

LAW OF GEORGIA ON TRADEMARKS

CHAPTER I. GENERAL PROVISIONS

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ARTICLE 3. TRADEMARK

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

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

3. The trademark is protected by its re

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, it:

- a) is identical with the trademark registered in regard to the same goods;
- b) is identical with 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;
- c) is similar to the trademark of third party and the goods are identical or similar to such an extent, that there exists the likelihood of confusion of the marks, which includes confusion based on association;
- d) is identical with or similar to the notorious in Georgia trademark, that there exists the likelihood of confusion with it, which includes confusion based on association. This rule is applied even in the case when the list of the goods are different.
- e) is identical with or similar to the appellation of origin or geographical indication protected in Georgia that causes the likelihood of confusion with it, which includes confusion based on association;
- f) is identical with 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;
- g) is identical with 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;
- h) 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;
- i) includes the names of the historical monuments of Georgia or their reproduction without the permission of the Ministry for Culture;
- j) includes the firm name causing the likelihood of confusion.

ARTICLE 6. EXCLUSIVE RIGHT

1. The exclusive right of the holder of a trademark arises from the date of the mark registration;

2. The person enjoying exclusive right can prevent third parties from the use of such a trademark in the civil circulation, which:

- a) is identical with the protected trademark, as well as the goods;
- b) is identical with, and the goods are similar to such an extent that, there exists a likelihood of confusion, which includes confusion based on association, of one trademark with another;

c) is similar to, and the goods are identical with or similar to such an extent, that there exists the likelihood of confusion of the marks, which includes confusion based on association;

If the reproduction of a trademark in a dictionary, encyclopedia or other information literature gives the impression that it represents a generic term of goods for which it has been registered, or its registration is required, the publisher, at the request of the holder of the indicated mark, is obliged to outline in the next edition of the reference book that the published sign is a registered trademark.

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 by an applicant or his representative.
2. The request is filled in Georgian language in respect to the established rule.
3. The foreign applicant nonresident of Georgia, or who has no operating enterprise within the territory of Georgia conducts his relations with Sakpatenti through a patent attorney registered at Sakpatenti.
4. The application shall apply to only one trademark.
5. The application at filing with Sakpatenti must contain:
 - a) a request for a trademark registration;
 - b) the full name and legal address of applicant;
 - c) the representation of a trademark;
 - d) the list of the goods 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;
 - e) the name and address of the representative, if the application is filed by him;
 - f) the application must be signed by the applicant or his representative.
6. All the necessary data and the list of the documents for examination, the terms of their presenting and conditions are defined by the legislation.

ARTICLE 10. DATE OF FILING AN APPLICATION WITH

1. A trademark priority is established by the date of filing an application, if the prescribed 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 by the filing date of the first application with the State party to the Paris Convention (hereinafter referred to as "Convention priority"), if no longer than six months have passed from this date until the date of filing the application with Sakpatenti.

3. If an applicant for the trademark has displayed a trademark on the exhibit presented at an official or officially recognized international exhibition held in the State party to the Paris Convention, the trademark priority is established by the first day of exhibition (exhibition priority), if he files the application within a period of six months from the date of display of the trademark at the exhibition. The exhibition and Convention priorities do not extend each others term.

4. The applicant who wants to enjoy the Convention, or the exhibition priorities, is obliged to notify Sakpatenti within one month from the date of filing the application with Sakpatenti, and, within three months from the filing date, present the document confirming the right on such a claim.

5. The fee determined by the established rule for Convention and exhibition priorities shall be paid to Sakpatenti within one month from the filing date of the application.

ARTICLE 12. EXAMINATION OF TRADEMARK APPLICATION

1. Sakpatenti conducts the examination as to form and substabtive examination of a trademark application.

2. Sakpatenti is authorized to require from an applicant the additional materials needed for the examination. The additional materials are furnished to Sakpatenti within two months from the date the relevant notification is handed to the applicant. If the applicant fails to comply the established term, or leaves the requirement of the examiner without any response, the application shall be considered rejected.

3. The application, where the list of goods contains two or more names, at the request of the applicant, before the trademark registration can be divided into two or more applications, by means of redistribution of the goods services of the first application on each application, after payment of the prescribed fee on this application. The divisional applications preserve the date of filing of the first application.

4. Sakpatenti gives away the information on trademark appications only after establishing the priority.

5. The applicant has the right to:

a) require suspension of consideration at any stage of examination of his own application after paying of the prescribed fee, but no longer than three months;

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

c) before establishing the application priority, to fill, amend correct or specify the application material. After establishing of the application priority, 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) before the trademark registration 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 defined by the approved regulation in respect to the the rule established by the legislation of Georgia “On Filing the Application for Trademark and Procedures Respecting the Registration”.

ARTICLE 13. 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 in the name of the applicant on 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 notification of well-grounded refusal on accepting the application;

4. If the application fee is not paid within one month from the date of filing the application, or is paid the amount which is less than the amount established for one class, Sakpatenti takes the decision on rejecting the appliation. If, within the established one month, the amount less than the amount established for presentation of the classes considered by the application, and enough for presentation of one class is paid, the examination shall cover the classes selected by the applicant, and, in the case of lack of such selection, it shall cover as many of the first classes as for which the paid amount shall be enough.

5. On basis of examination as to form Sakpatenti takes decision on accepting the application for examination and establishing of

ARTICLE 15. PUBLICATION

1. After taking a decision of substantive examination on a trademark registration Sakpatenti within one month 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 data 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 substantive 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 substantive examination on registration of the trademark can be revised in respect to the Article 11 of this Law concerning the filing with Sakpatenti of the application having earlier priority.

4. Within three months period from the date of publication of the trademark data

ARTICLE 18. TRADEMARK CERTIFICATE

1. After recording the data in the register Sakpatenti grants a trademark certificate.

For the examination as to form of trademark application, for substantive examination, for opposition of the examination decision, for the mark registration, for the registration of the amendments, for publication, for granting of the certificate, for the excerpt from the Register, for retaining of the procedure terms respecting registration, for renewal and extension, also for the other acts, respecting the legal protection of the trademark shall be paid the fees defined by the established rule under the legislation. The amount of the fees, conditions for payment are defined by the rule established under the legislation. Periodically the amount of the fee shall be revised considering the respective international standards, changes of national currency rate and inflation.

ARTICLE 23. TRADEMARK REGISTRATION ABROAD

The holder of the trademark registered in Georgia has the right under the observation of the established rule, to present a trademark for registration in another country, or conduct its international registration.

CHAPTER III. USE OF TRADEMARK AND ASSIGNMENT OF RIGHTS PROCEEDING FROM REGISTRATION

ARTICLE 24. USE OF TRADEMARK

1. Under the use of a trademark is considered: its imprint on the goods for which it has been registered, on its packaging, on the exhibit displayed at exhibition and fairs, signs, official forms, labels, advertisements, published works, also other use of trademark, use of a trademark by the holder of a trademark, licensee or third party on basis of assignment of the right by the holder of the mark. Under the use of a trademark is also considered the use of a slightly different sign instead of the registered trademark.

ARTICLE 25. TRANSFER OF RIGHTS PROCEEDING FROM TRADEMARK REGISTRATION

1. Pursuant to the trademark registration, the rights can be transferred to other legal entity and natural person on the basis of the rule established under the legislation.

2. The trademark can be transferred to another party 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 implies the trademark transfer as well, with the exception of the case when the contrary is provided by the transfer contract.

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 features, 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 assignee on withdrawing of goods leading into confusion from the list of goods.

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

8. The new holder of trademark cannot apply the rights proceeding from registration against the third party, until the amendments regarding the trademark transfer are recorded in the Register.

ARTICLE 26. LICENSE CONTRACT

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 contract. The license contract can be concluded with respect to a full list of goods or to its portion.

2. The license is exclusive or simple.

3. If the license character is not defined by the contract, the license shall be considered as simple. In this case the licenser can use the trademark himself or conclude another license contract.

4. The exclusive license prohibits the licenser to conclude other license contract and use the trademark, if its is not provided otherwise by the contract. The rights proceeding from the exclusive license are in froce during the validity term of trademark registration, if it is not provided otherwise by the contract.

5. The licensee is prohibited to assign the rights pro(er (ark, i1 TĐy).77Nd

a) a trademark holder files the relevant request with Sakpatenti;

CHAPTER V. COLLECTIVE MARK

ARTICLE 30. RIGHTS ON 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 similar qualitative features or other features.

2. The holder and the applicant of collective mark can be only an association or a legal entity of public law.

3. It is prohibited 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 INDICATION OF GEOGRAPHICAL ORIGIN AS 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 designates the place of geographical origin of the goods (place, district, region, name of the country or other indication designating the geographical origin of the goods).

2. The indication of geographical origin is not used as a collective mark for the goods, which did not originate from the respective geographical place, district, region, country, if such an indication leads to the confusion as to the origin of the goods.

3. If the indication of geographical origin includes the special features and quality of the goods, such indication shall be used as a collective mark only for the goods having respective features and quality.

4. The paragraphs 2 and 3 of this Article shall apply to the name, indication and sign, which are similar to the indication of geographical origin.

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 names 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 regulation governing the use of collective mark must provide for, that any party, the goods of which originate within the indicated geographical region, meets the conditions for use of the mark established pursuant to said regulations, has the 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 application filed for registration of a collective mark can be rejected if it does not comply the requirements provided under Articles 30 paragraph 1 and 2 of this Law, with the exception of the cases when the applicant corrects said regulations so, that the grounds for refusal on the registration shall not exist.

ARTICLE 34. LIMITATIONS OF COLLECTIVE MARK PROTECTION

The registration of a geographical name as the collective mark does not entitle its holder to prevent the third party from using of this name in civil circulation, if the use is conducted by preservation of the norms of fair competition and the third party has reasonable grounds to the use of the name.

ARTICLE 35. APPEAL

1. A person, who is entitled to use a collective mark, has the right to bring an action on infringement of the right to the use of a collective mark only with the permission of the collective mark holder association, unless the contrary is provided by the regulations governing use of collective mark.

ARTICLE 36. ENTERING OF AMENDMENTS IN COLLECTIVE MARK REGULATIONS

1. A collective mark holder is obliged to notify Sakpatenti about any changes made in a collective mark regulations.

2. In case of making amendments in a collective mark regulations, the requirements of Articles 31 and 32 shall be taken into account.

ARTICLE 37. ANNULMENT OF THE COLLECTIVE MARK REGISTRATION

The collective mark registration can be annulled:

- a) in respect to the Article 27 of this Law;
- b) if the holder of the collective mark uses the mark in breach to the collective mark regulations.

**ARTICLE 38. NULLITY DUE TO THE ABSOLUTE GROUNDS
FOR REGISTRATION REFUSAL**

Besides the grounds given in Article 28 of this Law, a collective mark registration can be considered annul

1. On the application for the international registration of trademark only the substantive examination shall be conducted in

ARTICLE 45. RESPONSIBILITY FOR THE INFRINGEMENT OF THE EXCLUSIVE RIGHTS OF TRADEMARK

1. The infringement of the exclusive rights to the trademark results in the responsibility pursuant to rule defined by the legislation of Georgia.

2. In the case of the exclusive rights infringement the holder of the trademark can appeal to the court and demand:

- 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.

CHAPTER VIII. TRANSITIONAL PROVISIONS

ARTICLE 46. APPLICATIONS FILED AND CERTIFICATES GRANTED BEFORE THIS LAW ENTERS INTO FORCE

1. The applications for registration of the trademarks which were filed before this Law enters into force are considered in respect to the resolution of the Cabinet of Ministers of Georgia N304 of March 16,1992 “On Approving and Enacting of the Statute on Trademarks”.

2. The certificates granted for the registered trademarks before this Law enters into force will be in force after the enactment of the Law.

CHAPTER IX. FINAL PROVISIONS

ARTICLE 47. REPEALED NORMATIVE ACTS

1. At enacting of this Law the following shall be considered as repealed:

a) resolution of the Cabinet of Ministers of Georgia N304 of March 16,1992 “On Approving and Enacting of the Statute on Trademarks”.

b) resolution N 483 “On Additional Measures for Regulation of the Trademarks Use in Georgia” approved by the Cabinet of Ministers of Georgia on June 25, 1993.

ARTICLE 48. ENACTING OF THE LAW

