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Amendments to Ukrainian Trademark Act now in force

Amendments to the Ukrainian Trademark Act have come into force. The amendments set out procedures for the recognition of well-known marks, which until now have only been protected by the [Paris Convention for the Protection of Industrial Property](#). It further states that the acts of preparation prior to an act of trademark infringement may also infringe that mark. A new fee structure for trademark registration has also been announced.

The amendments introduce the concept of well-known marks into Ukrainian law for the first time. Previously, all legal issues involving well-known marks were regulated by the Paris Convention and there was no government body authorized to grant a mark with well-known trademark status. Following the implementation of the amendments, the courts and the Patent Office's Board of Appeals are now authorized to recognize marks as well-known trademarks.

The amendments set out a number of criteria for determining whether a mark should benefit from well-known trademark status. The evidence to be taken into consideration includes:

- ⚡ the trademark's level of repute within the relevant consumer or industry segment;
- ⚡ the duration and geographical area covered by the mark's registration;
- ⚡ the duration, volume and geographical area of use of the trademark;
- ⚡ the duration, volume and geographical area of the marketing of the trademark, including advertising and exhibitions; and
- ⚡ an indication that the mark owner has successfully protected its mark on previous occasions.

The amendments also outline new rules expanding the definition of what constitutes an 'infringing act'. An infringing act now includes all acts of preparation prior to an act of trademark infringement. As a result, a trademark owner can request a court to protect its rights if it becomes aware of another party's acts of preparation that will lead to infringement of its trademark. In such cases, it can request injunctions and orders of seizure from the court to prevent the infringing party from violating its rights.

A further addition to the Trademark Law is the withdrawal of provisions for obligatory registration of licensing agreements and assignments. Such registration is now on a voluntary basis.

The amendments also set out the circumstances in which a trademark owner cannot prevent third parties from using its mark. These include:

- ⚡ use that started before the mark owner filed its application for registration or before the priority date;
- ⚡ use on goods that were first introduced on to the market by the trademark owner (exhaustion of trademark rights);
- ⚡ use involving geographical indications;
- ⚡ non-profit-making use; and
- ⚡ use of the mark in news coverage.

A new official fee structure has also come into force. A ministry decree has increased all official trademark registration and procedural fees. For example, the official fee for filing a trademark application has risen from \$300 to \$450 for three international classes.

