court may be appealed in cassation.

## 9 Invalidity

#### 9.1 What are the grounds for invalidity of a trade mark?

In accordance with the Trade Mark Law, a trade mark certificate may be fully or partially invalidated by the court based on the following grounds:

- the registered mark does not meet the requirements for granting legal protection;
- the registration certificate contains elements of the mark and goods/services that were not presented in the filed application; and
- the certificate was granted as the result of the filing of an application in infringement of the rights of other parties.

The invalidated certificate or its part are considered to be those that are no longer in effect from the filing date of the application.

#### 9.2 What is the procedure for invalidation of a trade mark?

To invalidate a trade mark, any interested party should initiate a court proceeding against the owner of the disputed registration and the UANIPIO (as the relevant governmental authority administrating the Trade Mark Register).

The parties submit to the court a statement of claim and supporting evidence. Usually, the main evidence in such matters includes the conclusion of the certified expert.

As a consequence of court consideration, the court passes judgment.

If the certificate is declared invalid and the court finds that the application was filed in infringement of the rights of other parties, the court may issue a decision on compensation by the owner of the certificate to the person who was harmed by the actions resulting from the registration of the trade mark in infringement of his rights.

### 9.3 Who can commence invalidation proceedings?

Any person or entity is entitled to commence invalidation proceedings provided that evidence of the infringed rights of the plaintiff by the disputed registration is submitted to the court (e.g. the disputed trade mark is misleadingly similar to the plaintiff's earlier registered trade mark).

### 9.4 What grounds of defence can be raised to an invalidation action?

In case of actions based on absolute grounds, the defendant may provide the court with the grounded argumentation that there are no legal reasons to apply the stated absolute grounds (e.g. evidence that the disputed trade mark is not descriptive). To defend against actions based on lack of distinctiveness, the relevant poll results may be submitted to the court.

In case of actions based on relative grounds (e.g. similarity with the earlier registered mark), the defendant may argue that the disputed mark is not similar to such extent that it can be confused with the earlier registered trade mark. For this purpose, the defendant may submit a conclusion by a certified expert. Moreover, it is possible to lodge a counterclaim for cancellation of the opposed registration.

### 9.5 What is the route of appeal from a decision of invalidity?

The owner of the invalidated trade mark has a right to appeal a first instance court decision to the appeal court. A decision of the appeal court may be appealed in cassation.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

The manner and court by which a trade mark is enforced depends on the trial participants, namely:

- Before the commercial court of the infringer's location, in the case that all trial participants are legal entities and/or private entrepreneurs.
- Before the civil court at the defendant's location or the location of the damages caused, in the case that at least one of the trial participants is a natural person.

To initiate a lawsuit, a plaintiff should file a legal action to the relevant court.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

As a matter of pre-trial settlement of the dispute, a cease-and-desist letter can be used by the rights holder. It usually takes about two months to reveal whether the sent letter is effective or not in the particular case.

As to the court proceeding, consideration of the case in the first instance court usually lasts about four to eight months. Consideration of the case in the appeal court and the court of cassation takes approximately four to seven months.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so, on what basis in each case?

Preliminary injunctions are provided by all of the Ukrainian procedural codes and may be applied by the court in the case that non-use thereof may have resulted in the impossibility of a court decision being executed.

Final injunctions are not prescribed by Ukrainian legislation.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so, how?

A party to an action may be compelled to disclose relevant information, documents or materials to its adversary based on the court ruling, which may be, *inter alia*, initiated by the adversary.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

All submissions and evidence should be presented to the court in written form. The trial participants are entitled to present oral motions and give oral comments.

Witness testimony is prescribed by Ukrainian legislation. When it comes to examination of witnesses, the court and all trial participants can pose questions to the witness related to the matter. However, the cross-examination of witnesses is not available in commercial proceedings; it is only available in criminal court proceedings.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

An infringement proceeding can be stayed pending resolution of validity in another court case if the resolution of validity relates to IP rights on which the infringing claim is based.

### 10.7 After what period is a claim for trade mark infringement time-barred?

The limitation of actions for filing a lawsuit is three years from the date on which the plaintiff became aware or should have known of the rights infringement. The missed term may be renewed provided that the plaintiff submits a grounded reason for not being able to file a lawsuit within the prescribed period.

### 10.8 Are there criminal liabilities for trade mark infringement?

There are the following criminal liabilities for trade mark infringement prescribed by the Criminal Code of Ukraine:

- penalty; and
- deprivation of the right to occupy certain positions or engage in certain activities for a term of up to three years or without such term.

It is worth noting that criminal liability arises only if damages caused by the infringement exceed approximately USD 715.

### 10.9 If so, who can pursue a criminal prosecution?

Given that IP rights to a trade mark are private rights, it is a rights holder or licence holder who is entitled to pursue a criminal prosecution of the infringer.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

Ukrainian legislation does not contain specific provisions relating to unauthorised threats of trade mark infringement.

Nevertheless, local laws ensure a viable mechanism of protection of honour, dignity and business reputation, so any business entity may defend the violated rights in court.

Moreover, Ukrainian competition legislation provides for protection against discreditation and libel.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The following grounds of defence to a claim of trade mark infringement can be used by a defendant depending on the list of claims:

- the used trade mark is not similar to such an extent that it can be confused with the plaintiff's trade mark and/or the goods/services are not homogeneous;
- non-use of the plaintiff's mark by the defendant;
- the plaintiff's mark was not applied on the defendant's goods, package label or other item attached to the goods;
- the goods marked with a disputed mark were not stored for subsequent offering for sale by the defendant;
- the goods marked with a disputed mark were not offered for sale, import or export by the defendant;
- the disputed mark was not used by the defendant while offering or rendering any service for which the plaintiff's mark is registered;
- the disputed mark was not used in the defendant's business documentation or in advertising, or on the internet;
- the defendant has the right of prior use to the disputed mark;
- the used mark was introduced into the commercial turnover with the plaintiff's permission;
- the usage of the disputed mark was non-commercial;
- the used mark was used in broadcasting or comments in the news;
- the used mark contains the defendant's name or addresses (in case of fair use); and
- the statute of limitations has expired.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

In addition to the non-infringement grounds of defence, a counterclaim may be filed against the trade mark on the following grounds:

- the opposed mark does not meet the requirements for granting legal protection;
- the opposed mark contains elements of, or is registered for, goods/services that were not presented in the filed application;
- the rights were granted as a result of the filing of an application in infringement of the rights of other parties;
- the plaintiff's mark has transformed into a designation that is commonly used as a designation of goods and services of a certain kind (after the filing date of an application); or
- the opposed mark has not been used in Ukraine for five years or more.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The remedies available for trade mark infringement are as follows:

- cessation of the disputed mark's use;
- compensation of losses caused by infringement of the plaintiff's rights;
- removal of the disputed mark from the product and/or its packaging;
- liquidation of the produced reproductions of the disputed mark; and
- liquidation of the counterfeit goods.

### 12.2 Are costs recoverable from the losing party and if so, how are they determined and what proportion of the costs can usually be recovered?

Yes, it is possible to recover the sued charges from the losing party.

The calculation of the sued charges should be provided to the court and may include, *inter alia*, court fees, forensic examination costs, attorney's fee, etc.

It is worth noting that in order to be accepted, a reasonable calculation of the legal and other professional fees should be submitted to the court. Provision of the documents that confirm payment of such fees is required.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

A decision of the first instance court may be appealed to the appeal court. In certain cases, the appeal court's decision can be appealed on cassation.

The appeal court reviews the case on the evidence available, and additional evidence, and verifies the legality and validity of the decision of the first instance court within the framework of the arguments and the requirements of the appeal.

During the cassation appeal, the court only considers whether the substantive and procedural law provisions were broken during the case's consideration.



### 13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence not submitted to the first instance court is considered by the appeal court only in exceptional instances, if the participant in the case proves that it was impossible to submit it earlier for reasons that were not objectively dependent on him.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and if so, how quickly are such measures resolved?

The goods seizing and preventing mechanism consists of a risk management system of the Customs Register of Ukraine providing an opportunity to screen imported goods according to the information entered by the rights holder into the Customs Register of Ukraine, and by means of a visual check of the goods by customs officers.

In this case, on the grounds of the data of the Customs Register, the goods are suspected in infringement of IP rights, their customs clearance is suspended for 10 business days and the rights holder is notified.

The term of resolving such seizure and preventive measures depends on the duration of a court action. If the infringement issue has been settled between the parties amicably by way of negotiations, the term for resolving seizure and preventive measures can last within the general terms for suspension of goods at customs, which are as follows:

- If the rights of the trade mark holder are infringed, the rights holder has the right to notify customs within the abovementioned 10 days about filing a lawsuit to court for protection of its rights or to send a solicitation regarding an extension of the suspension term to customs. In this case, suspension can be extended but for no more than 10 business days.
- In a case where the rights holder files ruling of the court about the preliminary injunction or decision of another competent authority to the customs authority, the suspension can be extended for the term set in such ruling or decision.
- In case of filing a lawsuit, the term for review of such case in court is approximately nine months, including the conducting of the expertise.

It is important to note that border control measures are not taken with regard to the original goods.

There is no mechanism for control of services importation at the customs border of Ukraine.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

In accordance with the Trade Mark Law, a well-known mark protected under the Paris Convention is protected in the same way as if the mark was filed for registration in Ukraine on the date from which the mark is recognised as a well-known mark.

A trade mark may be recognised as well known by a decision of the Board of Appeals or as a result of a court proceeding.

In some cases, it is applicable to enforce an unregistered trade mark based on unfair competition legislation.

In cases where a company name that is used in Ukraine is identical to an unregistered trade mark, enforcement is also available.

### 15.2 To what extent does a company name offer protection from use by a third party?

In accordance with the Civil Code of Ukraine, legal protection is given to a commercial name if it allows the entity to be distinguished from others and does not mislead consumers about their activity.

The IP right to a commercial name arises from its first use.

The owner of a commercial name is entitled to:

- use the commercial name; and
- prevent others from using the commercial name, including the prohibition of such use.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Ukrainian legislation prescribes that the original titles of books and films are protected as copyright works. Therefore, it is possible to use a copyright as an additional option to rights protection (e.g. unlawful use of the trade mark that is identical to the relevant book or film title).

## 16 Domain Names

### 16.1 Who can own a domain name?

Any natural or legal entity is entitled to own a domain name. There is an exception for the top-level domain “.ua”, which is only available to the owner of a trade mark protected in Ukraine (word or combined) or its licensee (the licence agreement should be registered with the UANIPIO).

### 16.2 How is a domain name registered?

For registration of a domain name, it is necessary to contact the domain registrar and pay the respective fee.

With regard to the top-level domain “.ua”, the registrant should also provide the trade mark certificate or a licence agreement registered with the UANIPIO.

### 16.3 What protection does a domain name afford *per se*?

The domain name owner is entitled to:

- use the domain name within the allocation period; and
- transfer the rights to the domain name to another person.

A third party has a right to initiate a lawsuit against the domain owner in cases where the domain name is identical or confusingly similar to the registered trade mark.

### 16.4 What types of country code top-level domain names (ccTLDs) are available in your jurisdiction?

In Ukraine, “.ua” is available.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Since March 2019, the Ukrainian ccTLD “.ua” can be subject to alternative dispute resolution through the WIPO Arbitration and Mediation Center according to the .UA Policy. It is

sufficient for the complainant to prove that either registration or use of the domain name is in bad faith. The same has also recently become applicable to the following third-level domain name registrations: “.com.ua”; “.kyiv.ua”; and “.kiev.ua”, etc.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

Significant developments in relation to trade marks in the last year include the following:

1. Updated fees for actions related to the protection of rights to IP objects:

On September 6, 2023, Resolution No. 859 of the Cabinet of Ministers of Ukraine dated August 15, 2023 “On Amendments to the Procedure for Paying Fees for Actions Related to the Protection of Intellectual Property Rights” entered into force. It provides for, in particular: new types of fees related to conducting information searches, restoration of rights by applicants and rights holders, etc.; changing the wording of types of fees in accordance with the new terminology; and an increase in benefits from the payment of fees for trade mark applications in electronic form via online filing systems.

2. The Law of Ukraine “On Amendments to Certain Legislative Acts of Ukraine on Legal Protection of Intellectual Property” No. 2974-IX:

This new law entered into force on April 15, 2023 and has implemented into national legislation one of the basic acts on the protection of IP rights in the EU – Directive No. 2004/48.

Among the changes is the possibility of using a one-time payment instead of other methods of protecting IP rights. This is possible provided that the violation occurred unintentionally and without negligence, while the use of protection methods is disproportionate to the damage caused to the rights holder. At the same time, the minimum amount of such one-time payment should not be less than the cost of the licence for the use of the corresponding IP object.

In addition, the law regulates the court procedure for establishing the amount of reimbursement and compensation, which the court will apply instead of compensation of losses. The reimbursement will be determined taking into account the lost profit or income, and compensation will be determined taking into account the scope of the violation, the fault of the violator and other circumstances of significant importance.

According to the provisions of the new law, the violator will now cover all costs associated with the removal of counterfeit goods from civilian circulation and the destruction of materials and equipment used during their production.

3. Update to the .UA Policy: new third-level domains:

The .UA Registry has adopted the “Decision on the Peculiarities of Application of the .UA Domain Name Dispute Resolution Policy and the Rules for .UA Domain Name Dispute Resolution Policy under the Martial Law Regime”.

In accordance with the Decision, the reinstatement of .UA proceedings is accompanied by procedural safeguards, mainly the possibility of extending deadlines under the .UA Policy and Rules.

As of February 1, 2024, the .UA Policy will be applicable to new third-level domain name registrations in the

following public domains: .CN.UA; .CHERNIHIV.UA; .CHERNIGOV.UA; .CV.UA; .CHERNIVTSI.UA; .CHERNOVTSY.UA; .LT.UA; .LUTSK.UA; .KR.UA; .KROPYVNYTSKYI.UA; .KIROVOGRAD.UA; .TE.UA; .TERNOPIL.UA; .UZHHOROD.UA; .VN.UA; .VINNYTSIA.UA; .VINNICA.UA; .VOLYN.UA; .ZAKARPATIA.UA; .ZT.UA; .ZHYTOMYR.UA; and .ZHITOMIR.UA.

The Administrator of the public domain .UA (Hostmaster Ltd.) will have the authority to further decide to extend the .UA Policy to other third-level domain name registrations in the ccTLD .UA with the subsequent introduction of changes to the .UA Policy, the .UA Rules and the Supplemental Rules to third-level domain name registrations in consensus with the WIPO Center. The WIPO Center as the service provider will be notified about the respective amendment of the applicability of the .UA Policy. A mandatory administrative proceeding (under Paragraph 4 of the .UA Policy) will be conducted according to the Rules for .UA Domain Name Dispute Resolution Policy and the WIPO Supplemental Rules for .UA Domain Name Dispute Resolution Policy.

4. WIPO establishes Memorandums of Understanding with the Supreme Court of Ukraine:

The gathering of international judges at the 2023 WIPO Intellectual Property Judges Forum provided an opportunity for WIPO to strengthen its cooperation frameworks. On November 14, 2023, in Geneva, WIPO Director General Daren Tang counter-signed two Memorandums of Understanding (MoUs), initially signed by Stanislav Kravchenko, President of the Supreme Court of Ukraine. The MoUs aim to promote cooperation and joint activities, including the development of targeted capacity-building programmes for the judiciary of Ukraine and the dissemination of leading Ukrainian judgments in the field of IP through WIPO Lex-Judgments. Thus, Ukraine became the 35<sup>th</sup> country whose court decisions will appear in the international IP database.

WIPO will provide the Supreme Court of Ukraine access to a web interface for entering court decisions and relevant information into the database. This will allow Ukrainian judges to familiarise themselves with foreign practice, and similar actions will take place with the practice of Ukrainian courts since the Supreme Court of Ukraine will be able to select the decisions to be added into the database, such as final decisions, cited decisions in other cases and precedent decisions. Ukrainian judicial practice will become more open to foreigners, which is important given the movement of Ukraine towards the EU.

5. The European Union Intellectual Property Office (EUIPO) establishes MoUs with the UANIPIO:

The agreement was signed in Geneva by Andrea Di Carlo, EUIPO Deputy Executive Director, and Olena Orliuk, UANIPIO Director, while attending the 64<sup>th</sup> series of meetings of the assemblies of WIPO Member States in July 2023. The MoU’s primary focus is to strengthen Ukraine’s IP system and bolster its institutional capacity to the benefit of businesses and citizens in Ukraine and the EU. Additionally, in light of Ukraine’s status as an EU candidate country, the MoU also represents a significant milestone in its journey towards closer integration into the EU Single Market.

From now on, the UANIPIO can benefit from management and examiner tools, harmonisation of trade mark and design registration and examination practices, as well as staff training opportunities and cooperation.

The MoU also includes enforcement-related activities, such as the mutual exchange of information on IP economic-related studies, enforcement or anti-scam. In addition, it paves the way for the integration of Ukraine's trade mark and design data within the EUIPO's trade mark databases, such as TMview and TMclass.

6. Updated Law "On Copyright and Related Rights": This new law entered into force on January 1, 2023 and improves the legal regulation of issues related to the exercise and protection of personal non-property and property rights of subjects of copyright and related rights. It has harmonised the provisions of the Civil Code of Ukraine and the Law "On Copyright and Related Rights" with EU legislation related to ensuring reliable legal protection of copyright and related rights, especially regarding protection in the digital world, eliminated the gaps in the current legislation, and improved the current legislation in terms of solving issues that arise in practice and are related to the implementation and protection of copyright and related rights. Among the changes is the increase of the penalty for copyright violations. Now, illegal use of an object of IP rights or other intentional violation of IP rights protected by law entails the imposition of a fine with the confiscation of illegally manufactured products and equipment and materials intended for their manufacture.

#### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

- Supreme Court Resolution dated November 9, 2023 in Case No. 910/3022/22 – *Oschadbank*: In view of the adversarial principle, it is the plaintiff who claims that the defendant's unlawful use of the trade mark caused the plaintiff losses in the form of lost profits that is obliged to prove by appropriate and admissible evidence the reality of receiving benefits in the form of income from the payment of licence fees and the amount of this income, whereas the court's duty is to clarify the factual circumstances of the case, which are within the scope of proof.
- Supreme Court Resolution dated November 30, 2023 in Case No. 910/10906/22 – *Space Exploration Technologies Corp.*: In this case of early termination of a trade mark on the grounds of non-use, the Supreme Court found that any interested party may file a claim for early termination of a trade mark, as the law does not set out any qualifying requirements for a person filing such a claim. However, it is obvious that the person filing such a claim must at least have an interest. Therefore, the subject matter of the court's consideration in such cases should include not only the circumstances of use/non-use of the trade mark, but also the circumstances confirming the interest of the person filing the claim for early termination of the trade mark. Another conclusion of the court is that the condition for the proper use of a registered trade mark is its use by the trade mark owner in relation to each of the services for which the trade mark is registered, and not the use of the trade mark in general.

#### 17.3 Are there any significant developments expected in the next year?

Significant developments that are expected include the following:

1. Adoption of the new "Rules on drafting, filing a trade mark application, application for international trademark

registration and conducting an examination of a trade mark application, international trademark registration with extension to Ukraine" is expected.

These Rules were developed with the aim of harmonising the registration procedure with the Laws of Ukraine "On Amendments to Certain Laws of Ukraine Regarding the Creation of a National Intellectual Property Authority" and "On Amendments to Certain Legislative Acts of Ukraine Regarding Strengthening Protection and Protection of Rights to Trademarks and Industrial Designs and Combating Patent Abuse" dated July 21, 2020 No. 815-IX, as well as with the Singapore Treaty on the Law of Trademarks, which has been in force in Ukraine since May 24, 2010.

The adoption of these new Rules will also establish the provisions related to the specifics of submitting international applications for the registration of marks and the specifics of performing other procedures provided for by the Protocol to the Madrid Agreement.

2. Adoption of the new Regulations of the Appeals Chamber of the UANIPIO is expected.

These Regulations were developed for the purpose of determining the powers of the Appeals Chamber, the Chamber's procedure for consideration of oppositions against decisions of the UANIPIO regarding obtaining rights to IP objects, claims for the invalidation of rights to IP objects, applications for recognition of a trade mark as well known in Ukraine, and the resolution of other issues within its competence.

Adopting these Regulations will resume the suspended work of the state authority and improve its activities, in terms of simplifying the procedure for considering oppositions in the Appeals Chamber and determining the deadline for UANIPIO approval of Appeals Chamber decisions.

3. The prospect of creating and launching the High Court on Intellectual Property (IP Court) has become more certain as the High Council of Justice has appointed 16 new members of the High Qualification Commission of Judges of Ukraine, permitting the body, which has not worked in Ukraine since 2019, to resume work on the creation of the IP Court.

The High Qualification Commission of Judges announced plans to resume competitions for the positions of judges of the IP Court and its Appeals Chamber.

The creation of an IP Court will be an important step to reforming the judicial system, will help solve many issues in the field of IP rights protection, will ensure guaranteed qualified legal protection of rights holders in relation to objects of industrial property, copyright and related rights, and will improve the business climate and increase the investment attractiveness of those sectors of the economy in which the protection of IP rights plays a crucial role.

4. Several changes are expected to be made to the Law "On Protection of Interests of Persons in the Sphere of Intellectual Property during Martial Law", according to which the deadlines (terms) for actions related to the protection of IP rights were suspended last year.

As indicated in the draft law, the term for a person submitting an opposition against a trade mark application, to appeal the UANIPIO decision to the Appeals Chamber, will be excluded from the list of suspended deadlines. This means the person submitting an opposition against a trade mark application will have the right to appeal the UANIPIO decision to the Appeals Chamber within two months from the date of receipt of a copy of the decision sent to such a person.

The adoption of this legal provision will restore the balance of the interests of the state and the applicants/rights holders.

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

The following trends have become apparent:

1. In connection with the Russian Federation's military aggression against Ukraine, the UANIPIO provided an explanation regarding the mechanism of refusal to represent the interests of persons associated with the aggressor country. It was recommended by the UANIPIO that persons who want to refuse to represent the interests of persons connected with Russia should submit a corresponding notice to the IP Office. Payment of a fee for submitting such a notice is not required. Based on the results of the review of the request, information about the representative and the address for correspondence will be deleted from the object's bibliographic data (replaced with "0000").
2. The UANIPIO provided clarification regarding the waiver of the right to appeal a UANIPIO final decision on a trade mark application to the Appeals Chamber from a person submitting an opposition against its registration. Since the term for a person submitting an opposition against a trade mark application and to appeal the UANIPIO decision to the Appeals Chamber is suspended during Martial Law, trade mark registration certificates are currently not being issued even if the opposition is dismissed. Thus, a lot of trade marks approved for registration have not yet obtained protection. In order to overcome such obstacle and to obtain a certificate of registration, it is recommended to obtain a letter of consent from the person submitting an opposition against the trade mark application based on the earlier registered trade mark or other prior right indicating that such person does not want to file an appeal to the Appeals Chamber.





**Oleg Zhukhevych** is an experienced trade mark and design attorney, attorney-at-law with in-depth experience and a proven track record in intellectual property. Being involved in IP practice for over 18 years, Oleg has gained extensive experience in complex matters ranging from obtaining 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, ICANN domain name dispute resolution procedures and administrative proceedings before appeal bodies of the National Intellectual Property Authority in Ukraine. Oleg is equally an expert in trade mark, patent and copyright litigation covering infringement proceedings, validity and establishment of ownership proceedings as well as recognition of trade marks as well known in Ukraine.

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ADVANCE PARTNERS is a Ukrainian IP law firm focusing on enforcement, protection and management of IP rights, including trade marks, patents, industrial designs and copyrights, and also practising competition law, corporate and commercial law, as well as data protection and dispute resolution. Our team of attorneys provides a whole range of IP services to local and international clients, including multinational corporations, privately owned companies, start-ups, and individuals. We manage IP right portfolios both for our Ukrainian clients worldwide and for international clients in Ukraine. By combining proficiency with a strong international network, our firm is well placed to handle complex cross-border matters with a high degree of speed and flexibility.

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