

Practical guide to registering Trademarks (TMs) in Ukraine

Ukraine is one of the members of the World Intellectual Property Organization (WIPO), and has ratified major international treaties in the field of Intellectual Property (IP) that are in effect in Ukraine. The status of IP rights in Ukraine is similar to that of EU countries.

In Ukraine, the legal protection of IP rights can be confirmed by TM certificates. They prevent labels from being misused and act as an indicator of the origin and quality of goods and services. TM certificates are registered by the State Enterprise “Ukrainian Institute of Intellectual Property” (Ukrpatent). The procedure for obtaining a TM certificate are briefly described below

I. Description of the procedure of registration

Preparation stage

If you want to expand your business into Ukraine, we recommend you register your IP assets in country. To save time and money, you should make a preliminary preparation before filing an application for a TM registration to Ukrpatent. For this you must define the class of goods of your future TM . Every class includes a definite list of goods and services that will protected. Classes are determined according to The Nice Agreement, which establishes a classification of goods and services for the purposes of a TM registration (the Nice Classification).

Ukrpatent’s website contains different databases, one of which is the Database of registered TMs (TM Register). It gives the possibility to examine Ukrainian-registered using different search criteria.

Initially, we recommend you carefully investigate and analyze the TM Register. If the same TM has already been registered, it may be an obstacle to register your TM in the future.

Also, it is important to determine the type of TM. For example, a TM can be registered as “word mark”, “figurative mark” (logo), “combined mark” (it includes word and figure elements) or as “volume mark” (3D mark). The type of TM is important for the scope of the TM’s legal protection .

Filing of the application and payment of service fee

In Ukraine, an application for TM registration on behalf of foreign entities has to be filed by a patent attorney – a certified person who is authorized to represent client interests before Ukrpatent. In particular, an application must contain an image of the proposed TM and a list of goods and services according to the Nice Classification.

Ukrpatent assigns a special number for every application. During the procedure of a TM registration, this number will be used as an application ID.

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The State fee for the filing of the application is UAH 1 000 (about USD 36). The amount of the state fee depends on the nature of the TM and additional costs may be payable, such as:

- UAH 1 000 (about USD 36) for each class of goods;
- UAH 500 (about USD 18) for a colour TM.

After filing of the application and payment of the applicable fee, Ukrpatent will check the submitted documents and make the Decision on the establishment of the date of filing of the application. This stage is very important, as the protection of a TM's IP rights will start on this date.

In fact, Ukrpatent's Decision on the establishment of the date of filing can take from 2 weeks to 2 months from the date of filing of the application.

Examination of the application

The process of examination of the application consists of two stages:

- 1) Formal Expert Examination,
- 2) Qualification Expert Examination.

The result of the Formal Expert Examination is Ukrpatent's Conclusion on the compliance of the application with the formal requirements. At this stage, Ukrpatent checks the correctness of documents, compliance with the list of documents and payments of the State fee. If Ukrpatent establishes that the application is filled, they will notify an applicant about the necessity to clarify or correct the application.

The Qualification Expert Examination is the most significant aspect of a TM registration. At this stage, Ukrpatent checks a TM for compliance with the applicable safety criteria specified by the Law. Ukrpatent may request additional information if the expert examination is impossible without such information, or in case of reasonable doubt as to the accuracy of any information, which is contained in the application materials. The applicant must provide the required additional information within 2 months from the date of receipt of Ukrpatent's notice.

This stage also involves Ukrpatent searching for any similarity with previously registered TMs and filed applications.

If the application for TM meets all the established criteria of protection (Annex 1), Ukrpatent will issue the Decision on Registration. The Decision on Registration of a TM shall be sent to the applicant.

Ukrainian Law doesn't provide clear time limits for both examinations. The period of examinations depends on the compliance of the application with all the requirements of the Law and timing of provision of additional information by the applicant if requested by Ukrpatent.

In practice, the average term of Formal Expert Examination is about 6 – 7 months from the date of filing an application, and the period of Qualification Expert Examination is about about 12 – 14 months from the date of filing an application.

Publication and issuance of a certificate of TM

Upon receipt of the Decision on Registration of the TM, the applicant has to pay two official fees:

- fee for publication of information on the issuance of a certificate in official Ukrpatent's official Bulletin – UAH 150 (about USD 5,5);
- fee for issuance of a certificate. The amount of this fee depends on the applicant: if an applicant is a Ukrainian resident, it needs to pay UAH 85 (about USD 3); if an applicant is non-resident of Ukraine, the fee is USD 200.

These fees need to be paid within 3 months from the date of receipt of the Decision on Registration of the TM by the applicant. If fees aren't be paid in time, Ukrpatent will not publish information in its official Bulletin and the application is considered withdrawn.

The publication on the issuance of a certificate is an official confirmation of completion of the procedure of TM registration.

Ukrpatent issues a certificate within a month of the TM registration, subject to the payment of the applicable fees.

II. Practical tips and important notes

Accelerated procedure

According to the Law, the period of TM registration can be shortened.

In general, the average term for a TM registration is from 14 to 18 months. However, if an applicant uses the accelerated procedure this term can be from 7 to 9 months.

The request for an accelerated procedure can be applied 3 months from the date of filing of an application. The applicant must file a petition to Ukrpatent and pay the fee to apply for this procedure.

Fees depend on the type of TM:

- for a "word mark" and a "figurative mark" the fee is UAH 5 832 (about USD 212) per TM;
- for a "combined mark" the fee is UAH 10 536 (about USD 383) per TM.

Objection against a TM registration

Any person may file with Ukrpatent an objection against an application for a TM registration. The objection can be filed not later than 5 days before the Decision on Registration of the TM.

According to the Law this procedure involves only two steps:

- submission of objection by the plaintiff, and
- submission of counter-objection by the TM applicant.

However, Ukrainian Law does not limit the provision of so-called additional explanations/arguments.

As such, both parties (plaintiff and applicant) have the right to repeatedly submit to Ukrpatent new arguments. Furthermore, consideration of an objection takes place at the stage of Qualification Expert Examination without the participation of the parties. This means that the results of consideration of the objection will be known only after the completion of the TM registration procedure – i.e. the TM is registered (unsuccessful objection) or the TM is not registered (successful objection).

Finally, an applicant has the right to appeal a refusal or previous refusal of a TM registration at the Appeal Chamber of Ukrpatent. If such an appeal is unsuccessful then the applicant can appeal the decision in court. However, a plaintiff may only appeal a TM registration by Ukrpatent in court.

An objection can be submitted against any application so we recommend applicants always monitor their registration process.

Control and monitoring of registration procedure

Ukrpatent's website provides the ability to search for information according to different criteria. For example, it is possible to search for information by TM name, applicant name, or application number. Also, Ukrpatent's databases contain information about fees, decisions which were made by Ukrpatent and documents which were filed by an applicant. As such, applicants can remain informed about the status of their application or the existence of conflicting registrations by third parties.

However, please note that Ukrpatent's databases are only informational in nature. In some cases information can be out-of-date by a few weeks and additional crosschecking through other sources is also recommended. Nonetheless, Ukrpatent's databases are a useful monitoring tool. Taking into account the length of the TM registration procedure and its complexities, we recommend you proactively monitor your registrations. In particular, we provide our clients with regular tabulated updates of information regarding their TM applications, as well as a chronological history of all procedures relevant to them. This allows you to take corrective measures should they become necessary.

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Annex 1. Criteria of TM protection

Legal protection will not be granted for marks that:

- contain the following elements:
 - pornography,
 - anti-State, racist slogans,
 - emblems, names of extremist organizations,
 - obscene words and expressions;
- represent or imitate:
 - State armorial bearings, flags, other State emblems or State symbols,
 - official names of States,
 - emblems and abbreviated or full names of international intergovernmental organisations,
 - official signs and hallmarks indicating control and warranty, assay marks or seals,
 - awards and other distinctions of honour;
- are identical or misleadingly similar to such an extent that they can be confused with:
 - marks that were previously registered or filed for registration in Ukraine on behalf of another person for identical or similar goods and services;
 - marks of other persons if those marks are protected without registration according to international agreements to which Ukraine is a party – in particular, marks recognized as well-known marks;
 - trade names that are known in Ukraine and belong to other persons that acquired the right to those names before the date of filing of the application with respect to identical or similar goods and services; or
 - qualified indications of the origin of goods.
- if they reproduce:
 - industrial designs, the rights to which belong to other persons;
 - titles of scientific, literary and artistic works known in Ukraine or quotations and characters from such works, as well as artistic works and fragments of artistic works, without the consent of the copyright holders or their legal successors; or
 - surnames, first names, pseudonyms and their derivatives, portraits and facsimiles of persons known in Ukraine, without their consent.
- are usually devoid of any distinctive character and have not obtained such character as a result of their use;
- consist exclusively of signs that are commonly used as the signs of goods and services of a certain kind;
- consist exclusively of signs or data that are descriptive when used for goods and services defined in the application or with respect to them, in particular signs or data that indicate kind, quality, composition, quantity, properties, purposes, value or the place and time of manufacturing or the sale of goods or rendering of services;

- are deceptive or liable to mislead as to goods, services or the person that produces a good or renders a service;
- consist exclusively of signs that constitute commonly used symbols and terms; or
- solely reflect a form caused by the natural state of goods or by the need to obtain a specific technical result, or a form that imparts a significant value to a good.