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01
THE FACTS:
BUSINESS IN UKRAINE FOR EU COMPANIES

SIZE of market

EU goods and services exported to Ukraine in 2013:
€23,942 m

EU goods and services exported from Ukraine in 2013:
€13,820 m

Total EU-UA trade in goods and services in 2013:
+€10,149 m

Ukraine GDP in 2013:
€133.6 bn

Ukraine GDP growth:
+2% in 2012/2013; -15.20% from 2013 to Q3 2014

Further information:
http://economics.com/gdp-annual-growth-rate-ukraine-euro-area

Key INDUSTRY SECTORS

The EU is Ukraine’s largest trading partner. The main EU exports to Ukraine are machinery, chemicals, and agriculture and food products while Ukraine’s key exports to the EU include agriculture and food products, metallurgy and mineral products. The key sectors in Ukraine requiring particular IP attention are pharmaceuticals, agrichemicals, software, consumer electronics and the music and film industries.
02
IPR in Ukraine for SMEs:
BACKGROUND

Intellectual Property Rights for SMEs: Why is this RELEVANT to you?

Protecting your intellectual property assets in Ukraine is one of the key ways in which you can expand your business into Ukraine successfully and safely. European SMEs report faster growth and higher income and employment when they use intellectual property rights (IPR).

IPR give SMEs a competitive advantage, increasing market share by granting them the exclusive rights to use their IP assets as well as authorising others to use them. Embedding unique technologies in your products will attract more customers and make your company stand out from your competitors. You will also be more attractive to investors and business partners as your IP portfolio will show that your company is a reliable partner with a high level of competence and an innovative approach. You can also grant licences to others to use your IPR and trade secrets in return for payment or you can enter into a cross-licensing agreement with others who own the solutions your business needs, using those rights as a medium of exchange.

If you don’t protect and manage your IP assets properly in Ukraine, you will risk not only IPR infringements but also taking your products out of this market.

In other words, if you do not register your IPRs, competitors will be able to offer the same products using your IP and sell them at a lower price. Moreover, they will be able to register your IPR objects as their own and use them against you. This, in turn, can cut into your market share and substantially reduce your trade turnover.

How does Ukraine’s IP legal framework compare with INTERNATIONAL STANDARDS?

On 16 May 2008, Ukraine became a member of the World Trade Organization, as a result of which it is now a party to the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement). Ukraine has ratified major international treaties in the IP field that have effect in Ukraine, including:

- Paris Convention for the Protection of Industrial Property
- Patent Cooperation Treaty
- International Convention for the Protection of New Varieties of Plants
- Hague Agreement Concerning the International Registration of Industrial Designs
- Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks

2 – Trade secrets are IP assets which are not registered, see point 3F on “trade secrets” below
In 2014, Ukraine ratified the Association Agreement between the EU and Ukraine, which means that Ukraine must ensure an adequate level of effective protection and enforcement of IPR. There has been considerable progress in recent years, in particular in IP legislation, but Ukraine is expected to improve its legislation even further in a number of areas, including geographical indications, designs, trade marks, data protection for pharmaceuticals, enforcement measures (including at its borders) and the liability of internet service providers.

IP TIPS and WATCH-OUTS in Ukraine

a. Trade mark and patent protection is territorial, which means that trade mark certificates and patents issued in other countries are not enforceable in Ukraine. In view of this, we recommend that you (1) check that the brands you use to identify your company and products, and other intangible assets do not violate the IPR of other companies in Ukraine and (2) file trade mark and patent applications in Ukraine to protect your IPR.

b. Ukraine applies a first-to-file system for registering IPR. In view of this, we strongly recommend that you register your IP assets before expanding your business into Ukraine. To save time and money, it is also worth conducting a preliminary search before filing the application to find out whether your IPR assets are protectable.

c. Despite the fairly solid legislative basis in most areas of IP, the overall IPR environment in Ukraine is fairly weak, mainly owing to a lack of enforcement. Enforcement issues range from widespread online piracy of music and films to the use of illegal software by government agencies, a non-transparent system of collecting and distributing music royalties and the non-payment of royalties by state TV and radio broadcasters. The counterfeit goods market consists not only of fake consumer goods (such as bags and shoes) but also, and of more concern, counterfeit agrochemicals and pharmaceuticals, which can have a serious detrimental effect on consumer health and safety.
The Basics

IP Rights in Ukraine: A - Trade Marks

What are Trade Marks?

Trade marks are signs that can be used to distinguish one company’s goods and services from those of another. Any sign or any combination of signs can be registered as a trade mark in Ukraine. These can be words (including people’s names), letters, numbers, pictures, colours (and combinations of colours), or any combination of these. You can also register labels and three-dimensional figures as trade marks.

Non-traditional designations are not prohibited under Ukrainian law although tastes and smells are not registered as trade marks in Ukraine as it is not technically possible to enter them in the Register and therefore make information on their registration available to the public. However, you can register sounds as a trade mark in Ukraine if they can be graphically represented by a musical notation.

Trade Marks in Ukraine: What you need to know

According to the Trademark Act of Ukraine, legal protection is not possible for marks that:

1) contravene public order, principles of humanity and morality;

2) represent or imitate: (a) state armorial bearings, flags and other state symbols (emblems); (b) official names of states; (c) emblems and abbreviated or full names of international intergovernmental organisations; (d) official signs and hallmarks indicating control and warranty, assay marks, seals; or (e) awards and other distinctions of honour;

3) are usually devoid of any distinctive character and have not obtained distinctive character as a result of use;

4) consist exclusively of signs that are commonly used as the signs for goods and services of a certain kind;

5) consist exclusively of signs or data that are descriptive of the goods and services of the application, in particular signs or data that indicate the kind, quality, composition, quantity, properties, purpose, or value of the goods and services, or the place and time the goods or services were manufactured or sold;

6) are likely to mislead the public about the goods or services, or the person producing or providing them;

7) consist exclusively of signs that are commonly used symbols and terms; or

8) solely reflect the natural state of goods, or are caused by the need to obtain a specific technical result, or reflect the form that gives goods a significant value.
You cannot register the following signs as trade marks:

1) signs that are identical or misleadingly similar so that they could be confused with: (a) marks that were registered earlier or filed for registration in Ukraine on behalf of another person for identical or similar goods and services; (b) marks owned by other persons if these are protected without being registered under an international agreement to which Ukraine is a party, in particular marks recognised as well known; (c) trade names that are known in Ukraine and belong to persons who acquired the right to them before a trade mark application for identical or similar goods and services was filed; or (d) the qualified indication of the origin of goods (including wines and spirits);

2) signs that reproduce industrial designs if the rights to these belong to other persons in Ukraine;

3) signs that reproduce the titles of scientific, literary and artistic works known in Ukraine or quotations and characters from these, as well as artistic works and excerpts from them without the consent of the copyright holders or their legal successors; or

4) signs that reproduce the names, pseudonyms, portraits and facsimiles of persons known in Ukraine without their consent.

Bearing in mind that Ukraine is a signatory to the Paris Convention, an applicant can claim the priority of a previous application for the same trade mark within six months of the date the previous application was filed in a state that is a party to the Paris Convention, provided that priority for the earlier application has not been claimed.

**HOW LONG does legal protection last?**

A Ukrainian trade mark certificate is valid for 10 years and can be renewed for subsequent 10-year periods by filing a request for renewal with the Ukrainian PTO and paying the official fee.

**HOW do I register?**

You will need the following documents and information if you want to file a trade mark in Ukraine: your full name, country of incorporation, address and WIPO country code; an image and description of the mark you are claiming; a description if the mark contains a word element; an indication of the colour of the trade mark; the list of goods and/or services being applied for under the relevant Nice International Classification; the date, country and number of the priority application or date of exhibition (if claiming priority under the Paris Convention); a certified copy of the priority application or document confirming the display of exhibits incorporating the trade mark applied for at an officially recognised international exhibition; and a power of attorney signed by an authorised person on behalf of the applicant.

The registration process is as follows:

1) Filing the application. If your application documents comply with the requirements, you will be notified of the filing date.

2) Preliminary (formal) examination. The documents you submitted are checked to ensure they comply with the formal requirements of the Ukrainian Trademark Act. If your application is in compliance, there is then an examination on the merits.

3) Substantive examination. Your trade mark application is checked to see whether it is eligible for protection, as specified by Ukrainian law. Searches for identity and similarity are carried out.
4) Trade mark registration, issuing the Certificate and publication in the official bulletin. If the trade mark is consistent with all the required criteria, a decision is issued granting trade mark registration. Once you have paid the fees, you will receive the trade mark Certificate and the trade mark registration will be published in the official bulletin.

You should file your trade mark application with the Ukrainian Institute of Industrial Property (the Ukrainian PTO), which is a state enterprise managed by SIPS at the following address:

State Enterprise 'Ukrainian Institute of Industrial Property'
1 Hlazunova Str., Kyiv-42, 01601
Tel.: +380 (44) 494 05 94
Fax: +380 (44) 494 05 35

You can also register a trade mark in Ukraine by filing an international application designating Ukraine under the Madrid Agreement or the Madrid Protocol.

WHO can register?

Any Ukrainian or foreign individuals or legal entities can file a trade mark application in Ukraine. Foreigners have to use a Ukrainian registered attorney for filing applications and will need to give power of attorney to the patent attorney they select.

Which LANGUAGES can I use?

Trade mark applications and all accompanying documents should be in Ukrainian.

How much does it COST?

If a single applicant wants to register a straightforward trade mark that consists of a single black and white (i.e. without claiming a colour) trade mark claimed in a single international class, the basic fee is approximately EUR 230. This covers the filing fee, the official duty for the trade mark certificate and the publication fee.

Trademark TIPS and WATCH-OUTS in Ukraine

Generally speaking, the Trademark Act protects only registered marks. As an exception, marks not registered in Ukraine, but recognised as well known by the courts or SIPS Board of Appeals are protected. Unregistered trade mark rights can also be enforced under the unfair competition law.

If a mark has not been used within three years of the date of official publication of information about the trade mark certificate, anyone can bring a cancellation action or part cancellation action (with regard to some goods and/or services) for non-use. However, a trade mark registration cannot be revoked if there were good reasons for the trade mark not being used, such as: (i) circumstances preventing a trade mark being used even though the trade mark owner wished to do so (e.g. import restrictions on goods and services or other legislative requirements); or (ii) the possibility of deception caused by the use of the disputed mark by the plaintiff or another person, which includes the use of a trade mark by another person under the control of the trade mark owner.
B - Geographical indications

Geographical indications are usually used for agricultural products, foodstuffs, wines and spirits, and industrial products. In Ukraine, there are two ways of indicating the origin of goods: simple indications and qualified indications.

A simple indication covers any designation — word or image — that directly or indirectly points to a geographical place of origin of the goods. This can be the name of a geographical place informing customers about the place of origin of the goods (e.g., ‘made in Ukraine’). The legal protection of a simple indication of origin is based on its use and prohibits the use of indications that are not true (false) or mislead consumers as to the real geographical place of origin of the goods. A simple indication of origin of goods does not therefore need to be registered.

Qualified indications can be appellations of origin or geographical indications. An appellation of origin is a geographical place name used for goods originating from that place and which have particular properties as a result of the natural conditions in that place or as a result of these natural conditions in combination with human factors specific to that place. Geographical indications, on the other hand, are words or images that directly or indirectly point to a geographical place with particular properties, reputation or other characteristics that are essentially due to the natural conditions specific to that place, to the human factor or to a combination of the two.

You can obtain legal protection in Ukraine for a qualified indication of origin of goods by registering them. You should file your application with the Ukrainian PTO at the following address:

State Enterprise 'Ukrainian Institute of Industrial Property'
1 Hlazunova Str., Kyiv-42, 01601
Tel.: +380 (44) 494 05 94
Fax: +380 (44) 494 05 35

Your application will need to be in Ukrainian and must contain the following documentation:

- a request to register the appellation of origin of goods or the geographical indication of origin of goods or the right to use the registered qualified indication of origin of goods with information about the applicant and their address;
- the appellation of origin of the goods you are claiming or the geographical indication of origin of the goods you are claiming;
- the name of the goods for which you are requesting registration of the specified indication of origin or the right to use the registered qualified indication of origin;
- the name and boundaries of the geographical place where the goods are manufactured and to which the particular properties, qualities or reputation relate;
- a description of the particular properties, qualities, reputation or other characteristics of the goods;
- data on the use of the claimed qualified indication of origin of goods on the label and in marking goods;
- data on how the particular properties, qualities of reputation of goods are connected to the natural conditions or human factor of the geographical place specified.
You will need to file the following documents along with your application:

- a document confirming that you manufacture goods for which you are claiming registration of the appellation of origin or the geographical indication of origin of goods and/or the right to use the registered qualified indication of origin;

- the opinion of a competent authority stating that the particular properties, qualities or other characteristics of the goods in the application are objectively the result of, or related to, the natural conditions and/or human factor of the geographical place of production of the goods that you have specified;

- the opinion of a competent authority on the boundaries of the geographical place to which the particular properties, qualities or other characteristics of the goods relate.

As a foreign applicant, instead of filing the above documents, you will need to file the following documents along with your application, confirming:

- the legal protection in the relevant foreign state of the qualified indication of origin of goods that you are claiming;

- the right of the foreign applicant to use the qualified indication of origin of goods.

You can file the documents in a foreign language and submit a translation into Ukrainian no later than three months from the filing date of the application. Once it has received your application and supporting documents, the Ukrainian PTO will examine your application.

There is no limit to the length of time a qualified indication is protected, provided that the conditions for granting protection remain unchanged. A qualified indication certificate is valid for 10 years from the date of application and can be renewed for subsequent 10-year periods following a request filed from the certificate-holder, provided it can submit the necessary evidence that the goods are still produced in the area concerned and that their properties are the same as those listed in the Register.
C - Copyright

WHAT is Copyright?

Copyright in Ukraine protects the moral and economic rights of authors and their successors related to the creation and use of works of science, literature and art. The rights of performers, manufacturers of phonograms and videograms and broadcasting organisations are protected by "related rights".

The following works may be protected by copyright in Ukraine:

- literary written works of fiction, journalistic, scientific, technical or other nature (books, brochures, articles, etc.);
- speeches, lectures, orations, sermons and other oral works;
- computer software;
- databases;
- musical works with or without lyrics;
- dramatic, musical drama works, pantomimes, choreographic and other works;
- audiovisual works;
- works of fine art;
- works of architecture, city construction, garden and park art;
- photographic works, including works made by methods similar to photography;
- works of applied art, including works of decorative weaving, ceramics, carving, casting, of art glass, jewelry, etc.;
- illustrations, maps, layouts, drawings, sketches, plastic works relating to geography, geology, topography, engineering, architecture and other spheres of activity;
- derivative works;
- collections of works, collections of folklore versions, encyclopedias and anthologies, collections of regular data, and other composite works, provided that they result from creative work involving the selection, co-ordination or arrangement of the content without prejudice to the copyright of works which are included thereto as the integrated parts;
- texts of translations for dubbing, sound-tracking of and adding Ukrainian and other language subtitles to foreign audiovisual works;
- other works.

The following objects are not protected by copyright in Ukraine:

- daily news or current events information that are regular press information;
- works of folk art (folklore);
- official documents of a political, legislative, or administrative nature (laws, decrees, resolutions, court awards, State standards, etc.) issued by government authorities within their powers, and official translations thereof;
- State symbols of Ukraine, government awards; symbols and signs of government authorities, the Armed Forces of Ukraine and other military formations; symbols of territorial communities; symbols and signs of enterprises, institutions and organizations; bank notes;
- transportation schedules, TV and radio broadcast schedules and telephone directories and other similar databases that do not meet the originality criteria and to which the sui-generis right is applicable.

However, copyright protects only the form of expression of a work and not any ideas, theories, principles, methods, procedures, processes, systems, manners, concepts, or discoveries, even if they are expressed, described, explained or illustrated in a work.
Copyright in Ukraine: What you need to know

Ukraine is a signatory to the Berne Convention for the Protection of Literary and Artistic Works, which means that works by foreign authors are automatically protected in Ukraine if (1) the author is a national of a country that is also a party to the Berne Convention, or (2) the work was first published in a country that is a party to the Berne Convention, which in fact covers virtually all countries.

Copyright protection starts as soon as a work is created and you do not need to register it or carry out any other formalities in order to enforce the copyright. At the same time, under the Law of Ukraine ‘On Copyright and Related Rights’, you have a right to register copyright at any time during the copyright protection period in order to certify:

- the authorship (copyright),
- the fact that it has been published
- the date of publication
- any contracts relating to your right to a work.

The author's copyright comprises the moral and economic rights to the work. The author cannot transfer or assign the moral rights to other people or companies. As well as having the right to require recognition of their authorship, authors also have the right to prohibit the mentioning of their name during the public use of a work if they choose to remain anonymous. They can also choose a pseudonym and prevent any change to the work that might be prejudicial to their honour or reputation.

A copyright holder’s economic rights are transferable and cover the exclusive rights to use a work, as well as to allow and prohibit such use. These include, in particular, the reproduction, public performance and broadcast of works, public demonstration and public display of works, distribution of originals of works and their specimens, translations, amendments, adaptations and alterations of works.

If you want to use protected works, the copyright holder must authorise this unless this use is permitted by law, e.g. the free use of a work provided the author's name is indicated, free reprographic reproduction by libraries and archives and free reproduction of works for personal use.

**How long does legal protection last?**

Economic rights over copyright last for the author’s life plus an additional 70 years. The author’s moral rights are perpetual.

Performers’ rights are protected for 50 years from the date a performance is first recorded. The rights of manufacturers of phonograms and videograms are protected for 50 years from the first publication of a phonogram (videogram) or from the first sound or video recording of it if the phonogram (videogram) is not published within this period. The rights of broadcast organisations are protected for 50 years from the date a transmission is first broadcast.

**How do I register?**

The author or copyright holder can register the copyright to the work, by filing an application with the State Intellectual Property Service of Ukraine (SIPS). The registration of the copyright will serve as evidence that the work has been completed on the date indicated and its author and/or right holders are known.
Your application should include the following information and documents:

- The full name(s), address(es) and date of birth(s) of the author(s) and applicant(s);
- The title of the work;
- The date it was created;
- A document testifying that the work was published and the date it was first published, if any;
- A sample of the work in paper or electronic form;
- A description of the work;
- A document confirming that the applicant has copyright in the work (relates to successors, works made for hire, assigned copyright);
- A power of attorney, if necessary.

SIPS examines the application to make sure all the documents have been provided and that they meet the formal requirements. If everything is in order, SIPS issues a certificate of registration of copyright. This procedure usually takes 2-4 months in Ukraine.

Contact details of the State Intellectual Property Service of Ukraine are as follows:

45 Vasylia Lypkivskoho St., Kyiv-35, COS, 03680, Ukraine
Tel.: +380 (44) 498 37 08 (09,10);
Website: http://sips.gov.ua/ua/copyright_registration.html (available only in Ukrainian).

WHO can register?

The author, their legal successor, or a natural or legal person to whom the author has assigned their legal rights, in person or through an authorised representative, can file an application to register a copyright. If the application is filed through a representative, the applicant needs to draw up a power of attorney and submit it to SIPS.

Which LANGUAGES can I use?

The application to register a copyright and the accompanying documents should be in Ukrainian.

How much does it COST?

SIPS charges around EUR 3 for individuals and EUR 8 for legal entities to register a copyright and issue a certificate.

Copyright TIPS and WATCH-OUTS in Ukraine

- We recommend that you expressly specify who owns the rights to the work for hire in employment contract as Ukrainian law is inconsistent on this issue. The Law on Copyright states that the employer owns the economic rights to a work for hire whereas the Civil Code states that the copyright for such work belongs to the employee and employer jointly, unless otherwise stated in the agreement.
- Manufacturers and importers of equipment and blank media carriers used for the private reproduction of copyrighted works are required to pay import levies on copyright (manufacturing in Ukraine). There is an official list of the equipment covered and the levies...
charged. For example, the copyright levy for MP3 players, video and audio tapes is 1% of their contractual price (for importers) or selling price (for manufacturers), the levy for mobile phones and PC tablets is 0.15%, for laptops with CD/DVD-RW drives it is 0.2% and for memory cards 0.75%.

D - Patents and designs

What are Patents?

Patent is a protective document that is issued in Ukraine to confirm priority, authorship and ownership of an invention, utility model or industrial design.

Contrary to the legislation of many countries, in Ukraine the objects which can be protected as inventions or utility models are the same, namely, (1) products (devices, substances, microorganism strains, plants or cultures of animal cells, etc.) or (2) processes (methods) or the novel use of a known product or process. The major differences between inventions and utility models are in their patentability requirements, registration procedure and its timescales, and term of protection, which will be specified below.

Industrial designs cover shapes, pictures or colouring, or any combination, that define the appearance of an industrial product, are designed to meet aesthetic and ergonomic demands and comply with the patentability requirements. However, there is no industrial design protection for architecture objects (apart from small architectural structures), industrial, hydrotechnical and other fixed constructions, printed production and objects of an unstable form of liquid or gaseous, free-flowing and similar substances.

Patents in Ukraine: What you need to know

To be registered in Ukraine, the inventions, utility models and industrial designs must not be in contravention of public order, humanity or morality and must be patentable.

An invention meets the patentability requirements if it is new, involves an inventive step and is industrially applicable.

A utility model must be new and industrially applicable.

An invention or utility model is considered new unless it is part of the prior art. The prior art includes all the information that was available to the public anywhere in the world before the date the patent application was filed or, if the priority has been claimed, before the date of its priority. An invention involves an inventive step provided that it is not obvious to a person skilled in the art, i.e. an invention is not obvious from the prior art. An invention or utility model is considered industrially applicable if it can be used in industry or other field of activity.

An industrial design meets patentability conditions if it is new. It is considered new provided all of its main features were not universally accessible in the world before the date the application was filed in Ukraine or, if priority is claimed, before its priority date. In addition, in determining whether an industrial design is novel, the Ukrainian Patent and Trademark Office (PTO) looks at the content of all applications it has previously received, apart from those that are ruled to have been withdrawn on that date, those that have actually been withdrawn and those for which it has refused to grant a patent, and all recourses against such decisions have been exhausted.
Bearing in mind that Ukraine, similarly to the European Union Member States is a signatory to the Paris Convention for the Protection of Industrial Property, if you are applying for an invention, utility model or industrial design patent, you can claim a right of priority if your application for an invention or utility model patent in Ukraine is filed within twelve months of the date of filing an application in one of the states that is party to the Paris Convention, and your application for an industrial design patent is filed within six months. As a consequence, your application in Ukraine will have the same filing date as the first application filed in a member country of the Paris Convention. This is very important for establishing the novelty of an invention, utility model or industrial design.

Ukraine is also a signatory to the Patent Cooperation Treaty (PCT), which means that an applicant can decide whether Ukraine should be covered by a patent application for the registration of an invention within 31 months from the date of filing the initial patent application, the priority of which is claimed.

**HOW LONG does legal protection last?**

Patents for inventions are granted for 20 years from the date the application was filed providing the annual maintenance fees are paid.

The utility model patent lasts for 10 years from the date the application was filed providing the annual maintenance fees are paid.

Legal protection for an industrial design lasts for 10 years starting from the application date providing the annual maintenance fees are paid. It can be extended, but for no more than five years.

**HOW do I register?**

You will need to register your invention, utility model or industrial design in order to obtain protection in Ukraine. You should file your patent application with the Ukrainian PTO at the following address:

1 Hlazunova Str., Kyiv-42, 01601  
Tel.: +380 (44) 494 05 94  
Fax: +380 (44) 494 05 35

When applying to register an invention or utility model, you need to include:

- a request for a patent for an invention or utility model;
- a specification;
- claims;
- drawings (if you have referred to them in a description);
- an abstract;
- a power of attorney (if you are filing your application through an authorised representative).

Once the Ukrainian PTO has received the patent application to register your invention or utility model, it examines the application as to formalities. If your application concerns a technology object and if you have submitted all the required documents according to the requirements of the Ukrainian patent law, the PTO will then issue a conclusion on possibility to conduct the substantive examination in case of filed invention or will issue a utility model patent in case you applied for protection of the latter.
A substantive examination of the invention, which checks the patentability requirements, is conducted if the applicant requests this. It needs to be filed within three years of the date the application was filed. If the invention meets the patentability requirements, the patent is then issued.

If you are applying to register an industrial design, along with your application you will also need to file a set of images of the industrial product (the product itself or its model or drawings), which give a clear idea of the product’s appearance. You will also need to file a specification (description) of the industrial design and you can also submit drawings, schemes and maps, if necessary.

The Ukrainian PTO does not carry out the substantive examination of the industrial design; it simply checks whether the object applied for registration belongs to objects protected as industrial designs under the law, the application for registration (along with drawings, description and power of attorney) meets the formal requirements and that the required fees have been paid.

**Who can register?**

Individuals or legal entities can file patent applications. Foreigners can only file applications through registered Ukrainian patent attorneys.

**Which LANGUAGES can I use?**

Patent applications and all accompanying documents must be filed in Ukrainian. For applications filed under the Patent Cooperation Treaty (PCT), a Ukrainian translation of an application must be submitted before the expiry of the 31 month period for entry into the national phase (i.e. upon filing). The deadline for filing a translation can be extended by two months. For standard applications, a Ukrainian translation can be submitted within two months of the filing date, which means that the application can be filed in the original language first.

**How much does it COST?**

If you are filing a patent application for an invention (utility model) containing up to three claims, this will cost around EUR 35 in fees. The fee for each additional claim is around EUR 4.

If you are filing a request for a patentability examination of an invention, the fee for a single stand alone claim will be around EUR 125. The fee for each additional stand alone claim will be around EUR 125. The official fees for publishing registration data and issuing a patent are around EUR 100.

You will need to pay the following annual maintenance fees (annuities) for your patents for inventions and utility models to remain valid:
The official fee for filing an industrial design application containing one variant will be approx. EUR 35; the fee for issuing an industrial design patent will be approx. EUR 100.

The following annual maintenance fees (anuities) are established for industrial design patents:

<table>
<thead>
<tr>
<th>Years 1 to 2 (inclusive)</th>
<th>5.00 (for each year)</th>
</tr>
</thead>
<tbody>
<tr>
<td>Year 3</td>
<td>9.00</td>
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<tr>
<td>Year 4</td>
<td>13.00</td>
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<tr>
<td>Year 5</td>
<td>20.00</td>
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<tr>
<td>Year 6</td>
<td>31.00</td>
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<tr>
<td>Year 7</td>
<td>39.00</td>
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<tr>
<td>Year 8</td>
<td>52.00</td>
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<tr>
<td>Years 10 to 12 (inclusive)</td>
<td>78.00 (for each year)</td>
</tr>
<tr>
<td>Years 13 to 15 (inclusive)</td>
<td>144.00 (for each year)</td>
</tr>
</tbody>
</table>
Patent TIPS and WATCH-OUTS in Ukraine

You, as the rights holder, can ask to have your patent protection for medicines or products for plants and animals protection, for the use of which a permit of the relevant authorising body is required, extended for a period equal to the period between the date the application was filed and the date the permit was received, up to a maximum of five years. This is known as a supplementary protection certificate (SPC).

The same designs can be protected by the laws on industrial design, copyright, trade mark and unfair competition, all at the same time, if the industrial design concerned meets the conditions for protection laid down by each of the laws. Even though the protection periods are different, if one IPR has expired, the industrial design continues to be protected by other IPRs that have not yet expired.

The Ukrainian PTO does not conduct a substantial (novelty) examination of utility models and industrial designs and so these patents are registered with no guarantee that these rights are valid. That is the responsibility of their owners.
WHAT are Plant Varieties?

Ukrainian law follows the International Convention for the Protection of New Varieties of Plants and provides protection for plant varieties. The protection right can be acquired for embodiments of a variety such as a clone, line, first-generation hybrid and population. It sets out the acquisition, protection and enforcement of intellectual property rights to plant varieties in Ukraine.

The State Veterinary and Phytosanitary Service of Ukraine (SVPS) is the competent authority for registering plant varieties.

Plant Varieties in Ukraine: What you need to know

You can acquire the following rights to varieties:

- **Personal, non-proprietary IPR to a plant variety (authorship)** – these must have a certificate of authorship and they must belong to the author (breeder) who bred the variety. Personal non-proprietary rights include: 1) authorship; 2) the right of a breeder to include its own name in the variety name; 3) right to a variety name.

- **Proprietary IPR to a plant variety** – can be acquired if the variety is new, distinct, uniform and stable according to the display of characteristics generated by a particular genotype or combination of genotypes. These must be certified by a patent and the patent holder has the exclusive right to use a variety and to authorise or prohibit the use of this variety by other persons;

- **Proprietary IPR to distribute a plant variety** – can be acquired if the variety does not meet the criteria of novelty, but is distinct, uniform and stable, has a name and is suitable for distribution in Ukraine (can satisfy the needs of society, does not threaten the life and health of people, does not harm plant and animal life, environment). These rights must be certified by registering them with the State Register of Plant Varieties Suitable for Dissemination in Ukraine and by a certificate of state registration of the variety. They can belong to their author or to others under contract or under the law (e.g. to an employer or an assignee). The certificate holder is entitled to distribute a variety and to authorise or prohibit its use by others.

If you are a plant variety patent holder, you can transfer your property rights to the variety to any person who is your successor by means of a contract. You can also issue a permit (licence) to another person to use the variety under a licensing agreement.

HOW LONG does legal protection last?

Personal, non-proprietary rights to a plant variety are in perpetuity and not transferrable. Proprietary IPR to a plant variety start on the registration date and expire on the last day of the 35th calendar year for varieties of trees, shrubs and vines and the 30th calendar year for all other varieties, calculated from the year following the year of registration, provided the annual fees are paid.

HOW do I register?

The SVPS decides whether to grant a proprietary IPR to a plant variety. The application for registration must include the following documentation:

1. The application form for the plant variety, containing general information about the variety as well as about the breeder(s), applicant(s), representative, etc.;
2. A technical questionnaire about the variety’s characteristics;
3. Indicators of the suitability of the variety for distribution;
4. Information on the origin of the variety;
5. Information about other applications for the variety;
6. Information on the commercial use of the variety;
7. A copy of the priority application, if any;
8. A power of attorney (if the application is filed through an authorised representative);
9. Other information/documents required by the state authority concerned.

The State Veterinary and Phytosanitary Service of Ukraine conducts the formalities check and the substantive examination of the application. It then issues a decision, which can in turn be subject to an appeal. The registration decision is published in the State Register of Patents or the State Register of Plant Varieties.

**WHO can register?**

Anyone can register plant varieties in Ukraine. Applications can be submitted both by the author and the employer or their successors.

**Which LANGUAGES can I use?**

The application must be submitted in Ukrainian. If you are applying in a foreign language, you must submit an official translation.

**How much does it COST?**

<table>
<thead>
<tr>
<th>PATENTS FOR INVENTIONS</th>
</tr>
</thead>
<tbody>
<tr>
<td>1. For filing an application for a plant variety</td>
</tr>
<tr>
<td>2. For the substantive examination of an application for a plant variety (for the first and each subsequent year of examination):</td>
</tr>
<tr>
<td>– determining whether a variety is distinct, uniform and stable</td>
</tr>
<tr>
<td>– assessing whether a variety is suitable for dissemination</td>
</tr>
<tr>
<td>3. For intellectual property rights to a variety distribution</td>
</tr>
<tr>
<td>4. For issuing a certified copy of a certificate attesting the state registration of a plant variety</td>
</tr>
<tr>
<td>5. For issuing a certified copy of a patent for a plant variety</td>
</tr>
<tr>
<td>6. For amendments to the Patent Register for intellectual property rights to a variety at the request of the person to whom the rights are granted</td>
</tr>
<tr>
<td>7. For amendments to the Registry of Varieties at the request of the person who owns the rights to the variety</td>
</tr>
</tbody>
</table>
Plant varieties TIPS and WATCH-OUTS in Ukraine

If the IPR to a plant variety belong to several persons jointly, there must be an agreement between them on how this right should be executed. Failing this, the IPR to a plan variety will be exercised jointly.

If a variety is created by a breeder as part of their employment contract or commission agreement with an employer using the employer’s know-how, the right to file an application for the variety shall belong to the breeder and employer jointly, unless otherwise specified in the employment contract or in the commissioning agreement between the employer and breeder. If the employment contract or commissioning agreement specifies that only the employer has the right to file an application, the employer must file an application for the variety, assign the right to that variety to another person or decide to keep the information on the variety confidential within 60 days of receiving a breeder’s notification of the variety. Within this period, the employer must also conclude a written agreement with the breeder of the variety about the amount to pay the breeder and the conditions for fair remuneration, based on the economic value of the variety and any other benefits to the employer.
F  Trade Secrets

WHAT are Trade Secrets?

Under the Civil Code of Ukraine information can be protected as a trade secret if it meets the following three criteria:

1. it is secret (it must not be known and easily accessible by the public);
2. it has commercial value because of its secrecy (this value will be lost if the information is disclosed);
3. the person lawfully in control of the information has taken reasonable protective measures to keep it secret (non-disclosure agreements, a non-disclosure clause in employment agreements, marking documents ‘confidential’, limited access to information by employees, IT security measures).

Any information of a technical, organisational, commercial, industrial or other nature can be a trade secret.

Trade Secrets in Ukraine: What you need to know

The above definition of a trade secret is sufficiently broad that right holders can determine which information should be protected as a trade secret at their own discretion. The following information, however, is not classified as a trade secret:

- a legal entity’s documents of incorporation;
- information needed for tax verification purposes and associated payment documents;
- information about staff and the number of employees, their salaries and the number of job vacancies;
- information about environmental pollution, about the violation of safety requirements for employees, about products that can harm consumers’ health and about the amount of damage caused;
- documents related to solvency;
- information on company officials’ participation in other business entities.

In Ukraine, it is the proprietor who has to take the appropriate measures to protect its trade secret; there is no formal registration procedure for protecting it. If Ukrainian authorities become aware of trade secrets during the course of their professional duties, they are obliged to protect them from disclosure and unfair commercial use and to keep them confidential. Examples of state authorities are the Antimonopoly Committee, customs, tax and investigation authorities, judges and prosecutors. If the state authorities request confidential information that is considered a trade secret (such as the fact that a tax inspection or discovery proceedings are in progress), we recommend that you notify the state authorities that the information you have provided should be treated as a trade secret.

The Ukrainian health and environmental authorities must ensure protection against disclosure and unfair commercial use of the information submitted by applicants for marketing approval (registration) of medicines and agrochemicals in Ukraine.

Within five years of the date of registration of the medicinal product in Ukraine, it is prohibited to use the registration information on the safety and efficiency contained in the application of this product for filing an application for registration of another medicinal product, unless the right to refer to or use this information is lawfully obtained from the person or organisation that provided the information, or the information produced by or for the applicant.

Moreover, within 10 years of the date of registration of the agrochemicals or pesticides in Ukraine, it is prohibited to use the
information on the safe use of these agrochemicals or pesticides provided by the applicant in the documentation (dossier) without the applicant’s permission.

This information is protected by the state authorities against disclosure, except in cases where disclosure is needed to protect the public interest or where the right holder has not taken any measures to protect it against unfair commercial use.

**HOW LONG does legal protection last?**

Trade secrets are protected for an unlimited period and are valid provided the above three conditions for protecting trade secrets are met.

**Trade Secret TIPS and WATCH-OUTS in Ukraine**

- The Unfair Competition Act of Ukraine also protects trade secret rights, according to which the following are classified as unfair competition:
  - the unlawful collection of information that constitutes a trade secret;
  - the disclosure of a trade secret;
  - the inducement to disclose a trade secret;
  - the unlawful use of a trade secret.

- Before you disclose trade secret information to your business partners or employees, we recommend that you clearly mark this information as confidential and conclude non-disclosure (confidentiality) agreements or incorporate a confidentiality clause in agreements with your business partners and employees.
WHAT are Customs?

The Department for Customs Affairs at the State Fiscal Service of Ukraine and its territorial customs offices are responsible, in particular, for preventing IPR infringement at the customs border.

Customs in Ukraine: What you need to know

One of the most effective ways of preventing counterfeit goods from being imported into Ukraine or exported from Ukraine with the unauthorised use of your IPR is to register your IPR objects in the Customs Registry. Once your goods are registered (prior application), the authorities will take steps to prevent the movement of counterfeit goods across the customs border of Ukraine.

Customs officers also detect counterfeit goods suspected of being imported or exported without a prior application. If this happens, the release of the goods is suspended for three business days and a notification is sent to the IP rights owner. During this time, an owner should file an application for the IPR object to be included in the Customs Registry. If the owner fails to do so, the goods will be released.

WHAT can be registered?

The following IPR objects can be included in the Customs Registry:

- trade marks
- industrial designs
- copyright and related rights objects
- geographical indications
- inventions
- utility models
- plant varieties.

HOW LONG does legal protection last?

The registration of an IPR in the Customs Registry is valid for six months or one year. Registration can be extended for a further 6- or 12-month period if a written application is submitted no later than 10 working days before the preceding term expires.

HOW do I register?

To register an IPR with Ukrainian customs, the IPR holder or their representative should file an application along with the following documentation:

- an extract from the appropriate SIPS register relating to the IPR object, certifying that the registration was valid when the application was filed. For copyright and related rights objects, the documents confirming the existence of these rights are required.
- a detailed description of the IPR object and the goods containing the IPR object;
- samples of goods containing the IPR object or photos of them;
- a power of attorney if an application is filed by a representative of an IPR holder.
Which LANGUAGES can I use?

The application and all accompanying documents should be filed in Ukrainian.

How much does it COST?

No fees, deposits or bank guarantees are needed for customs registration but if counterfeit goods are suspended, any expenses incurred by the customs authorities for the storage of goods must be borne by the IPR holders.

**Customs TIPS and WATCH-OUTS in Ukraine**

If counterfeit goods are detected, the following procedure is applied:

1. If, as a result of data from the Customs Registry, a customs officer finds that counterfeit goods are being imported or exported, the customs clearance of these goods will be suspended for 10 business days. Later the same day the customs authority will send the right holder a notification by fax or email.

2. Before the suspension period ends, an IPR holder should:
   
   a) bring a court action for IPR protection, or  
   b) file a motion for extension of the suspension period, or  
   c) give written permission for customs clearance of the suspended goods.

If on receipt of a suspension notice an IPR holder informs the customs authority in writing of the IPR infringement and provides the written consent of the owner of the counterfeit goods for their destruction, the simplified procedure for destroying the counterfeit goods will be applied.
Under Ukrainian legislation, the following remedies are available for protecting IPR:

1) Administrative procedures
2) Civil litigation
3) Criminal proceedings.

Civil litigation is the most frequently used means of protecting IPR in Ukraine although administrative procedures can also be effective.

**Administrative actions**

Administrative procedures can be applied to protect IPR: at the customs border by the Ukrainian customs authorities; under unfair competition by the Antimonopoly Committee of Ukraine; under the recognition of well-known trade marks, upon appeal against decisions of the Ukrainian PTO.

The Antimonopoly Committee of Ukraine has jurisdiction over acts of unfair competition. However, it may simply decide whether the act of unfair competition actually occurred which means that the sanctions will be applied if there is a court decision. As a result, IPR holders do not tend to use this mechanism.

SIPS can protect IPR using its special authority to recognise well known trade marks. The SIPS’ Board of Appeals can recognise a trade mark as well known as at a certain date (usually, in the past) on application. If a mark is well known, it has much broader legal protection in Ukraine and strengthens the IPR holder’s standing in other IP proceedings. In addition, decisions of the Ukrainian PTO on granting protection to IPR objects may be appealed to the SIPS.

**Civil Litigation**

IP cases are normally considered by the Ukrainian civil (involving a natural person as one of the parties to the dispute) or commercial (involving legal entities only) courts; however, in some cases, administrative courts are also competent. To initiate an IP court action, cease and desist letters (or any other pre-litigation measures) are not required. A preliminary injunction is available either before court proceedings start or in litigation cases that are pending.

In the vast majority of IP cases in Ukraine, claims are filed for: termination of IP infringement; compensation for damages resulting from IP infringement; cancellation of a trade mark registration/patent; early termination of a trade mark registration on the basis of non-use; recognition of a well-known trade mark in Ukraine; the extension of a patent term; invalidation of an IP-related agreement; cancellation of an application related decision by the Ukrainian PTO (these cases should be considered by the administrative court); and termination of unfair competition in the IP domain.
Criminal prosecution

Criminal proceedings may be initiated against an IP infringement if the IPR holder or the police/prosecutor files a complaint. For an IP infringement to be criminal, it must be intentional (the person knew or should have known that they infringed the IP rights) and cause major damage (the amount of damages is not fixed and depends on the level of subsistence; currently, this means damages of more than EUR 740). Only individuals (or, in the case of legal entities, their duly-authorised representatives) can be held criminally liable for IP violations.

Under Ukrainian law, a civil claim can be brought within criminal proceedings by a natural person or a legal entity (the civil plaintiff) if a criminal IP offence has caused them property and/or moral damage. The civil plaintiff's rights and duties will accrue at the time a statement of claim is filed with the pre-trial investigation body or court. Civil defendants in criminal proceedings are natural persons or legal entities civilly liable under the law for damage caused by criminal acts committed by them or for a socially dangerous act committed by a mentally defective person against whom a claim is made.

Sanctions range from fines to imprisonment (with seizure of the infringing goods and production facilities). If an IP infringement is not considered criminal, it can still be prosecuted by the police as an administrative offence, which is punishable by a fine and the seizure of the infringing goods and facilities.

Enforcement TIPS and WATCH-OUTS in Ukraine

The European Commission (DG Trade) report on bilateral interactions with Ukraine points out that the level of both IPR protection and enforcement in Ukraine is unsatisfactory and has not improved in recent years. In particular, weak institutions, corruption, poor capacity and the enforcement authorities' lack of resources contribute to IPR protection and an enforcement environment that is generally weak. As a result, IPR infringements (both online and in physical markets) occur on a massive scale and generally without serious repercussions.

According to the report, Ukrainian IPR laws are particularly unfit for enforcement in the digital environment. Moreover, the criminal sanctions are not a deterrent, legal proceedings still appear lengthy and there is a shortage of IPR-trained judges.

For more information, see: http://ec.europa.eu/trade/policy/countries-and-regions/countries/ukraine/

Even though Ukraine's legal system is not based on case-law, the lower courts are normally guided by the jurisprudence of the higher courts in IP matters.

In most IP-related court proceedings an expert opinion is requested. Questions of, inter alia, the similarity of trade marks and compliance of a trade mark/patent with registrability/patentability conditions should be considered by specially certified experts, appointed by a judge. Three levels of appeal are formally available; however, in practice, only two are actually used.
06 RELATED LINKS and Additional Information

- State Enterprise 'Ukrainian Institute of Industrial Property' (Ukrainian PTO) — http://www.uiipv.org/en
- Ukrainian Center of Innovations and Patent Information Services — http://iii.ua