



Trademarks

in 51 jurisdictions worldwide

Contributing editors: Stuart Sinder
and Michelle Mancino Marsh

2011



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Ukraine

Dariya Valiavska

Sayenko Kharenko

1 Ownership of marks

Who may apply?

Any individual or legal entity may apply for registration of a trademark in Ukraine. Foreign individuals and legal entities have the same rights under the laws of Ukraine on trademarks as Ukrainian nationals, as provided under international treaties and the principle of reciprocity. However, if foreign individuals or legal entities are domiciled outside Ukraine, they shall act in Ukraine through their duly authorised patent agents.

2 Scope of trademark

What may and may not be protected and registered as a trademark?

Any words (including proper names), letters, numerals, descriptive elements, three-dimensional designs, colours and combinations of colours, or any combination thereof, may be protected as a trademark or a service mark. Moreover, sounds may also be protected if it is technically possible to register and publish them. In addition to trademarks, label designs may be registered as industrial designs.

A trademark shall not be registered if it is contrary to public policy, principles of humanity and morality or if there are any grounds for refusal of registration stipulated in the respective laws. Nor shall a trademark be registered if it is of a nature such that it may deceive the public with regard to the goods or services, or the person that produces such goods or provides such services.

Refusal of registration of a trademark may be made for three broad reasons.

First, the designation can be refused if it depicts or imitates state coats of arms, flags, or other state symbols; official names of states or international organisations; official seals, awards, etc. Subject to the approval of the owner of the above-mentioned designation or the competent authority, such designations may be included in the elements of a trademark, but not granted protection thereunder.

Second, the designation can be refused if:

- it is devoid of any distinctive character;
- it consists of designations that have become customary for specific type of goods and services;
- it consists of designations that have a descriptive character in relation to the goods and services stated in the application and serve to identify, *inter alia*, the kind, quality, content, quantity, characteristics, intended purpose, value of goods and services, place and time of production or sale of goods or of rendering of services;
- it consists of generally used symbols and terms;
- it is of a shape that results from the nature of the goods themselves, or the shape of goods that is necessary to obtain a technical result; or
- it is of a shape that gives substantial value to the goods.

The designations mentioned in the list above may be included in the elements of a trademark if the latter does not consist exclusively of such designations.

Third, designations can be refused if they are identical or confusingly similar to names, pseudonyms and derivative words, facsimiles or portraits of persons who are well known in Ukraine without their consent; signs that have already been registered or have been applied for registration for the same or related kind of goods and services; signs that are protected without registration under the respective international treaties that Ukraine is a party to; trade names that are well known in Ukraine for the same or related goods and services, provided the owner of such trade names has obtained the right thereto prior to application for registration of a trademark by an adverse party; qualified indications of goods' origin (if the right to use such designations is properly obtained, they may be included in the elements of a trademark, but not granted the protection thereunder); duly registered certification marks; industrial designs the rights to which belong to other persons in Ukraine; names of well-known scientific, literary or artistic works or quotation and characters therefrom; or artistic works and fragments thereof without consent of copyright owners or their successors.

3 Common law trademarks

Can trademark rights be established without registration?

Certain signs (for instance, well-known trademarks pursuant to article 6bis of the Paris Convention on the Protection of Industrial Property) are protected regardless of registration in Ukraine under the international treaties that Ukraine is a party to, provided that trademarks are recognised as well known by the Appellate Board as defined by the Trademark Law of Ukraine or by decision of a court.

4 Registration time frame and cost

How long does it typically take, and how much does it typically cost, to obtain a trademark registration?

As a rule, it takes about 16 to 20 months to obtain a trademark registration. An expedited procedure, which will take approximately eight to 10 months, is available for additional fees.

The minimum official fees for registration of a black-and-white word trademark in a single class is about €290 for a non-resident and about €135 for a resident. (Any cost indicated hereinafter is in the euros of the cost in hryvnyas, and therefore may fluctuate in accordance with the respective currency rate). Additional official services provided by the respective authority will also affect the cost (eg, for including the word 'Ukraine' in a trademark, for including additional classes of goods and services, application for a trademark in colour, division of an application, and other actions initiated by an applicant or recommended by an expert). Moreover, a preliminary provisional refusal of trademark registration will also cause deviations from the average timings.

5 Classification system

What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed?

Ukraine is a party to the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks. Ukraine has used the ninth edition of the International Classification System since 1 January 2007.

6 Examination procedure

What procedure does the trademark office follow when determining whether to grant a registration? Are applications examined for potential conflicts with other trademarks? May applicants respond to rejections by the trademark office?

The Ukrainian Patent and Trademark Office (the UPTO) determines the application date (official filing receipt), then examines an application for formal requirements (formal examination), and, finally, analyses the designation per se (substantial examination). During the latter, the UPTO examines a designation set forth in the application for potential conflicts with other trademarks, and considers other grounds for registration. If the application does not satisfy respective conditions, the UPTO will send a prior conclusion to the applicant and will suggest submitting reasonable arguments within two months. This term, however, may be extended for an additional fee for two more months. The above-mentioned arguments will be considered by the UPTO in the course of preparation of its conclusion (granting a decision on trademark registration).

7 Use of a trademark and registration

Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? Are foreign registrations granted any rights of priority? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a third-party challenge on grounds of non-use?

Ukraine is a 'first-to-file' and not a 'first-to-use' jurisdiction. Thus the use of a trademark or a service mark shall not be claimed before registration, and therefore no proof thereof shall be submitted. In order to maintain the registration, the use of a trademark must begin no later than three years from the date of publication of information on issuance of a certificate. Otherwise, any person may ask the court for termination of the registration on the basis of any three-year non-use period within the effective term of trademark registration, provided there are no reasonable excuses for non-use.

An applicant has the right of priority to submit an application for the same mark in regard to all or particular goods and services within six months from the date of filing a primary application with the UPTO in Ukraine or any other competent authority in a state that is a party to the Paris Convention, provided no priority has been claimed in regard to primary application. Priority also may be claimed based on participation in the international exhibitions under the same trademark. See also question 2.

8 Appealing a denied application

Is there an appeal process if the application is denied?

Under the administrative appellate procedure, an applicant may challenge the validity of the decision of the UPTO via the Appellate Board within two months (this term may be extended for two more months if the respective fee is paid) from the receipt of the decision of the UPTO or of the materials that served the ground for the refusal of registration.

Under the judicial appellate procedure, the decision of the UPTO may be appealed within two months in the administrative courts.

However, this option is rarely used. As a rule, an applicant would appeal to the Appellate Board first, because this procedure takes less time, and then refer a dispute to the court with regard to the decision of the Appellate Board if an appeal is denied.

9 Third-party opposition

May a third party oppose registration, or seek cancellation of a trademark or service mark? What are the primary bases of such challenges, and what are the procedures?

Any person may oppose the registration of a trademark on the basis that it does not conform to the requirement of the laws. The procedure is the following: a third party shall submit its objection to the UPTO not later than five days prior to making the decision by the UPTO, which will send the objection in question to the applicant; applicant may respond to the objection within two months. The objection of a third party will be considered by the UPTO in the course of preparation of the decision.

Any person may seek cancellation of a trademark in the court on the following bases:

- registered sign discrepancy with the conditions of granting legal protection (see question 2);
- certain elements of the mark's image or list of goods and services were not included in the application; or
- issuance of the certificate on trademark registration violates the rights of a third party.

10 Duration and maintenance of registration

How long does a registration remain in effect and what is required to maintain a registration? Is use of the trademark required for its maintenance? If so, what proof of use is required?

Registration is valid for 10 years from the date of filing an application with the UPTO and may be extended each time for another 10 years upon the request of a holder of the certificate, provided a duty is paid. The owner of the rights to a trademark shall avoid non-use lasting for three consecutive years.

The following is deemed to be the use of a mark:

- application of a mark to any product for which the mark is registered, to the package that contains such goods, the signboard, label, ribbon, tag or other object attached to the product; labeling of goods that are stored with the mark for the purposes of offering for sale, offering of such goods for sale, sale, import and export;
- use of a mark in the course of offering and providing any service for which the mark is registered; or
- use of a mark in documentation or in advertisements and on the internet.

A mark is deemed to be used if it has been applied in the form of a registered mark, as well as in the form that is different from a registered mark in relation to separate elements, provided that it does not alter the distinctive character of a mark.

11 The benefits of registration

What are the benefits of registration?

The benefits of registration are the following:

- protection of a mark on the territory of Ukraine;
- availability of effective administrative enforcement mechanisms;
- standing in civil, administrative and commercial courts, courts of arbitration;
- increasing remedies for IP rights infringement;
- registration of a trademark with the State Customs Service;
- control of export and import activities in Ukraine, identification of grey market players;

- exclusion of other market players from using the same mark;
- assignment of rights or application of other trademark rights disposal mechanisms;
- possibility to apply for a ‘UA’ level domain name;
- possibility to form an authorised capital of a legal entity with the rights to a trademark;
- tax advantages; and
- creation of strong brand reputation to extend the Ukrainian market enabling customers to enjoy benefits from high quality goods and services provided under the trademark.

12 Assignment

What can be assigned?

An exclusive right to a trademark may be assigned with regard to all goods and services or a subset of specific goods and services that it was registered for by entering into an assignment agreement. Assignment of right shall be made within the effective term of the registration. The parties are free to assign goodwill with rights to a trademark. No business assets shall be assigned to make it a valid transaction.

A trademark assignment is not allowed if it may lead to deception of the customer in respect of the goods and services or the person who produces goods or provides services.

13 Assignment documentation

What documents are required for assignment and what form must they take?

The assignment agreement is deemed to be valid if it has been concluded in writing and has been signed by both parties to the agreement. There are, however, certain requirements in respect of the form of the assignment agreement to be filed with the UPTO for the purposes of recordation within the Trademark Register and publication of information on the assignment of the rights. The assignment of rights can be done during and after the completion of the trademark registration process.

In this case, the following documents shall be filed with the UPTO:

- three copies of an assignment agreement (including a minimum of one original and one notarised copy);
- a formal application signed by both parties;
- power of attorney, if appropriate (appointing a patent agent as a representative of assignee or assignor if a non-resident is involved); and
- a payment document amounting to the official fee of €60 (in the case of recording the assignment of a pending trademark application) and a fee of €80 (if the recordation is done after the certificate has been issued).

14 Validity of assignment

Must the assignment be recorded for purposes of its validity?

Although an assignment concluded in writing and signed by both parties to the agreement is deemed to be valid, the information on the change of an owner should be recorded in the UPTO’s State Register of Certificates of Ukraine for Trademarks and Service Marks according to the provisions of the Civil Code. Moreover, the High Commercial Court has recently adjudicated the following: although an assignment agreement may be executed by the parties after it has been signed, the obligations for the third parties arise only after such an agreement is duly registered in the UPTO. It usually takes one to two months, if a trademark application is pending, and two to three months, if a trademark certificate has already been issued, to record the respective trademark assignment.

15 Security interests

Are security interests recognised and what form must they take?

Must the security interest be recorded for purposes of its validity or enforceability?

Yes, security interests over intellectual property rights are recognised under the laws of Ukraine. The written form of the security interest contract is mandatory, unlike notarisation of the contract, which is optional. Although registration of the security interest with the State Register of Encumbrances of Moveable Property is not obligatory, it is still highly advisable since registered security interests have a priority over non-registered interests. To register the above encumbrances, the following documents shall be filed with the registrars:

- application;
- power of attorney; and
- a fee of €3.50.

16 Markings

What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?

The proprietor of the trademark may mark his or her goods and services with a notice, which certifies that this sign has been registered in Ukraine. More precisely, the sign ‘™’ may be used after submission of an application to the UPTO and the sign ‘®’ may be used once a certificate of trademark registration has been obtained. However, this marking is not mandatory. Thus, if none of the above signs is used, the proprietor can still have recourse to the court in the case of a trademark infringement.

Pursuant to the prospective amendments, the owner of the trademark may mark his or her goods or services either with ‘®’, or ‘™’, or ‘sign for goods and services’, ‘registered sign for goods and services’ at his or her sole discretion.

17 Trademark enforcement proceedings

What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?

In the case of trademark infringement, remedies may be sought under civil, commercial, administrative and criminal legal procedures, as well as under administrative proceedings (eg, according to competition and customs law).

There are no specialised courts or other tribunals for resolving disputes in regard to trademark infringement in Ukraine.

Pursuant to the Criminal Code of Ukraine, illegal use of a trademark or a service mark or any other intentional violation of the rights thereto is a punishable offence if it has caused damages of at least €886.

18 Procedural format and timing

What is the format of the infringement proceeding?

Cases relating to trademark infringements are heard in both civil and commercial courts. A civil court has jurisdiction over the matter if one of the parties to the dispute is an individual who is not registered as a private entrepreneur. A commercial court can hear cases in which only legal entities or private entrepreneurs are involved.

The civil court shall adjudicate within a reasonable period of time, which may not exceed two months after the beginning of court proceedings. A decision of the first instance court may be appealed to an appellate regional court, the decision of which may be appealed to the High Specialised Court for Trial in Civil and Criminal Cases

(starting from 1 November 2010). The decision of the latter may be further appealed to the Supreme Court of Ukraine. In practice, it takes about eight to 10 months to pass all stages. The proceeding may, however, be protracted if an expert opinion is necessary.

The commercial court shall adjudicate not later than two months after an action is brought to the court. A decision of a first instance court may be appealed to an appellate commercial court, the decision of which may be appealed to the High Commercial Court. The decision of the latter may be further appealed to the Supreme Court of Ukraine. In practice, it takes about seven to nine months to pass all stages. Given that in IP disputes specific knowledge is required, the parties may have to request an expert opinion, which usually takes about six months in each particular case.

Both in civil and commercial procedure, the discovery and conclusions of experts are allowed. Live testimony is more common in the civil procedure. The commercial procedure is mostly based on submission of written evidence. However, oral explanations of parties' representatives may be introduced. A request for an expert opinion shall be ordered by the court in both procedures. Parties to the dispute may suggest questions to be reviewed by an expert. Moreover, the parties may obtain an expert opinion separately from the court's request and submit it to the court.

The criminal procedure consists of the following proceedings: commencement of the proceedings; inquiry; preliminary investigation by prosecutors, if any public officers are involved, or interior affairs authorities in other cases; bringing of an indictment; court proceedings.

The court can adjudicate in each particular case following all the procedures, and therefore neither any evidence nor arguments of the prosecutor is of a decisive or mandatory character for the court.

19 Burden of proof

What is the burden of proof to establish infringement or dilution?

Each party to a dispute has a burden of proof of its claims and objections both in the civil and commercial procedure. Therefore, a plaintiff has to demonstrate that there is a trademark infringement and that his rights to a mark in question are duly certified. In criminal proceedings, an alleged infringer is presumed innocent until the contrary is proven.

The cause of action for dilution is possible in Ukraine. However, prior to instituting proceedings with regard to dilution, the fact that a trademark is well known shall be established either by the Appellate Board or the court. For more information, see question 29.

20 Standing

Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?

Both the trademark owner and licensee, provided the consent of the trademark owner is given, may seek remedy for an alleged trademark violation.

A criminal complaint may be brought by any person. However, in the criminal proceedings, the damages may be awarded only to such persons that have suffered from the trademark infringement.

21 Foreign activities

Can activities that take place outside the country of registration support a charge of infringement or dilution?

No, activities that take place outside Ukraine cannot support a charge of infringement or dilution. However, information on the above-mentioned activities may be used to support a claim for recognition of a well-known trademark.

22 Discovery

What discovery devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?

The following devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country:

- under both civil and commercial procedure: a motion submitted to the court for a request of evidence;
- under administrative procedure: the court may request production of evidence regardless of any motions being submitted; or
- under criminal procedure: interrogation and search and seizure. The appropriateness of different discovery techniques depends on the circumstances of each particular trademark infringement case.

23 Timing

What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?

In practice, it takes about eight to 10 months to complete all stages under the civil procedure. The proceeding may, however, be protracted if an expert opinion is necessary. A preliminary injunction is available in the course of court proceedings, as well as before filing a claim. An application for a preliminary injunction submitted prior to filing a claim shall be considered by the court within two days. If the application is accepted by the court, the claim must be submitted within three days.

As a rule, it takes about seven to nine months to complete all stages of the commercial procedure. Given that in IP disputes specialist knowledge is required, the parties may have to request an expert opinion, which usually takes about six months in each particular case. A preliminary injunction is available at any stage of proceedings in court.

24 Litigation costs

What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?

The amount of the official fees (court fee and IT services fee, where appropriate) will depend on the alleged damages determined by the plaintiff and the type of procedure. The typical range of costs associated with an infringement action may vary depending on the fees of legal counsel, patent agent and translator in each particular case. A successful plaintiff can recover the cost of an expert, translators' services, lawyers' fees, court fees and other expenses. The court, however, has the discretion to assess whether expenses are excessive and may, therefore, decrease the amount of expenses to be compensated.

25 Appeals

What avenues of appeal are available?

In the commercial procedure, the appeal to the appellate commercial court shall be filed within 10 days in the case of a decision and five days in the case of a resolution. An appeal to the High Commercial Court is only available after appeal to the appellate commercial court within 20 days from the day when the respective decisions came into force. An appeal to the Supreme Court of Ukraine is possible on the grounds of different application of the law by the court of cassation or ascertainment by an international institution, which is recognised by Ukraine, of violation of its obligations by Ukraine.

In the civil procedure, an appeal to the appellate regional court shall be filed within 10 days in the case of a decision and five days in the case of a resolution. An appeal to the High Specialised Court for Trial in Civil and Criminal Cases (starting from 1 November 2010) is only available after the appeal to the appellate regional court within

Update and trends

More than 80 per cent of national companies are willing to prevent and react to any violations of their rights in the sphere of intellectual property. Such infringements usually involve illegal use of trademarks and industrial designs, sale or purchase of counterfeit goods and grey imports. During the past two years, combating IP infringements on the internet, mostly related to domain name disputes with regard to protection of rights, has become extremely urgent. The number of disputes regarding protection of rights to domain names (with respect to the use of domains that violate the rights to trademarks and trade names) has increased, as well as the number of disputes concerning the illegal use of trade names. It should be noted that trademark owners are more frequently addressing the AMCU with respect to protection from unfair competition.

20 days from the moment when the respective decisions came into force. An appeal to the Supreme Court of Ukraine is possible on the same grounds as in the commercial procedure.

26 Defences

What defences are available to a charge of infringement or dilution, or any related action?

The following defences are available against a charge of infringement:

- a plaintiff does not have duly certified rights to a trademark;
- a defendant has obtained the prior rights to a mark;
- no likelihood of confusion exists on the part of the marks;
- a mark in question is of descriptive character and therefore is not afforded any protection;
- the trademark is registered for different goods or services (to a charge of infringement only); or
- evidence provided by the plaintiff to support his or her claims is neither proper nor admissible.

27 Remedies

What remedies are available to a successful party in an action for infringement or dilution, etc? What criminal remedies exist?

The following remedies are available to a successful party.

Civil and Commercial Procedure Law

Preliminary injunctions, injunctions, awards of damages, removal from the circulation and destruction of the infringing items, invalidation of a certificate or registration.

Administrative Procedure Law

The actions or omissions of state authorities may be recognised as illegal.

Competition Law

Ascertaining of the trademark infringement, injunction by Anti-Monopoly Committee of Ukraine, fine of up to €16,954 or 5 per cent of the profit gained during the preceding financial year.

Customs Law

Prohibition of import or export of counterfeit goods; although parallel import is not expressly prohibited under the laws of Ukraine, an owner or a licensee may still have recourse to the court with regard to trademark infringement; provided that a trademark is registered in the Customs Register, customs clearance may be suspended if there is a reasonable suspicion of a trademark infringement.

Criminal and Administrative Violations Law

Given that there are other respective constitutive elements of trademark infringement, a penalty of up to €5,086 or six years' imprisonment may be applied. Also, in the criminal proceedings, the damages may be awarded to persons that have suffered from the trademark infringement. Moreover, for minor trademark infringements an administrative fine may also be imposed.

28 ADR

Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?

The parties may either stipulate an arbitration clause in the contract or enter into a separate arbitration agreement. This would give the contesting parties standing to refer a dispute to a court of arbitration. Although decisions of courts of arbitration are mandatory only for the parties to the dispute, they cannot be enforced unless a commercial court issues an order. Therefore, ADR techniques are not commonly used.

Moreover, a non-resident of Ukraine may refer a dispute to the International Commercial Arbitration Court if an arbitration clause is provided for in the agreement. To enforce a decision of such a court, an approval of a civil court shall be obtained.

29 Famous foreign trademarks

Is a famous foreign trademark afforded protection even if not used domestically? If so, must the foreign trademark be famous domestically? What protection is provided?

Subject to the use of a mark in Ukraine and submission of other required evidence to the UPTO, well-known trademarks (ie, famous foreign trademarks) are afforded protection regardless of their

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registration in the UPTO in Ukraine, provided that these trademarks are recognised as well-known by the Appellate Board or the court. Both authorities will determine the date on which the trademark became well-known. From that date the same scope of protection is granted as if it were a duly registered domestic trademark. Moreover, the well-known trademark will be protected not only with regard to related goods and services if their use may potentially hamper the interests of the owner of the well-known trademark and the connection between such goods and services and the owner of the well-known trademark.

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