

Comments from Ukraine concerning some areas of convergence of positions pointed out in WIPO documents SCT/35/4 and SCT/36/5

Ukraine supports the efforts made by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) in identifying the areas of convergence of positions of the SCT members on legislative norms and approaches to the protection of country names against their registration as trademarks, as well as any initiative directed at studying the actual practice of the offices carrying out examination of applications for registration of trademarks which consist of country names or contain such names.

To help search for solutions which will contribute to appropriate protection of country names against their registration and use as trademarks, and reach a consensus by the SCT members on the given matter, Ukraine is providing the following comments concerning the areas of convergence of positions pointed out in documents SCT/35/4 and SCT/36/5.

*Possible area of convergence № 1 «Notion of Country Name»*

Ukraine supports all the kinds of country names covered by the notion of country name defined on the basis of the WIPO Questionnaire Concerning the Protection of Names of States Against Registration and Use as Trademarks (document SCT/23/4).

*Possible area of convergence № 2 «Non-registrable if Considered Descriptive»*

In accordance with the current legislation of Ukraine, trademarks are not registered which consist solely of designations or data that are descriptive as used in relation to the goods and services designated in the application or in connection with them, in particular indicate the place and time of manufacture or sale of the goods or provision of the services. This ground is used mostly for the particular place of manufacture of the goods or provision of the service. This having been said, the position such designation has in the trademark is assessed.

Along with that, the national legislation of Ukraine provides for a separate ground for refusal of registration of a trademark containing an official country name. However, such name may be included in a trademark as a non-protectable element provided that consent has been given by a correspondent competent authority.

Yet, such ground does not exclude that a trademark is examined as for its distinctiveness.

Along with this, the Ukrainian legislation does not provide that the said ground applies to the country name in an adjectival form. Instead, if a claimed trademark contains a country name in an adjectival form, examination checks whether such trademark is misleading with regard to the geographical place of origin of the goods or services.

In the absence of a specific ground for refusal of registration of a trademark containing an official country name, Ukraine agrees with the mentioned possible area of convergence № 2 that a trademark consisting solely of a country name is non-registrable, if this name is descriptive of the place of origin of the goods and services.

*Possible area of convergence № 5 «Invalidation and Opposition Procedures»*

Ukraine supports the possible area of convergence of positions № 5 which states that the ground for refusal of registration of a trademark indicated in the possible area of convergence of positions № 2 should constitute grounds for invalidation of a registered trademark and also grounds for opposition against the trademark registration. The same mechanism is provided for by the Ukrainian legislation.

*Possible area of convergence № 6 «Use as a Mark»*

The legislation of Ukraine on trademarks does not contain any specific provisions on the prohibition of use of trademarks likely to deceive the general public, in particular, concerning the geographical origin of the goods and services, as such trademarks are non-registrable according to the legislation, and if they have been registered, the certificates for their registration are to be invalidated.

However, if the producer of the goods, while using indications on the market, provides information misleading to the customer, in particular, containing deceptive data on the origin of the goods, such activity is deemed to be unfair competition and is to be prohibited in accordance with the legislation of Ukraine on unfair competition.

Ukraine supports position № 6 and considers that interested parties should have access to appropriate legal means to prevent the use of country names if such use is likely to deceive the public as to the geographical place of origin of the goods and services.

