



The Trademark Prosecution Review

2025

**Ukraine: navigating the examination
and registration framework before the
UANIPPO**

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The second edition of the *WTR Trademark Prosecution Review* takes a wide-ranging view of best strategies for securing trademarks in the key regions of the Americas, the Asia-Pacific, and Europe, the Middle East and Africa. The review combines on-the-ground knowledge and analytic insight to offer an unparalleled deep dive into the prosecution landscape in specific key markets.

Generated: October 16, 2024

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Ukraine: navigating the examination and registration framework before the UANIPIO

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IN SUMMARY

This article describes procedures for registering trademarks in Ukraine, including the application, registration, opposition, appeals and cancellation procedures. The requirements for proof of use are outlined. Enforcement of trademark rights and customs surveillance procedures against infringement are also covered. The article also describes ownership changes, licensing and online domain disputes.

DISCUSSION POINTS

- Requirements and criteria for registration of trademarks
 - Overview of the application, UANIPIO examination, oppositions, appeals, publication and registration
 - Use requirements and non-use revocation
 - Enforcement and remedies
 - Customs surveillance
 - Domain name disputes
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REFERENCED IN THIS ARTICLE

- Ukrainian National Office for Intellectual Property and Innovations (UANIPIO)
 - Appeals Chamber of UANIPIO
 - Civil Code of Ukraine
 - Criminal Code of Ukraine
 - Trademark Law
 - UA Domain Name Dispute Resolution Policy (the .UA Policy)
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FIVE KEY NEED-TO-KNOWS

1. A trademark application undergoes two stages of examination – formal and substantive. The claimed designation is examined on both absolute and relative grounds at the substantive examination stage.
2. Ukraine is a first-to-file country.
3. Three-month period for filing an opposition against the application from the date of its publication applies to any interested parties who may rely on any grounds for refusal to grant legal protection.
4. Trademarks must be put in use within five years from the date of registration; otherwise, they may be revoked in court proceedings at the request of an interested party.
5. Commercial names are protected from later trademarks if they were used before the trademark filing date.

LEGAL FRAMEWORK

National Law

The main trademark laws are:

- Civil Code of Ukraine;
- Law of Ukraine 'On Protection of Rights to Marks for Goods and Services' (Trademark Law); and
- Rules on Drafting, Filing, and Consideration of Trademark Applications.

International Treaties

Ukraine is also a party to these international treaties:

- Paris Convention for the Protection of Industrial Property;
- Madrid Agreement Concerning the International Registration of Marks;
- Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks;
- Vienna Classification;
- Nairobi Treaty on the Protection of the Olympic Symbol;
- Protocol Relating to the Madrid Agreement;
- Trademark Law Treaty;
- Singapore Treaty on the Law of Trademarks; and
- EU–Ukraine Association Agreement.

Unregistered Marks

According to the Trademark Law, unregistered marks do not enjoy legal protection.

A trademark in use without registration is protected against a newly registered trademark through acquisition of the rights of the prior user, if the priority of use of such unregistered trademark is proved.

A well-known trademark, regardless of whether it is registered in Ukraine or not, acquires protection under article 6-bis of the Paris Convention upon recognition of the trademark as well-known by the Appeals Chamber of UANIPIO or a court.

In some cases, unregistered marks and commercial designations may be protected under the Law of Ukraine 'On Protection Against Unfair Competition' if there is ongoing competition between the marks on the market.

Also, trade (commercial) names may obtain legal protection by virtue of their use, subject to the requirements set out in the Civil Code of Ukraine.

Registered Marks

An application for trademark registration may be filed by an individual or legal entity, or by joint applicants residing in Ukraine or abroad. According to the Trademark Law, residents of Ukraine may file trademark applications by themselves or through a representative. Foreign

applicants residing outside Ukraine must be represented by trademark attorneys admitted to represent foreign applicants before UANIPIO.

Any sign or combination of signs may be the subject of a trademark, 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.

Legal protection is granted to a trademark that does not contradict public policy and meets the requirements for registration under the Trademark Law, which includes both absolute and relative grounds for refusal.

Signs are not registrable if, inter alia, they:

- are usually devoid of distinctive character and have not acquired distinctiveness through use;
- consist exclusively of signs that are generally used in language or in fair and constant trade practices on goods and services;
- consist exclusively of signs or data that are descriptive;
- can be misleading as to the nature of the goods or services, or as to the person manufacturing the goods or rendering the services;
- can be confused or, in particular, may be associated with trademarks that were registered or filed earlier in Ukraine, trade names that are known in Ukraine and belong to other persons who have acquired the right to said names before the filing date for identical or similar goods and services; or
- reproduce registered industrial designs, or 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, and names, pseudonyms, portraits and facsimiles of persons known in Ukraine, without their consent.

A colour or combination of colours, sound and three-dimensional marks may be registered as a trademark, provided that such signs are suitable to distinguish the goods or services of one person from the goods or services 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.

To register such marks, the following requirements should be fulfilled.

- Colour per se: as a rule, such signs do not have distinctiveness, but may be eligible for protection if the evidence is provided that the sign has acquired distinctiveness. A verbal description of the colours must be submitted with the application for registration of a trademark as a colour or combination of colours. The application may also include a description of how the colour or combination of colours is applied in connection with the claimed goods or services and examples of such use.
- Sound marks translated into musical notes, particularly in the form of a chord, musical work (or fragment), are acceptable for registration. To register a sound mark, a musical notation of sounds 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.

- Three-dimensional marks cannot repeat the appearance of a known object, but must have an original appearance and their shape should not be determined solely by their functional purpose.

PROCEDURES

A trademark application undergoes two stages of examination – formal and substantive.

Formal Examination

The UANIPIO checks whether the filed application corresponds to the formal requirements; in particular, the claimed list of goods or services is examined for compliance with the NCL. In the case of any inaccuracies with the claimed wording, the examiner issues the office action. The statutory time limit for responding is two months.

The UANIPIO publishes the information on the filed application after reviewing whether it corresponds to the formal requirements and whether the official filing fee is paid.

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

Substantive Examination

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 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 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 trademark.

Based on the granting decision, and provided that the registration fees are paid, a trademark certificate is issued and information about the registered trademark is published.

In the case of a smooth registration process, the registration of a trademark takes 18 months.

An opposition may be filed within three months after the application is published. Filing the opposition is subject to payment of the official fee. Trademark application may be opposed on the absolute and relative grounds.

The UANIPIO sends a copy of the opposition to the applicant. The applicant has two months to submit the response to the opposition. No cooling off period is available.

The applicant may decline the opposition and leave the application unchanged, make amendments to the application or withdraw it.

The filed opposition is considered by the UANIPIO's at the stage of the substantive examination. The results of the opposition's consideration are presented in the UANIPIO decision. A copy of such a decision is sent to all participants of the appeal procedure.

If the UANIPIO's final decision is deemed unfavourable by the opposer, such a decision can be appealed to the Appeals Chamber. The Appeals Chamber's decision may be appealed to the court within two months from the receipt date of the decision.

The applicant may appeal against the decision of the UANIPIO to the Appeals Chamber or to the court within two months from the date of receipt of such decision. The applicants usually appeal unfavourable decisions when the UANIPIO refuses to register a trademark or grants legal protection to part of the claimed goods or services.

Meanwhile, per the Trademark Law, a person who has filed an opposition against granting protection to a third party's trademark may also appeal the final decision of the UANIPIO regarding the opposed mark to the Appeals Chamber within two months. Usually, such a decision is appealed when the UANIPIO grants protection to the opposed mark of a third party in contrast with the opposer's goal to prevent registration of such a mark.

If the Appeals Chamber receives the appeal, the examination of the trademark application shall be suspended until the decision of the Appeals Chamber is issued. Furthermore, the Appeals Chamber's decision may be further challenged by the opposer in court within two months.

The trademark registration is valid for 10 years from the filing date. The registration may be renewed for the next period of 10 years provided that the renewal fee is paid and the renewal request was filed with the UANIPIO within the last six months of the validity of the registration. The Trademark Law also provides the option of renewal the trademark during the grace period that comprises six months after expiration of the trademark validity.

The owner of a registered trademark may withdraw from the registration in whole or in part by filing an appropriate request with the UANIPIO. The withdrawal shall take effect from the publication date of the information in the Official Bulletin.

A trademark registration shall be deemed abandoned and its validity shall be terminated in the case of non-payment of the renewal fee.

Use

There is no requirement for use prior to trademark registration.

Proof of use is not required for trademark registrations and renewal purposes.

The use of a registered trademark is mandatory. Non-use may result in revocation of the trademark registration (ie, the trademark registration becomes vulnerable to revocation due to non-use after five years from the publication date).

The use of the mark is carried out by the trademark owner or by the licensee or any other person under the control of the trademark owner. The proper use of a trademark is putting it on any product for which the trademark is registered, the packaging containing the product, a sign associated with it, a label, a bar, a tag or other object attached to the product, storing such product with the said mark for the purpose of offering it for sale; offering for sale, selling, importing, exporting; using the mark when offering and providing any service for which the trademark is registered; using the mark in business documentation or in advertising and on the internet.

A trademark is deemed to be used if it is applied in the same form as the registered trademark, as well as in a form that differs from the registered trademark only in certain elements, if this does not change the distinctiveness of the trademark.

If a registered mark is not used without valid reasons, its registration may be revoked in part or in full. Any interested person may file a claim with the court for early termination of the registration of a mark because the mark has not been used for five years preceding the date of filing the claim. The evidence provided by the trademark owner that the non-use was caused by circumstances beyond the owner's control may be considered when making a court decision. The burden of proof of trademark use is borne by the trademark owner.

ASSIGNMENT AND RECORDATION

A trademark owner may transfer its trademark rights through an assignment agreement.

The assignment agreement shall be registered with the UANIPIO. The effective date of the assignment agreement is the date of its registration.

Both the assignor and the assignee are entitled to file a trademark assignment registration request with UANIPIO. If the trademark is assigned to a non-resident of Ukraine, the trademark assignment agreement shall be registered through a local trademark attorney. An official fee is paid for the registration of a trademark assignment agreement.

To register the trademark assignment, it is necessary to submit to the UAPTO the trademark assignment agreement or a notarised extract from such agreement, a power of attorney (if necessary) and a document on payment of the fee.

Registering the trademark assignment is not allowed if it may lead to misleading consumers regarding goods and services or the person who produces goods or provides services.

Licensing

A trademark owner may grant an exclusive or non-exclusive licence to use a registered trademark.

The subject of a licence agreement may be only a registered trademark, not an application for such a trademark. The licence agreement is not subject to mandatory registration. The parties may register the licence agreement with the UANIPIO.

The licence agreement must include a provision that the quality of goods or services produced or provided under the licence agreement will not be lower than the quality of goods and services provided by the trademark owner. The trademark owner controls the fulfilment of this provision.

Enforcement

Registration of a trademark confers exclusive IP rights.

Civil Remedies:

Owners of registered trademarks may request the following remedies in a civil action:

- injunction;
- cessation of the acts that infringe trademark rights;
- award of damages or compensation or moral damage;

- confiscation of infringing products and devices for their manufacture; and
- destruction of infringing articles or removal of the illegally used mark from articles and packaging.

The amount of damages shall be determined by the court, taking into account the lost profits or income received by the infringer because of the infringement of the trademark rights.

The amount of compensation shall be determined by the court depending on the scope of the infringement, the fault of the infringer and other circumstances of material importance. In this case, the amount of compensation cannot be less than the amount of remuneration that would have been paid for granting permission to use the trademark in dispute. If the infringement of the trademark 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.

Recovery of compensation is applied by the court instead of damages at the discretion of the trademark owner.

The statute of limitations for filing a claim is three years from the date when the claimant learned or should have learned of the infringement. The missed limitation period may be restored provided that the plaintiff confirms the validity of the reason for the inability to file a claim within the prescribed period.

Criminal And Administrative Penalties

Infringement may be considered an administrative or criminal offense (if on a large scale).

According to the Criminal Code of Ukraine, trademark infringement is a crime if it caused significant damage. Criminal proceedings may be initiated if a certain threshold of damage is met. Damage is considered significant if it is 20 times the tax-free minimum income.

Cases on trademark infringement are private prosecution cases and can be initiated only on the basis of a complaint by the trademark owner or their representative in Ukraine who has information about a criminal offense, or a victim of a crime committed as a result of actions infringing trademark rights.

The police cannot act *ex officio* in cases of trademark infringement. However, the police may conduct searches based on a complaint from the right holder and documents collected. A court order is required to conduct a specific investigative action.

CUSTOMS SURVEILLANCE

Ukraine provides a mechanism to combat the movement of counterfeit goods across the border through the Customs Register of Intellectual Property Rights.

Such a mechanism for seizing goods and preventing infringements includes the risk management system of the Customs Register of Ukraine, which allows for the inspection of imported goods per the information recorded with the Customs Register of Ukraine, as well as through visual inspection of goods by customs officers.

In such a case, if the Customs Register indicates that the goods are suspected of infringing intellectual property rights, their customs clearance is suspended for 10 business days and the trademark owner is notified.

The time frame for resolving the issue of such suspension depends on the court proceedings. If the issue of infringement is settled amicably by the parties through negotiations, the term for resolving the issue of interim measures may last within the general terms for suspending customs clearance of goods, which are as follows.

- The owner has the right to notify the customs within 10 days of applying to the court or to submit a request to the customs for an extension of the suspension period (which may be extended for another 10 days).
- If the owner submits a court ruling on a preliminary injunction to the customs authority, the suspension may be extended for the period specified in such ruling.
- If a lawsuit is filed, the timeframe for consideration of such a court case is three to six months.

The seizure of infringing goods at the border by the customs authorities is possible upon the court decision.

Additionally, the suspended goods can be destroyed at the border, subject to the consent of the owner of a shipment, or without such consent after 10 days from the customs notification on suspension. The trademark owner shall bare all expenses related to the destruction unless the shipment owner and the trademark owner agree on the contrary.

It is important to note that border control measures do not apply to original goods.

DOMAIN NAMES

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 trademark protected in Ukraine (word or combined) or its licensee (the licence agreement should be registered with the UANIPIO).

Since March 2019, the Ukrainian country code top-level domain '.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.



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