

## Intellectual Property Rights in Ukraine

### Regulatory Framework

The main pieces of local legislation that govern this area are as follows:

- Law on Trademarks of 15.12.1993, No. 3689-XII, as amended;
- Law on Industrial Designs of 15.12.1993, No. 3688-XII, as amended;
- Law on Inventions and Utility Models as of 15.12.1993, No. 3687-XII, as amended;
- Law on Copyright and Related Rights of 23.12.1993, No.3792-XII, as amended;
- Law on Distribution of Copies of Audiovisual Works, Phonograms, Videograms, Computer Programs, Databases of 23.03.2000, No. 1587-III, as amended.

Ukraine has also ratified the core international and European treaties, and convention-systems on intellectual property rights, among which are:

- Paris Convention;
- Berne Convention;
- WIPO Copyright Treaty;
- Patent Cooperation Treaty;
- Madrid System;
- Hague System;
- WIPO-Administered Treaties on Classification;
- TRIPS Agreement.

### National IP Offices

The state authorities that supervise IP matters in Ukraine are as follows:

- State Enterprise "Ukrainian Institute of Industrial Property" (**Ukrpatent**), the only institution in Ukraine, authorized to deal with IP matters (patents, trademarks, industrial designs, utility models, geographical indications etc.); and
- Ministry of Economic Development and Trade of Ukraine (**MEDT**), responsible for general supervision over registration, maintaining, transferring and cancellation of the industrial property rights and copyright. It acquired its functions due to the Concept for Reforming the State Intellectual Property System in Ukraine. It is a necessary step towards the establishment of the National Authority of Intellectual Property of Ukraine (**NAIP**) within next few years.

### Registration of IP rights in Ukraine

#### (a) Trademark

TM (i.e. a designation in a form of a logo, a word, a term, an image, a personal name, a company name or a combination thereof that identifies a company, its goods/services, and sound) shall be registered with the MEDT. Below we succinctly list the required actions and potential timeline for a TM registration in Ukraine.

#### (i) Search of similar TM already registered in Ukraine (OPTIONAL)

Although not mandatory, but advisable to order a search, which is done by Ukrpatent and is aimed primarily: (a) to identify whether similar trademarks have already been registered in Ukraine; as well as (b) to prepare in advance well-grounded justification for TM registration if similar TMs are detected and, thus, to smoothen the registration process.

Availability of TM is checked within 10 working days as of submission of a formal search request and is formalized in an official report. This report may be optionally submitted to the SIPS for speeding up TM registration.

#### (ii) Filing an application for a TM registration

After applying for a TM, two-stage examination is effected by the MEDT:

a. **Formal stage** – verification of the validity of the application documents;

b. **Qualification stage** – verification of the ability to grant protection to respective TM. In particular, the TM is checked for similarity with already registered TMs and compliance with the general qualification requirements.

#### (iii) Obtaining of TM registration certificate

The process of TM registration takes from 6 months (expedited procedure) to 2 years (standard procedure) as of acceptance of an application.

TM registration certificate is granted for 10 years and may be extended every 10 years for the same period.



**Tatiana Iurkovska**  
Partner

T +380 44 495 30 94  
t.iurkovska@nobles-law.com



**Volodymyr Yakubovskyy**  
Partner

T +380 44 495 30 86  
v.yakubovskyy@nobles-law.com



**Olena Stanishevskya**  
Senior Associate

T +380 44 495 30 91  
o.stanishevskya@nobles-law.com

LLC Nobles  
7/11 Khreschatyk St.,  
01001 Kyiv, Ukraine  
T +380 44 495 30 80  
F +380 44 495 30 90  
Info@nobles-law.com  
www.nobles-law.com

The information provided in this Legal Overview does not substitute legal advice in particular cases.

International trademark registrations extended to the territory of Ukraine enjoy the same level of protection as granted by the national registration.

## (b) Industrial designs

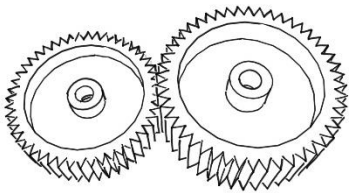
Industrial design is a combination of applied art and applied science, whereby the aesthetics, ergonomics and usability of products may be improved for marketability and production. The object of an industrial design may be a shape, picture, coloration or combination thereof, which define the appearance of an industrial product.

The registration of industrial design consists of the following steps:

### (i) Filing for registration of industrial design

After respective application is filed, it shall be examined from scientific and technical perspectives, which may further request/suggest the applicant to add certain information/restate designated data.

### (ii) Obtaining of a patent for industrial design



Overall procedure of obligatory registration may take from 6 up to 12 months as of filing. The protection is granted for 15 years maximum and cannot be renewed or prolonged.

## (c) Patents for inventions/utility models

Both inventions and utility models are subject to mandatory state registration through the MEDT. To qualify for patent protection, inventions shall meet the following requirements: (i) novelty; (ii) non-obviousness; (iii) utility.

Importantly, software, usually is not protected in Ukraine under inventions law – (as in US, for instance) but only under copyright law; unless only the part (code) can be treated from a scientific view as an invention.

Generally, the following stages shall be considered by the client while applying for registration:

### (i) Filing an application for registration of inventions/utility model

As soon as the application is submitted, the MEDT makes the following examination:

#### a. **Formal stage** – verification of the accuracy of a patent application, and

#### b. **Qualification stage** – verification whether designated invention/utility model meet the requirements of patentability.

### (ii) Obtaining of a patent for inventions/utility model

Generally, the process of patenting takes from 1,5 up to 2 years as of acceptance of a client's application.

The protection for inventions is given for 20 years as of the filing date, which can be further extended for 5 years more in such spheres as medicine, pharmaceutical, agro-chemistry and related areas, whereas the term of utility model patent is 10 years.

## (d) Copyright and Related rights

There is no mandatory registration of copyright. Protection is automatically granted to all and any works of authorship, irrespective of manner of its expression, i.e. works of science, literature and arts (copyright). Importantly, however, ideas, theories, principles, methods, procedures, etc., even if they are expressed, described, explained or illustrated in a work are not subject to copyright protection.

Alternatively, the copyright may be registered within the MEDT on the basis of respective application. In practice, apart from this registration procedure, there are several means that may prove the origin of a copyright and, thus, are advisable to avoid potential disputes between the authors.

The author's rights are generally protected as follows: (i) propriety rights - within author's lifetime and during 70 years after his death; (ii) non-propriety rights - indefinitely.

## Enforcement of IP rights in Ukraine

IP right holder may protect its infringed IP rights inter alia through:

- High Court on Intellectual Property that is to be created due to the Concept for Reforming State Intellectual Property System in Ukraine. It will have jurisdiction over majority of IP disputes, including the termination of the infringement, cancellation of registration certificates on infringing IP object; damages, including loss of profit;

compensation; recognition of a right, etc. In the meanwhile IP disputes are handled by state commercial courts;

- MEDT that handles, inter alia, registration of IP rights, registration of IP rights assignments, licence agreements;
- Antimonopoly Committee of Ukraine (AMC) that handles cases, inter alia, regarding unfair competition using intellectual property; and
- State Fiscal Service that performs border measures against IP infringements, including counterfeiting, handled by customs authorities.

## Transfer of IP rights/objects

In commercial relations the following contractual mechanisms of transferring/assignment IP rights/objects are viable:

- license for use of intellectual property;
- licensing contract;
- agreement on creation and use of IP object;
- agreement on transferring exclusive propriety IP rights;
- other agreements on alienation of IP rights.

Important: under Ukrainian law there is an explicit prohibition on waiving moral rights. There are, however, few possible means to mitigate this statutory restriction.

## What NOBLES offers

We advise domestic and international clients in all IP issues in Ukraine, including but not limited to:

- IP audit and IP due diligences;
- Legal support related to registration, assignment and cancellation of both international and local trademarks, patent inventions, utility models, and industrial designs;
- Legal support in recognition of trademarks as well known in Ukraine;
- Structuring transactions involving assignment or acquisition of IP rights, franchising, sale-purchase and distribution agreements;
- Ensuring both judicial and non-judicial measures, in particular, vis-à-vis state courts, MEDT, AMC authorities in terms of protection and securing of IP rights;
- Assessment of IP rights, advising on taxation matters related to transactions with IP rights/objects.

