

DRAFT

LAW OF GEORGIA ON TRADEMARKS

CHAPTER I. GENERAL PROVISIONS

ARTICLE I. AIM OF THE LAW

The Law regulates the relations applying to registration and protection of trademarks, service marks and collective marks, also to usage of these marks.

ARTICLE 2. MAIN DEFINITIONS USED IN THE LAW

1. “Sakpatenti” - National Intellectual Property Center of Georgia - a legal entity, which conducts the legal enforcement of the rights of natural persons and legal entities in the field of intellectual property.

2. Paris Convention - the Paris Convention for the Protection of Industrial Property, signed at Paris on March 20, 1883, as revised and amended at Stockholm on July 14, 1967 and on September 28, 1979.

3. Protocol Relating to the Madrid Agreement - Protocol Relating to the Madrid Agreement Concerning the International registration of marks signed on June 27, 1989.

4. International Classification - the classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, signed at Nice on June 15, 1957, as revised at Stockholm on July 14, 1967 and Geneva May 13, 1977.

5. Certificate - the document granted in the name of the trademark holder in respect to this Law, confirming the exclusive rights of the trademark holder.

6. Application - collection of documents necessary for granting of a patent, made in respect to the approved requirements.

7. Applicant - a natural person or legal entity requesting for receiving of the certificate.

8. Priority - privilege enjoyed by the application filed earlier, than the application filed later.

ARTICLE 3. TRADEMARK

1. A trademark is a sign or a combination of signs, which can be represented graphically and distinguishes the goods and/or services of one enterprise from the goods and/or services (hereinafter goods) of the other

2. The sign can be a word or words, including personal names, letters, figures, sounds, reproduction, three-dimensional figure, among them shape of the goods or packaging as well as other designs of the goods applying colors or combination of colors.

3. The trademark is protected by its registration with Sakpatenti or on basis of international agreement

4. The well-known trademarks in Georgia are protected without registration under Article 6bis of the Paris Convention for the Protection of Industrial Property.

circulation has been established as a distinctive sign for the goods indicated in the application.

ARTICLE 5. RELATIVE GROUNDS FOR REFUSAL ON REGISTRATION

A trademark is not registered if:

1. It is identical to the trademark registered in regard to the same goods;
2. It is identical to the trademark of third party and the goods are identical or similar to such an extent that, creates the possibility of confusion of the marks, among them confusion based on association;
3. It is similar to the trademark of third party and the goods are identical or similar to such an extent that, creates the possibility of confusion the marks, among them to such confusion based on association;
4. It is identical or similar to the notorious in Georgia trademark, that creates the possibility of confusion with it, among them confusion based on association. This rule is applied even in the case when the lists of the goods are different.
5. It is identical or similar to the appellation of origin or geographical indication protected in Georgia that causes the likelihood of confusion with it;
6. It is identical to the industrial design protected in Georgia except the cases when the registration of the trademark is sought by the holder of the exclusive right on the industrial design;
7. It is identical, or similar to the third party's trademark enjoying good reputation in Georgia, and the use of this identical, or similar trademark creates the advantageous conditions for its applicant, or damages the reputation of the protected trademark. This rule is applied in the case when there are different lists of goods;
8. It includes names, pseudonyms, facsimiles, portraits of famous in Georgia persons without the consent of these persons or their legatees, and if they are the property of the history and culture of Georgia without the permission of the Ministry for Culture of Georgia;
9. It includes the names of the historical monuments of Georgia or their reproduction without the permission of the Ministry for Culture;
10. It includes the firm name, which can cause the confusion.

ARTICLE 6. THE EXCLUSIVE RIGHT

1. The exclusive right of the holder of a trademark arises from the date of the mark registration;
2. The trademark holder shall be entitled to prevent third parties from the use of such a trademark in the civil circulation which:
 - a) is identical to the protected trademark, and the goods are identical as well;
 - b) is identical, and the goods are similar to such an extent that, there exists a

creates the advantageous conditions for his holder, or damage the reputation of the earlier trademark. This rule is applied in the case when there are different lists of goods and/or services;

CHAPTER II

ACQUISITION AND PRESERVATION OF THE TRADEMARK RIGHTS

ARTICLE 9. APPLICATION FOR A TRADEMARK REGISTRATION

1. An application for registration shall be filed with Sakpatenti
2. The application is filled in Georgian language in respect to the established rule.
3. The application is filed with Sakpatenti by the legal entity or natural person (hereinafter referred to as applicant). The right to file an application in the name of the applicant has also his representative.
4. The foreigner, who does not have a permanent place of residence within the territory of Georgia conduct their relations with Sakpatenti through a patent attorney registered in Georgia.
5. The application shall apply to only one trademark.
6. The application at filing with Sakpatenti must contain:
 - a) a request for a trademark registration;
 - b) the name, address and signature of an applicant;
 - c) the representation of a trademark;
 - d) the list of the goods and/or services for which the registration is sought. It is permitted to present a list of goods in a foreign language, the Georgian translation of which shall be presented to Sakpatenti within one month from the date of filing the application, with the exception of the cases provided for by the paragraph 4 Article 11;
 - e) the name, address and signature of the representative, if the application is filed by him;
 - f) the application must be signed by the applicant or his representative.
7. All the necessary data and the list of the documents for examination, the terms of their presenting and conditions are determined by the rule established by the legislation.

ARTICLE 10. THE DATE OF FILING AN APPLICATION WITH SAKPATENTI

The date of filing of an application with Sakpatenti is considered the day on which the applicant presents it to Sakpatenti, if the presented application complies with the requirements considered under Article 9 paragraphs 2 and 6.

ARTICLE 11. PRIORITY

1. A trademark priority is established by the date of filing an application, if the established application fee shall be paid after filing the application within the period no longer than one month.

If several identical trademarks have one and the same filing date, then the priority is established as of the date starting the actual use of the trademark.

2. The trademark priority can be established as of the filing date of the first application with the Member State of the Paris Convention (hereinafter referred to as

b) familiarize himself with the materials applied at examination and require the copies;

c) before establishing the application priority, to fill, or specify the application information by his own initiative. After establishing of the application priorities, the mentioned changes are possible only after paying the prescribed fee, but no later than the registration of the trademark. If the additional materials expand the list of goods or essentially changes the presented sign, then such information is not taken into account.

d) at any stage of consideration of an application, but no later than its registration, to withdraw the application.

6. The rules of compiling of the application and filing, of examination, of opposing the examination decision, retention of the procedural terms, of extension and renewal. also other rules respecting the trademark registration are established by the approved on the basis of the rule defined by the legislation “Instruction on Filing the Application for Trademark and Procedures Respecting the Registration”.

ARTICLE 13. THE EXAMINATION AS TO FORM

1. The examination as to form shall be conducted within two months after filing the application and if the applicant claims for Convention or exhibition priority - within the term provided for by the Article 11 paragraph 4 of this Law. If the applicant was send a notification requiring the additional materials, the examination is retained till the receipt of the response on notification, but no later than the term defined by the Article 12 paragraph 2 of this Law.

2. The examination as to form checks whether the application is compiled in respect to this Law.

3. If the application satisfies the requirements of Article 9 paragraphs 2 and 6 of this Law, a document shall be issued on the name of the applicant, or his representative, about the establishment of the date of filing the application, with the indication of the office number and a list of documents. Otherwise, the applicant shall receive(r)-1.15ga4(r Convev3.7(1).ae6.

ARTICLE 14. THE COMPLETE EXAMINATION

1. The complete examination is carried out within six months period from the end of the formal requirements examination;
2. On the stage of the complete examination, it is ascertained whether the sign satisfies the requirements considered under Articles 4 and 5 of this Law.
3. On the basis of the complete examination, the examiner takes a decision about the registration, or refusal on a trademark registration and sends a relevant notification to the applicant.

ARTICLE 16. PUBLICATION

1. After taking a decision of examination on a trademark registration within one month Sakpatenti publishes the trademark data in the Official Bulletin of the Industrial Property (hereinafter referred to as "Bulletin").
2. If the applicant makes use of the right defined in the Article 16 paragraph 2, the publication of the data of the application in the Bulletin shall be conducted within one month after the Chamber of Appeals takes the decision.
3. The following shall be published in the Bulletin: reproduction of the trademark, the name and address of the holder, the list of goods respecting the International Classification for which the trademark registration is sought, and the priority date of the trademark.

ARTICLE 16. OPPOSITION TO THE EXAMINATION DECISION

1. The decision of the examination as to form on examining of the application can be opposed by the applicant at the Chamber of Appeals within 3 months after taking the decision.
2. The decision of the complete examination on refusing the trademark registration respecting the full list of the goods or its part can be opposed by the applicant at the Chamber of Appeals within 3 months after taking the decision.
3. The decision of the complete examination on registration of the trademark can

1. If, after publication of the trademark data an objection is not filed, or if, after consideration of the appeal the Chamber of Appeals takes decision on a trademark registration, Sakpatenti conducts a trademark registration in the State Register of trademarks (hereinafter referred to as the "Register").

1. The trademark, the validity term of which has been expired, can not be re-registered before expiration of one year from the date of termination of the validity term of the previous registration, with the exception of the cases, when its registration is required by the former holder of this trademark.

2. If, after expiration of the above mentioned one year term, different persons, out of which one is a former holder of this trademark, file applications

2. The trademark can be transferred to another person with, or without an enterprise.

3. Transfer may be applied to the full list of goods or to its portion.

4. Transfer of the enterprise considers the trademark transfer as well, with the exception of the case when the contrary is provided by the transfer agreement.

5. The contract on the trademark transfer shall be concluded in a written form. Unobservance of a written form shall result in annulment of the contract.

6. If it becomes apparent from the transfer documents that a trademark transfer can mislead a consumer as to the properties, quality, or geographical origin of those goods for which it is registered, Sakpatenti does not record a note about the transfer in the register until it gets consent from a legatee, that the registration would be limited by the goods and/or services not resulting in confusion.

7. The trademark transfer documents, after payment of the prescribed fee, shall be recorded in the register and published.

8. If the trademark transfer contract is not recorded in the register, a legatee of a trademark holder is not authorized to use the rights, originated from the registration, against the third parties.

ARTICLE 26. THE LICENSE AGREEMENT

1. The right to the use of a trademark can be given by its holder (licenser) to another person (licensee) on the basis of a license agreement.

The license agreement can be concluded with respect to a full list of goods and/or services, or its portion.

2. The license can be either exclusive, or simple.

3. The trademark holder can use his rights against a licensee infringing a license agreement, if the infringement concerns the license term, a form of a trademark use, a list of those goods and/or services, for which the license has been issued, a territory where the trademark can be used, quality of the produced goods and rendered services.

ARTICLE 27. GROUNDS FOR CANCELLATION OF A TRADEMARK REGISTRATION

1. A trademark registration shall be canceled by Sakpatenti if:
 - a) a trademark holder files the relevant request with Sakpatenti;
 - b) a trademark holder does not pay the fee within the established period, if the term has not been extended;
 - c) a legatee is not created while liquidation of a trademark holder as a legal entity.
 - d) there exists an application having the earlier priority provided for by the Article 11;
2. The trademark registration shall be canceled by the Court at the request of the third party if:
 - a) it has not been used for five continuous years, although nobody is authorized to demand a trademark registration, if the use of a trademark has started, or has been renewed during the interval between expiration of the established five years term and filing the requirement for abolishment of the trademark registration.
 - b) the trademark has become a generic term of the goods for which it has been registered;
 - c) in case of existence of the grounds considered under Article 5 of this Law.
 - d) use of a trademark, by its holder, or in agreement with him, is conducted in such a way, that it can mislead a consumer as to the kind, quality, properties, value, or a place of geographical origin.
3. If there are the grounds for cancellation of a trademark regarding only the part of the registered list of goods, the registration shall be canceled only for this part.

ARTICLE 28. RECOGNITION OF REGISTRATION NULLITY

1. A trademark registration can be recognized annulled at the request of third party, if it has been registered in breach of Article 4 of this Law.
2. If there are the grounds for recognition of a trademark registration annulled only for the part of the registered list of goods, the registration shall be recognized

2. If the trademark registration is considered annulled in accordance with Article 28 of this Law, the rights awarded under the registration shall be considered annulled from the date of arising of the rights to the trademark.

3. The recover of the damages is regulated by the civil code in force.

CHAPTER V. COLLECTIVE MARK

ARTICLE 30. RIGHTS TO COLLECTIVE MARK

1. A collective mark is a sign or combination of signs, which under the Article 3 of this Law can be protected as a trademark and distinguishes the goods of the association members holders of the collective mark from the goods of the other parties regarding the origin, geographical origin, nature, similar qualitative features or other features.

2. The holder and the applicant of collective mark can be only an association.

3. It is not permitted to transfer the collective mark, and grant a license for this mark to the party, which is not the member of the association.

4. All rules of this Law are applicable to the collective mark, if not provided otherwise by the Chapter V of this Law.

ARTICLE 31. USE OF THE GEOGRAPHICAL NAME AS THE COLLECTIVE MARK

1. From the restrictions considered under the Article 4 subparagraph “b” of the paragraph 1 of this Law it is admissible, as an exception, to register as a collective sign, such a sign which indicates the place of geographical origin of the goods and/or services.

ARTICLE 32. THE COLLECTIVE MARK REGULATIONS

1. An application for a collective mark shall comply with the requirements of the Article 9 and must be completed by the collective mark regulations.

2. The collective mark regulations shall contain:

- a) the name and address of the association;
- b) the name of the members of the association and the legal address;
- c) the aim of the association;
- d) conditions for the use of a collective mark and taking control over its usage;
- e) the rights and obligations of the member parties of the association which are related to infringement of the rights to the collective mark;
- f) list of those goods and common characteristics for which the collective mark is intended.

3. If the collective mark contains a geographical name, the charter must provide any person, whose goods originate within the indicated geographical region, and who meets the conditions for use of the mark established under the indicated charter, with a right to become a member of the association and use the mark.

4. Any interested person is entitled to familiarize himself with the collective mark charter.

ARTICLE 33. THE APPLICATION EXAMINATION

Besides the grounds for refusal on the registration given in Article 4 and 5, an

ARTICLE 36. NULLITY BECAUSE OF THE ABSOLUTE GROUNDS FOR REGISTRATION REFUSAL

Besides the grounds given in Article 28 of this Law, a collective mark registration can be considered annulled if it has been registered in breach of the requirements of Article 33 of this Law. If the grounds for the annulment are related with a collective mark

application for the international registration of trademarks shall be replaced by the terms “refusal on protection” and “annulment of protection”.

ARTICLE 42. PUBLICATION AND APPEAL

1. The data of the international registration of trademark shall be considered published at their publication in the Gazette of the International Bureau of the World Intellectual Property Organization (WIPO).

2. At taking the decision by the complete examination on the international registration of the trademark the date of the international registration and number are additionally published in the Bulletin within one month from taking of the decision.

3. The opposition term provided for by the Article 16 paragraph 4 of this Law shall be calculated from the day of publishing the date and number of the international registration of trademark.

ARTICLE 43. ANNULMENT OF THE PROTECTION DUE TO THE NON-USE

- a) the prevention of acts infringing his rights;
- b) the compensation of damages;
- c) destruction of all those labels, pictures, imprints, packaging, packaging materials and advertisements containing the registered trademark or its copy, resemblance or imitation;
- d) destruction of the plates, matrices and clichés prepared for making the trademark and if separation of the trademark from the goods is impossible - the destruction of the goods.