



Study Question

Submission date: June 22, 2017

Sarah MATHESON, Reporter General
Jonathan P. OSHA and Anne Marie VERSCHUUR, Deputy Reporters General
Yusuke INUI, Ari LAAKKONEN and Ralph NACK, Assistants to the Reporter General

Bad faith trademarks

Responsible Reporter: Anne Marie VERSCHUUR

National/Regional Group	Ukraine
Contributors name(s)	Oleksandr Mamunya, Anastasia Mindrul
e-Mail contact	mail@aippi.org.ua

I. Current law and practice

Bad faith - prior third party use or filing

1 Does your Group's current law provide for an action against the application or registration for a trademark in a jurisdiction by a party (Party A), if that trademark or a similar sign is already used in one or more jurisdictions by another party (Party B), but is not registered in the jurisdiction where Party A has filed the trademark?

If yes, please answer questions 2) – 7). If no, please go to question 8).

No

Please Explain

The Ukrainian trademark legislation does not provide such ground for application refusal or registration invalidity as use of a trademark or a similar sign in one or more jurisdictions by another party without registration of this trademark or a similar sign in Ukraine.

2 Is the application or registration as described under question 1) above denoted as "bad faith"? If not, what is it called?

3 Are the following factors relevant for proving an application or registration as described under question 1) in your jurisdiction?

Please tick or fill in all boxes as applicable to your jurisdiction. If you select "other", please describe further.

4 Is any one or more of the above factors sufficient on their own, or will the assessment instead always take the specific circumstances of the case into account? If one or more of those factors are sufficient on their own, please identify those factors.

5 Which of the following factors are relevant to establishing whether there was or should have been knowledge as described under question 3) above?

Please tick or fill in all boxes as applicable to your jurisdiction. If you select "other", please describe further.

6 Is the degree of similarity between the signs relevant? Please explain why in either case.

7 Is the degree of similarity between the goods/services relevant? Please explain why in either case.

Repeat filings

8 Can the filing of a trademark in your Group's jurisdiction by a trademark owner for a trademark identical or similar to a trademark it already owns in that jurisdiction be refused or cancelled on the ground that the previous trademark fails to meet applicable genuine use requirements?

If yes, please answer questions 9) -11). If no, please go to question 12).

No

Please Explain

The non-use of the previous trademark by its owner cannot be considered a ground for refusal or cancellation of a trademark identical or similar to such previous trademark it already owns in Ukraine.

9 Is the application or registration as described under question 8) above denoted as "bad faith"? If not, what is it called?

10 Which of the following factors are relevant when assessing whether a trademark as described under question 8) should be refused or cancelled?

Please tick or fill in all boxes as applicable to your jurisdiction. If you select "other", please describe further.

11 Are the answers to questions 8) -10) above different if the previous trademark is no longer in force? Please explain.

Defensive marks

12 Is it permissible under your Group's current law to file a trademark if the trademark owner does not have any intent to use that trademark for part or all of the goods/services claimed? If not, is there a timeframe (and if so, what) for such intention to use (e.g. must the intent be to start use immediately)?

If yes, please answer question 13). If no, please go to question 14).

No

Please Explain

It is not forbidden by the Ukrainian legislation to file a trademark application if the trademark owner does not have any intention to use that trademark. At the same time, in case a trademark has not been used within three years as from the date of an official publication of information on the trademark certificate or as from another date after such publication, any person may bring legal action for early termination of such trademark for part or all of the goods/services claimed. However, a trademark registration may not be cancelled due to non-use if the trademark might not be used due to good reasons, such as:

- (i) circumstances preventing from use of a trademark regardless of the will of the trademark owner (e.g. restriction of imports or other legislative requirements on goods and services); or
- (ii) possibility of deception regarding a producer of goods/services caused by use of the disputed mark by the plaintiff or another person.

For the purposes of the above provision, the use of a trademark by another person under control of the trademark owner shall also be deemed use of a trademark.

It should also be noted that in order to perform its obligations under the Ukraine–European Union Association Agreement, Ukraine shall improve and amend its legislation, inter alia, in the sphere of trademark protection. Namely, the term of trademark non-use giving reason to cancellation action shall be increased to five years.

13 Is the application or registration as described under question 12) above denoted as "bad faith"? If not, what is it called?

Other

14 Does any other conduct in respect of trademarks, as an independent ground for action, amount to bad faith ¹⁶ under your Group's current law? If so, what conduct and how is it denoted, ie as "bad faith" or something else?

¹⁶ Including fraud within the context of this Study Question, as explained on p. 1 at paragraph 5.

Bad faith is not considered an independent ground for trademark refusal or cancellation in Ukrainian legislation. At the same time, Article 6septies of the Paris Convention is used in opposition proceedings or cancellation court proceedings against the trademarks filed/registered in bad faith by the agent or representative of the person who is the owner of a mark in other countries without such owner's authorization.

Type of proceedings

15 In which proceedings can the grounds, insofar as they are available under your Group's current law, described in your response to questions 1), 8), 12) and 14) above be invoked in your jurisdiction?

Please tick or fill in all boxes as applicable to your jurisdiction. If you select either of the last two boxes, please describe further.

- other

Please Explain

A trademark application may be refused by the Ukrainian PTO if during the opposition proceedings it is proved by the opponent that, inter alia, (1) a trademark may mislead customers as to the goods, services, or the person that produces goods or renders services, or (2) a trademark is identical or misleadingly similar to such an extent that it can be confused with: (a) marks that were earlier registered or filed for the registration in Ukraine on behalf of another person for identical or similar goods and services; (b) marks recognised well-known in Ukraine; (c) trade names that are known in Ukraine and belong to other persons who have acquired the right to the said names before the date of filing a trademark application with respect to identical or similar goods and services.

The same grounds are stipulated by the Ukrainian legislation for trademark cancellation action before the court.

Non-use trademark cancellation actions are also considered by the courts.

II. Policy considerations and proposals for improvements of your current law

6.a Could any of the following aspects of your Group's current law be improved?

The possibility of taking action against the application or registration of a trademark in a jurisdiction by a Party A, if that trademark or a similar sign is already used in one or more jurisdictions by a Party B, but is not registered in the jurisdiction where Party A has filed the trademark

Please tick or fill in only the applicable box. If you select "yes", please explain.

Yes

Please Explain

It would be worth providing for in the Ukrainian legislation a possibility of opposition proceedings and/or taking cancellation action against the application or registration of a trademark by a Party A, if that trademark or a similar sign is already used in one or more jurisdictions by a Party B and is known, but not registered in Ukraine.

6.b Could any of the following aspects of your Group's current law be improved?

The possibility of taking action against or refusing the refiling of a trademark by a trademark owner as described above under question 8) above

Please tick or fill in only the applicable box. If you select "yes", please explain.

No

Please Explain

6.c Could any of the following aspects of your Group's current law be improved?

The possibility of taking action against or refusing the filing of a trademark by a trademark owner without an intent to use such for part or all of the goods/services claimed as described above under question 12) above.

Please tick or fill in only the applicable box. If you select "yes", please explain.

No

Please Explain

6.c Could any of the following aspects of your Group's current law be improved?

The possibility of taking action against other conduct as described in your response to question 14) above.

Please tick or fill in only the applicable box. If you select "yes", please explain.

No

Please Explain

17 Are there any other policy considerations and/or proposals for improvement to your current law falling within the scope of this Study Question?

It is indispensable to enshrine in the Ukrainian legislation the trademark refusal or invalidation on the grounds of bad faith to enable right holders to challenge trademarks filed in bad faith.

Proposals for harmonisation

18 Does your Group consider that harmonisation in any or all of the four areas described in question 16) above is desirable?

If yes, please respond to the following questions without regard to your Group's current law.

Even if no, please address the following questions to the extent your Group considers your Group's current law could be improved.

Yes

Please Explain

Yes, the harmonization of legislation in the sphere of the bad faith trademark applications and registrations is desirable in Ukraine.

19 Does your Group consider there should be a harmonised definition of bad faith?

Please tick or fill in only the applicable box. If you have different reasons for selecting "no" or "yes" to those identified, please explain.

No; identifying circumstances that can be relevant in assessing whether the types of conduct identified above under question 16) are allowed can be helpful, but a definition as such does not allow sufficient flexibility

Please Explain

Bad faith - third party use or filing

20 Should it be possible to take action against the application or registration for a trademark in a jurisdiction by a Party A, if that trademark or a similar sign is already used in one or more jurisdictions by a Party B, but is not registered in the jurisdiction where Party A has filed the trademark?

If yes, please answer questions 21) – 25). If no, please go to question 26).

Yes

Please Explain

Yes, such ground should be provided, but only as to the foreign trademarks known in Ukraine and in the course of opposition proceedings and/or cancellation action where trademark owner may provide the evidence of its mark registration and wide use in other jurisdictions, as well as awareness of the applicant about this trademark.

21 Which of the following should be relevant factors for proving an application or registration as described under question 20)?

Please tick or fill in all relevant boxes. If you select "other", please describe further.

- Party A knows, or should reasonably be aware, of use of an identical or similar sign abroad for identical goods or services

Please Explain

- Party A knows, or should reasonably be aware, of use of an identical or similar sign abroad for similar goods or services

Please Explain

- Party A knows, or should reasonably be aware, of use of an identical or similar sign in the same jurisdiction for identical goods or services

Please Explain

- Party A knows, or should reasonably be aware, of use of an identical or similar sign in the same jurisdiction for similar goods or services

Please Explain

- Party A intends to prevent Party B from continuing to use the earlier sign or to only allow such under certain conditions (e.g. a license)

Please Explain

- the degree of legal protection enjoyed by Party B's sign and the sign used by party A

Please Explain

22 Should any one or more of the above factors be sufficient on their own, or should the assessment instead always take the specific circumstances of the case into account? If one or more factors should be sufficient on their own, which should they be?

The specific circumstances of each case should be taken into account and all the above-listed factors should be assessed when establishing the fact of acting by the applicant in bad faith.

23 Which of the following should be relevant when establishing whether there was or should have been knowledge as described above under question 21) above?

Please tick or fill in all relevant boxes. If you select "other", please describe further.

- whether Party A operates in the same or a similar field of business as Party B

Please Explain

- whether the earlier sign is well known or enjoys a reputation

Please Explain

- whether there have been formal or informal dealings or contact between Party A and B (such as an agreement, written communication etc.)

Please Explain

24 Should the degree of similarity between the signs be relevant? Please explain why or why not.

Yes

Please Explain

Establishing the degree of similarity between the trademarks is important, since the more similarity between the two marks, the more likely the consumer confusion.

25 Should the degree of similarity between the goods/services be relevant? Please explain why or why not.

Yes

Please Explain

The degree of similarity between the goods/services is significant, as it also defines the likelihood of confusion between the identical/similar trademarks.

Repeat filings

26 Should it be possible to refuse or cancel the filing by a trademark owner of a trademark identical or similar to a trademark it already owns in your Group's jurisdiction on the grounds that it fails to meet applicable genuine use requirements?

If yes, please answer questions 27) – 28). If no, please go to question 29).

No

Please Explain

It could be worth providing the ground only for cancellation action of a trademark identical or similar to a trademark previously registered in Ukraine by the same owner if the previous trademark was not used in Ukraine for a specified period of time and the repeated application was filed to block others from entering the market or to keep open the option for the trademark owner to enter the market at a later stage.

According to the current Law, there are no provisions according to which the applicant shall confirm his intend to use or actual use of the applied mark. Thus, in our opinion such ground should not be used for trademark application because it may lead to unreasonable blocking and delay in the course of obtaining of the trademarks protection.

27 Which of the following factors should be relevant when assessing whether a trademark as described under question 26) above should be refused or cancelled?

Please tick or fill in all relevant boxes. If you select "other", please describe further.

28 Should the answers to questions 26) - 27) above be different if the previous trademark is no longer in force? if so, how?

Defensive marks

29 Should it be permissible to file a trademark if the trademark owner does not have any intent to use that trademark for part or all of the goods/services claimed? If not, should there be a timeframe (and if so, what) for such intention to use (e.g. must the intent be to start use immediately)? Please explain.

In our opinion, it is not expedient to confirm the intent to use the trademark in the course of filing of the application. The timeframe for such

intention to use should coincide with the non-use grace period, established by the Law.

Other

30 Should any other conduct in respect of trademarks, as an independent ground for action, amount to bad faith ¹⁷? If yes, please explain.

¹⁷ Including fraud within the context of this Study Question, as explained on p. 1 under paragraph 5 above.

/

Type of proceedings

31 In which proceedings should it be possible to invoke the grounds described in your response to questions 20), 26), 29) and 30) above, insofar as they should be grounds for action in your view?

Please tick or fill in all boxes. If you select either of the last two boxes, please describe further

- opposition proceedings (before the trademark/IP office)

Please Explain

- court proceedings concerning a bad faith registration

Please Explain

Other

32 Please comment on any additional issues concerning bad faith (or equivalent concepts) in the context of trademark law you consider relevant to this Study Question.

To decrease the number of the trademarks filed in bad faith, it could be worthwhile to consider providing for in the Ukrainian legislation the right to claim damages or specified compensation for trademark infringement by bad faith application or registration.

Please indicate which industry sector views are included in part "III. Proposals of harmonization" on this form:

Please enter the name of your nominee for Study Committee representative for this Question (see Rule 12.8, Regulations of AIPPI). Study Committee leadership is chosen from amongst the nominated Study Committee representatives. Thus, persons not nominated as a Study Committee representative cannot be in the Study Committee leadership.