

LAW OF GEORGIA ON TRADEMARKS

(Last amended as of June 28, 2010)

CHAPTER I. GENERAL PROVISIONS

Article 1. AIM OF THE LAW

1. The Law regulates relations arising in connection with the registration and protection of trademarks, service marks and collective marks and the use of such marks.

Article 2. EXPRESSIONS USED IN THE LAW

2. The terms used in the law have the following meaning:
(a) «Sakpatenti» - the legal entity of public law that provides legal protection of rights of natural persons and legal entities in the field of intellectual property protection;

(a) National Intellectual Property Center «Sakpatenti» (hereinafter referred to as «Sakpatenti») - the legal entity of public law determined by the Patent Law of Georgia; (28.06.2010. № 3159 shall enter into force within a month from the publication)

(b) "Paris Convention" - the Paris Convention for the Protection of Industrial Property, signed at Paris on March 20, 1883 (as revised at Stockholm on July 14, 1967, and as amended on September 28, 1979);

(c) "Madrid Protocol"- the Protocol Relating to the Madrid Agreement Concerning the International Registration of marks signed on June 27, 1989; (20.12.2005 № 2380 is in force from March 1, 2006);

(d) "International Classification" - the International Classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, signed at Nice on June 15, 1957, as revised at Stockholm on July 14, 1967 and at Geneva May 13, 1977;

(e) "Certificate" - the document granted in the name of the trademark holder as provided in this Law, confirming the exclusive rights of the trademark holder;

(f) "Application" - the set of documents necessary for granting certificate, compiled in accordance with the prescribed conditions;

(g) "Applicant" - the natural person or legal entity requesting the grant of a certificate;

(h) "Priority" - the privilege derived from an application filed earlier, than the current application;

(i) "Convention priority" - the priority deriving from Article 4 of the Paris Convention;

(j) "Exhibition priority"- the priority deriving from Article 11 of the Paris Convention;

(k) "Patent attorney"- the authorized person registered at «Sakpatenti» who is entitled to represent third parties in industrial property matters; extracted – (28.06.2010. №3159 shall enter into force within a month from the publication);

(l) "Chamber of Appeals"- the dispute resolution body at «Sakpatenti» hears disputes arising in connection with the acquisition of the rights in industrial property subject matters; (20.12.2005 № 2380 is in force from March 1, 2006)

(m) "Association" - any association of the producers established under the legislation of Georgia or its country of origin.

(n) "Feature of a trademark not qualifying for protection" – the part of a trademark to which the right holder's exclusive rights do not apply. (20.12.2005 № 2380 is in force from March 1, 2006);

Article 3. TRADEMARK

1. A trademark is a sign or combination of signs that can be represented graphically and is capable of distinguishing the goods or services or both (hereinafter referred to as "goods") of one undertaking from those of other undertakings.

2. The sign may be a word or words, including proper names, letters, figures, sounds, a design or a three-dimensional figure, including the shape of goods or their wrapping and also other packaging, including colors or combination of colors.

3. The trademark is protected by registration at «Sakpatenti» or by virtue of international agreement.

4. The well-known trademarks in Georgia are protected without registration in Georgia under Article 6^{bis} of the Paris Convention. The trademark is recognized as well-known by the Chamber of Appeals of «Sakpatenti» or by the court, in its competence, upon the request of an interested person.

Article 4. ABSOLUTE GROUNDS FOR REFUSAL OF REGISTRATION

(20.12.2005 № 2380 is in force from March 1, 2006);

1. A sign, or combination of signs shall not be registered as a trademark where it:

(a) does not comply with the requirements of Article 3 (1) of this Law;

(b) represents a single non-stylized (standard) letter or figure, or a single colour taken separately;

(c) is not capable of distinguishing the relevant goods;

(d) is descriptive in respect of the goods for which its registration is requested,

consists exclusively of the kind, quality, quantity, feature, value, intended purpose, geographical origin, place of sale, time or other characteristics of the goods or can be regarded as such;

(e) is widely used as a generic term for the particular type of goods;

(f) represents a widely established trade term or sign for which registration is sought;

(g) irritates or is contrary to national dignity, religious sentiment and traditions and moral standards;

(h) is likely to deceive the public (as to the feature, quality, geographical origin or other characteristics of the goods);

(i) completely or in any of its constituent elements coincides with the national emblems or the flags, emblem or full or abbreviated names of foreign states; the emblems of intergovernmental or other international organizations or their abbreviated or full names; official control, warranty and test hallmarks, signs (including certification marks of goods) seals, orders and medals; the official or historical names, emblems and State flags of the constituent parts of Georgia; the banknotes of Georgia or the imitation of the forgoing; such a sign may be included in a trademark, as a feature not qualifying for protection, if the permission of the Ministry of Culture or the holder has been obtained.

2. A three-dimensional sign shall not be registered as a trademark, where its shape:

(a) is established exclusively by the nature of the goods;

(b) is necessary for a technical result to be achieved.

3. The provisions of paragraph 1(c), (d), (e), (f), and (h) above shall not apply if, before a decision is taken on its registration, a trademark has become distinctive through use in the course of trade in relation to the goods specified in the application.

Article 5. RELATIVE GROUNDS FOR REFUSAL OF REGISTRATION (20.12.2005 №2380 is in force from March 1, 2006);

A trademark shall not be registered if it:

(a) is identical to another trademark registered for the same goods;

(b) is identical to the trademark of a third party and the goods are so similar as to create a risk of confusion between the marks, including confusion based on association;

(c) is similar to the trademark of a third party and the goods are identical or so similar as to create a risk of confusion between the marks, including confusion based on association;

(d) is identical or similar to a trademark well known in Georgia, existing before filing the application, so that there is a risk of confusion with it, including confusion based on association; this rule shall apply even where the lists of goods are different;

(e) is identical or so similar to an appellation of origin or geographical indication protected in Georgia that there is a risk of confusion with it, including confusion based on association and the registration of trademark is requested for the identical or similar goods, or using such a trademark will result in using the reputation of the protected appellation of origin or geographical indication. This provision shall not apply if an appellation of origin or geographical indication is involved as a feature not qualifying for protection in the trademark of a person entitled to use it.

(f) is identical to an industrial design protected in Georgia except where registration of the trademark is sought by the holder of the exclusive rights in the industrial design;

(g) is identical or similar to registered trademark a third party enjoying good reputation in Georgia, and if the use of that trademark creates unfair advantages for its applicant or damages the reputation of the protected trademark; this rule shall apply where there are different lists of goods;

(h) includes names, pseudonyms, facsimiles, portraits of persons famous in Georgia without the consent of these persons or their legatees, and if they belong to the history and culture of Georgia without the permission of the Ministry of Culture of Georgia;

(i) includes the names of historical monuments of Georgia or of reproductions thereof without the permission of the Ministry of Culture;

Article 6. EXCLUSIVE RIGHT

1. The exclusive rights of a trademark holder arise on the date of the registration of the trademark.

2. The person enjoying exclusive rights may prevent third parties from using a trademark in the course of trade that is:

(a) identical and the goods are identical too;

(b) identical to the protected trademark and the goods are so similar, that there is a risk of confusion including confusion based on association;

(c) similar to the protected trademark, and the goods are identical or so similar that there is a risk of confusion of the marks including confusion based on association;

(d) identical or similar to the protected trademark, and protected on account of the good reputation of the trademark in Georgia, so that the use of the mark affords unfair

advantages to third parties or damages the good reputation of the trademark or its distinguishing power.

3. In the cases provided for in paragraph (2) of this Article, except other possible prohibitions, it is prohibited:

(a) to print a protected trademark on goods or their packaging;

(b) to offer, place on the market, or to store for that purpose, import or export the goods bearing the trademark, except where the act is performed with the goods bearing a sign affixed by the person owning the exclusive rights in the mark; (20.12.2005 № 2380 is in force from March 1, 2006);

(c) to offer or render services using the trademark;

(d) to use the trademark in advertisements or business papers.

4. Without the consent of the trademark holder, a third party is prohibited:

(a) from affixing a sign identical or similar to the trademark on packaging materials, labels, tags and etc.;

(b) from offering, placing on the market, selling, preparing for sale, importing or exporting packaging material or packaging bearing the mark.

Article 7. SCOPE OF EXCLUSIVE RIGHTS

The person enjoying the exclusive rights in the trademark may not prevent a third party from using in the course of trade:

(a) his name or address if it coincides with the trademark of the person having the exclusive rights;

(b) a sign or combination of signs indicating the kind quality, quantity, characteristics, value, intended purpose, geographical origin, time or place of sale or other features of the goods;

(c) the protected trademark itself, if it is necessary for the goods to be used according to their intended purpose, including where the goods bearing the trademark are used as a component or spare part, provided that the use is made in accordance with fair practice in industrial or commercial matters.

2. The person enjoying the exclusive rights in the trademark may not prevent a third party from using the protected trademark on goods that have been brought on to the market by the holder of the trademark himself or with his consent. This rule shall not apply where the features of the goods have changed, the quality has become worse or there are other important grounds for prohibition.

Article 8. PUBLICATION OF TRADEMARK IN REFERENCE BOOKS

8. If the reproduction of a trademark in a dictionary, encyclopedia or other informative work gives the impression that it represents the generic term designating the goods for which it has been registered, or its registration is sought, the publisher, at the request of the holder of the mark in question, is obliged to mention in the next edition of the reference book that the sign published is a registered trademark.

CHAPTER II. ACQUISITION AND MAINTENANCE OF EXCLUSIVE RIGHTS IN TRADEMARKS

Article 9. APPLICATION FOR A TRADEMARK REGISTRATION

1. An application for registration shall be filed with «Sakpatenti» by an applicant or his representative.

2. The request shall be filed in the Georgian language in accordance with the established rule.

3. The foreign applicant who is not a resident of Georgia or who has no real business within the territory of Georgia shall conduct his relations with «Sakpatenti» through a patent attorney registered with «Sakpatenti». repealed - (28.06.2010. №3159 shall enter into force within a month from the publication);

4. The application shall apply to one trademark only.

5. The application, on being filed with «Sakpatenti» must contain:

(a) a request for trademark registration;

(b) the full name and legal address of the applicant;

(c) the representation of the trademark;

(d) the list of the goods for which the registration is sought; it is permitted to submit a list of goods in a foreign language, provided that a Georgian translation of the said list is submitted to «Sakpatenti» within one month from the filing date of the application;

(e) the name and address of the representative, if the application is filed by him;

(f) the mandatory signature of the applicant or his representative.

6. All the other data and the list of the documents for examination, the time limits for the filing thereof and other conditions shall be defined by the legislation of Georgia.

Article 10. DATE OF FILING THE APPLICATION WITH «SAKPATENTI»

10. The day on which the applicant submit an application to «Sakpatenti» shall be considered the filing date thereof if the application complies with the requirements of paragraphs (2) and (5) of Article (9).

Article 11. PRIORITY

1. The priority of a trademark is established by the filing date of the application, provided that the prescribed application is paid after filing within a period not exceeding one month thereafter. (20.12.2005 № 2380 is in force from March 1, 2006);

2. Trademark priority may be established by the filing date of the first application in a State party to the Paris Convention (hereinafter referred to as "Convention priority"), provided that no more than six months have elapsed between that date and the filing date of the application with «Sakpatenti».

3. If the applicant for a trademark has displayed the trademark in an exhibit at an official or officially recognized international exhibition held in a State party to the Paris Convention, the priority of the trademark shall be established by the first day of the exhibition ("exhibition priority") if he files the application within a period of six months from the date of the display of the trademark at the exhibition. The exhibition and Convention priorities shall not be cumulative.

4. The applicant who wants to benefit from Convention priority or exhibition priority is obliged to notify «Sakpatenti» within one month from the filing date of the application with «Sakpatenti», and, within three months from said filing date to present the document confirming his right to claim.

5. The fee payable under the rule governing Convention priority and exhibition priority shall be paid to «Sakpatenti» within one month from the filing date of the application.

6. If the same priority has been established for several trademarks, preference shall be given to the trademark, the actual use of which on the territory of Georgia had started earlier. (20.12.2005 № 2380 is in force from March 1, 2006);

Article 12. EXAMINATION OF THE TRADEMARK APPLICATION

1. «Sakpatenti» shall conduct an examination as to form and a substantive examination of the trademark application.

2. «Sakpatenti» is authorized to require of an applicant any additional materials needed for the examination. The additional material shall be furnished to «Sakpatenti» within two months from the date on which the relevant notification is handed to the

applicant. If the applicant fails to comply within the said period the application shall be rejected.

3. Where the list of goods contains two or more names, the application may, at the request of the applicant, be divided before the registration of the trademark into two or more applications by redistribution of the goods and services of the first application among the divisional applications, subject to payment the prescribed fees for those applications. The divisional applications retain the filing date of the first application.

4. «Sakpatenti» shall not release information on trademark applications until after priority has been established.

5. The applicant has the right to: (20.12.2005 № 2380 is in force from March 1, 2006)

(a) require at any stage of the examination suspension of consideration of his application subject to payment of the prescribed fee, but for no longer than three months;

(b) familiarize himself with the material issuing from the examination and require copies thereof;

(c) complete, amend, correct or specify the application material before the application priority is established. After the application priority is established, such changes may be made only on payment of the prescribed fee, but no later than on the registration of the trademark; at the same time, only such minor changes are allowed in the amendments of the trademark, which does not extend the scope of its protection, and only restrictions or specification are allowed in the amendments of list of goods;

(d) withdraw the application before the trademark is registered.

(e) renew proceedings on the application on payment of the prescribed fee. The renewal is allowed when its termination had occurred prior to the publication of the application data according to Article 15 of this Law.

6. The rules governing the writing and filing of the application, examination, opposition to the examination finding, observance of procedural time limits, extensions and renewals, and also other rules regarding trademark registration, shall be defined by the approved regulation enacted under the legislation of Georgia on the filing of trademark applications and registration procedure.

Article 13. EXAMINATION OF APPLICATION AS TO FORM

1. The examination as to form shall be conducted within two months after the filing of the application, or if the applicant claims Convention priority or exhibition priority, within

the term provided for in the Article 11(4) of this Law. If the applicant has been sent a notification requiring the additional material, the examination shall be delayed until a response to the notification has been received, but no later than the time limit laid down in the Article 12(2) of this Law.

2. The examination as to form serves to ascertain whether the application has been filed in accordance with this Law.

3. If the application satisfies the requirements of Article 9(2) and (5) of this Law, a document shall be issued in the name of the applicant specifying the filing date of the application, with a mention of the record number and a list of documents. Otherwise, the applicant shall receive notice of refusal to accept the application with a statement of reasons.

4. If the application fee is not paid within one month from the filing date of the application, or if an amount less than that payable for one class is paid, «Sakpatenti» shall take the decision to reject the application. If, within the said period of one month, an amount less than that payable for filing in the number of classes to which the application relates but enough for filing in one class is paid, the examination shall cover the classes specified by the applicant or, if none is specified, the number of classes for which the paid is sufficient.

5. On the basis of the examination as to form, «Sakpatenti» shall take the decision to reject the application. Shall take the decision to accept the application for examination and recognize the priority thereof or to reject the application, and shall notify the applicant accordingly.

Article 14. SUBSTANTIVE EXAMINATION

1. Substantive examination shall be carried out within six months from the end of the examination as to form.

2. The substantive examination serves to ascertain whether the sign satisfies the requirements of Articles 4 and 5 of this Law.

3. On the basis of the substantive examination finding, the applicant shall be sent the decision on the registration or refusal of registration of the trademark for the whole list of goods or part thereof.

Article 15. PUBLICATION

1. After taking a decision on the registration of a trademark based on substantive examination, «Sakpatenti» within one month shall publish the trademark data in the Official Bulletin of the Industrial Property (hereinafter referred to as "the Bulletin").

2. If the applicant makes use of the right defined in Article 16 (2), the publication of the application data in the Bulletin shall take place within one month after the Chamber of Appeals has taken the decision.

2¹. If the decision of the refusal of registration of the trademark for the entire list of goods or a part of thereof taken after the substantive examination is changed on the basis of the court enacted positive decision, «Sakpatenti» shall publish the trademark data in the Bulletin. (20.12.2005 № 2380 is in force from March 1, 2006);

3. The following shall be published in the Bulletin: a representation of the trademark, the personal particulars and address of the holder, the list of goods according to the International Classification for which the trademark registration is sought and the trademark priority.

4. From the date of publication of the application until its registration the applicant is conventionally given the same rights which would be granted to him by the registration. If the registration is not implemented, these rights shall not be regarded as arisen. (28.06.2010. №3159 shall enter into force within a month from the publication);

Article 15 ¹. PROCEDURE OF ACCELERATED REGISTRATION OF A TRADEMARK (28.06.2010. №3159 shall enter into force within a month from the publication);

1. Unless otherwise specified by this Article, Chapter II of this Law regulates the procedure of accelerated registration of a trademark.

2. An applicant at the time of filing the application or within one month from the filing may request conducting accelerated examination of his application.

3. The application requesting accelerated examination shall be accompanied by all documents specified by Article 9 of this Law, power of attorney, if any, and the fees prescribed for an accelerated examination of a trademark application and trademark registration shall be paid.

4. If an applicant wishes to benefit from the priority defined in the paragraphs: (2) and (3) of Article 11 of this Law or from Article 9^{quinquies} of the Madrid Protocol, a document certifying the right to claim priority shall be enclosed to the application requesting accelerated examination and the prescribed fee shall be paid.

5. Within three days after the request of conducting an accelerated examination, «Sakpatenti» checks whether the application meets the requirements of paragraphs 3 and 4 of this Article. If the application materials lack any document provided for in paragraphs 3 and 4 of this Article, the applicant shall submit this document within 15 days. Otherwise, «Sakpatenti» takes a decision to refuse conducting an accelerated examination and considers the application according to Chapter II of this Law.

6. If the application requesting an accelerated examination meets the requirements of paragraphs 3 and 4 of this Article, within 7 days «Sakpatenti» checks whether there are grounds of refusal of the trademark registration according to Articles 4 and 5 of this Law and in the case of taking a positive decision, registers the trademark in the Register of Trademarks, publishes data on the trademark in "the Bulletin" and issues a certificate.

7. Within three months after the publication of the trademark data any interested person is entitled to file an appeal with the Chamber of Appeals about requesting the cancellation of the registration on the grounds that the requirements of Articles 4 and 5 are violated.

8. If after the registration of a trademark through the accelerated procedure an application is filed with «Sakpatenti» which is entitled to earlier priority and if there exist grounds for refusal of the trademark registration stipulated in Article 5 of this Law in relation to the trademark registered through the accelerated procedure, «Sakpatenti» takes a decision on the cancellation of accelerated registration of the trademark and publishes it in the Bulletin.

9. The decision on the cancellation of accelerated registration of the trademark, mentioned in paragraph 8 of this Article can be opposed under Article 16 (2) of this Law.

Article 16. OPPOSITION TO THE EXAMINATION DECISION AT THE CHAMBER OF APPEALS

1. The decision of the examination as to form may be opposed by the applicant before the Chamber of Appeals within three months after having been taken.

2. A decision of the substantive examination to refuse the registration of the trademark in respect of all or part of the list of goods may be opposed by the applicant before the Chamber of Appeals within three months after having been taken.

3. Repealed - (20.12.2005 № 2380 is in force from March 1, 2006);

4. Within three months from the date of publication of the trademark data in the Bulletin, any party concerned has the right to bring an action before the Chamber of

Appeals against the decision of the examination to grant registration only on the grounds that the requirements of Article 4 or Article 5 is violated. The enacted decision of the court concerning the trademark registration is not allowed to be appealed at the Chamber of Appeals on the same grounds. (20.12.2005 № 2380 is in force from March 1, 2006);

5. The Chamber of Appeals shall consider the appeal within three months from the date of its filing. (20.12.2005 № 2380 is in force from March 1, 2006);

6. The decision of the Chamber of Appeals may be appealed in a court.

Article 17. TRADEMARK REGISTRATION

1. If within the period prescribed in Article 16 (4) an action is not brought before the Chamber of Appeals, or if on the basis of the appeal filed in accordance with Article 16 (4) the Chamber of Appeals takes a decision to register a trademark, «Sakpatenti» shall enter the trademark in the Register of Trademarks (hereinafter referred to as "the Register") and publish the data concerning the registered trademark in the Bulletin. (20.12.2005 № 2380 is in force from March 1, 2006)

2. The Register shall contain a representation of the trademark, the particulars of its holder, the date of its priority, the date of its registration, a list of the goods grouped according to the International Classification for which the trademark is registered and other information regarding the registration.

3. Any interested person is authorized, after filing a proper request with «Sakpatenti», to familiarize himself with the Register data and, against payment of the prescribed fee, to request the issue of a certified excerpt from the said Register.

Article 18. TRADEMARK CERTIFICATE

1. After having entered the data in the Register, «Sakpatenti» shall grant a trademark certificate.

2. The certificate shall confirm the registration of a sign as a trademark, the date of the trademark priority, the holder's exclusive right to the trademark in question and its term of validity.

Article 19. RECORDING OF AMENDMENTS IN THE REGISTER

1. Any amendments to the data whose registration is mandatory under Article 17 (2) of this Law shall be entered in the Register at the request of trademark holder or his representative. ; at the same time, only such minor changes are allowed in the

amendments of the trademark which do not extend the scope of its protection, and in the amendments of list of goods only restrictions or specifications are allowed. Amendments shall enter into force on registration. (20.12.2005 № 2380 is in force from March 1, 2006);

2. Amendments entered in the Register shall be published in the following Bulletin.

3. Amendments shall also be recorded in the certificate.

Article 20. TERM OF VALIDITY OF THE TRADEMARK REGISTRATION

(20.12.2005 № 2380 is in force from March 01, 2006);

1. The term of validity of a trademark registration shall be 10 years from the date of registration with «Sakpatenti».

2. The term of validity of a trademark registration may be extended indefinitely by consecutive periods of 10 years. Extension of the term of validity of a registration shall be effected on a request filed by the holder with «Sakpatenti», after payment of the prescribed fee. The said request shall be filed with «Sakpatenti» and the said fee paid in the 10th year of the certificate's validity.

3. A notice on the extension of the term of validity of a trademark registration shall be recorded on the certificate and in the Register, and shall be published in the Bulletin.

4. If the request on the extension of the term of validity of the trademark registration was not filed with «Sakpatenti» or the prescribed fee was not paid during the term determined in Article 20 (2), the holder of the trademark is entitled to pay the above-mentioned fee within six months from the date of expiration of the term of validity of the trademark registration. In the case of missing of this time the trademark registration is canceled from the date of expiration of the term of validity of the registration without the right to its reinstatement and the relevant notification shall be published in the Bulletin.

5. The extension of the term of validity of the registration for such a trademark, which involves an appellation of origin or a geographical indication protected in Georgia as a feature not qualifying for protection, is allowed only in the case if the applicant at the time of submitting the request for extension of the term of validity of the trademark registration to «Sakpatenti» has the right to use this appellation of origin or geographical indication.

6. If the registration is cancelled at the request of the trademark holder, the renewal of the registration is not allowed.

Article 21. Extracted- (20.12.2005 № 2380 is in force from March 1, 2006)

Article 22. Fees (28.06.2010. №3159 shall enter into force within a month from the publication)

Fees specified in the rules enacted under the relevant legislation shall be payable for the examination as to form of a trademark application, for substantive examination, for accelerated examination, for claiming priority, for opposition to the examination decision, for trademark registration, for the recording of amendments, for publication, for the grant of the certificate, for excerpts from the Register, for the delaying of the procedural time limits associated with the registration, for renewal and extension as well as all other acts in relation to the legal protection of a trademark. The amounts of the fees and the conditions for the payment thereof shall be specified in the rules enacted under the relevant legislation. The amount of fee shall be specified by the resolution of the Government of Georgia.

Article 23. Extracted- (20.12.2005 № 2380 is in force from March 1, 2006)

CHAPTER III. USE OF THE TRADEMARK AND TRANSFER OF THE RIGHTS DERIVING FROM REGISTRATION

Article 24. (20.12.2005 № 2380 is in force from March 1, 2006)

USE OF THE TRADEMARK

1. The following shall be considered use of a trademark: its affixation on the goods for which it has been registered and the packaging thereof, on exhibits displayed at exhibitions and fairs, on signs, official forms and labels, its inclusion in advertisements and published works and also other uses, including use both by the holder of a trademark and by a licensee or third party on the basis of assignment of rights by the holder of the mark. Use of slightly different sign instead of the registered trademark shall likewise be considered use of the trademark.

2. The use of such trademarks which involve an appellation of origin or a geographical indication protected in Georgia as a feature not qualifying for protection, is allowed with the consent of the respective competent authority, which is regulated by the legislation of Georgia and international agreements to which Georgia is a party.

Article 25. TRANSFER OF THE RIGHTS DERIVING FROM TRADEMARK REGISTRATION

1. The rights under a trademark registration may be transferred to another natural person or legal entity on the basis of the rules enacted under the relevant legislation.

2. The trademark may be transferred to another party with or without the associated business.

3. The transfer of rights deriving from trademark registration shall apply to the full list of goods or a part thereof.

4. The transfer of a business shall imply the trademark transfer as well, unless otherwise provided in the transfer contract.

5. Contracts on trademark transfer shall be executed in writing. Failure to use the written form shall cause the contract to be void.

6. If on the basis of the transfer documents «Sakpatenti» regards that a trademark transfer might mislead consumer as to the features, quality, or geographical origin of the goods for which it is registered, «Sakpatenti» shall not enter a record of the transfer in the Register until it receives the transferee's agreement to the withdrawal from the list of goods of those liable to be a cause of confusion. (20.12.2005 № 2380 is in force from March 1, 2006)

6¹. The transfer of rights on a trademark which involves an appellation of origin or a geographical indication, protected in Georgia as not qualifying for protection, is allowed only in the case when the transferee is has the right to use this appellation of origin or geographical indication; (20.12.2005 № 2380 is in force from March 1, 2006)

7. Upon the transfer of a trademark relevant amendments shall be recorded in the Register and published in the Bulletin on payment of the prescribed fees.

8. The new holder of the trademark may not use the rights deriving from the registration against a third party, until the relevant amendments on the trademark transfer are recorded in the Register.

Article 26. LICENSE CONTRACTS

1. The right to the use of a trademark may given by its holder (the licensor) to another person (the licensee) on the basis of a license contract. The license contract may be concluded in relation to the full list of goods or to a part thereof.

2. The license shall be exclusive or simple.

3. If the character of the license is not specified in the contract, the license shall be considered simple, in which case the licensor may use the trademark himself or enter into another license contract.

4. An exclusive license prohibits the licensor from entering into another license contracts and from using the trademark unless otherwise provided in the contract. The rights under the exclusive license shall remain in force throughout the term of validity of the trademark registration unless otherwise provided in the contract.

5. The licensee is prohibited from assigning the rights under the license contract and from issuing sublicenses, unless it directly derives from the contract. (20.12.2005 № 2380 is in force from March 1, 2006)

6. In the case of infringement of the license contract the trademark holder has the right to assert his exclusive rights under this Law in relation to the licensee if the infringement relates to the term of the contract, the manner of trademark use, the list of goods for which the license was issued, the territory on which the trademark may be used or the quality of goods. (20.12.2005 № 2380 is in force from March 1, 2006)

7. The trademark license contract shall be registered at «Sakpatenti» and the relevant information published in the Bulletin on payment of the prescribed fee.

8. In the case of infringement of the trademark rights the licensee brings an action only with the consent of the trademark holder.

9. The licensee is entitled, with a view to compensation for damages, to participate in court proceedings for infringement of the trademark rights.

10. The transfer or licensing of the trademark rights shall not cover a license issued earlier in the name of a third party.

11. A license contract on a trademark which involves an appellation of origin or a geographical indication protected in Georgia as a feature not qualifying for protection may be concluded only in the case, when the licensee has the right to use this appellation of origin or geographical indications of goods. (20.12.2005 № 2380 is in force from March 1, 2006)

CHAPTER IV. TERMINATION OF THE EXCLUSIVE RIGHTS IN A TRADEMARK

Article 27. GROUNDS FOR CANCELLATION OF A TRADEMARK REGISTRATION (20.12.2005 № 2380 is in force from March 1, 2006)

1. A trademark registration shall be canceled by «Sakpatenti» if:
a) the trademark holder files a request to that end with «Sakpatenti»;

b) on the death of the trademark holder (being a natural person) he has no successor, or a legatee is not appointed, or on the liquidation of the trademark holder it is a legal entity;

c) On the grounds of Article 15¹ (8) of this Law. (28.06.2010. №3159 shall enter into force within a month from the publication);

2. The trademark registration shall be canceled by the court at the request of a third party if:

(a) the trademark is not used continuously during five years in relation to the goods for which it was registered in Georgia; where the use of the mark starts or is resumed during the time between the expiry of the said five-year period and the claim of nullity of the trademark registration, no one may seek cancellation of the said registration;

(b) the trademark has become a generic term with which to designate the goods for which it has been registered;

(c) the use of the trademark by the trademark holder or with his consent might mislead consumer as to the kind, quality, feature, value or geographical origin of the goods or other characteristics;

3. paragraph (2) (a) of this Law does not apply, when non-use of trademark is caused by the circumstances independently from the will of trademark holder. In such circumstances shall be considered e.g. imposed import restrictions on the good protected by the trademark or other requirements established by the Government;

4. If there are grounds for cancellation of a trademark in respect of only part of the registered list of goods, the registration shall be canceled only in respect of that part.

5. In the case of cancellation of the trademark registration for the whole list of goods or part thereof, appropriate amendments shall be entered in the Register and the relevant notification shall be published in the Bulletin.

Article 28. RECOGNITION OF NULLITY OF A REGISTRATION (20.12.2005 № 2380 is in force from March 1, 2006)

1. A trademark registration may be recognized by the court as being void at the request of a third party, if:

a) the trademark is registered in violation of requirements of Article (4) or (5);

b) the trademark has been registered with dishonest intent;

c) the trademark has been registered in a state party to the Paris Convention by the representative or agent of the trademark holder in his own name, without the consent of the trademark holder.

d) The trademark contains the brand name for which the rights are originated before the filing the application for the trademark registration, which may cause confusion;

e) Such registration violates the copyright of a third party, which is arisen before the date of priority established for the trademark.

2. If there are grounds for a trademark registration to be recognized as being void only for part of the registered list of goods, the registration shall be recognized as being

void only for the said part, which shall be recorded in the Register and published in the Bulletin.

3. In the case of nullity of the trademark registration for the whole list of goods or part thereof, appropriate amendments shall be entered in the Register and the relevant notification shall be published in the Bulletin.

Article 29. EFFECTS OF RECOGNITION OF THE TRADEMARK CANCELLATION OR NULLITY OF A TRADEMARK REGISTRATION (20.12.2005 № 2380 is in force from March 1, 2006)

1. Where a trademark registration is cancelled under Article 27 of this Law, any rights accorded under the registration shall be considered terminated as of the date of the decision on cancellation of the registration unless the court decision refers to other date.

2. Where a trademark registration is considered void under Article 28 of this Law, any rights accorded under the registration shall also be considered void as of the date of arising on which the said rights came into being registration unless the court decision refers to other date.

3. Compensation for the damages shall be governed by the legislation of Georgia.

CHAPTER V. COLLECTIVE MARK

Article 30. RIGHTS IN COLLECTIVE MARKS (20.12.2005 № 2380 is in force from March 1, 2006)

1. A collective mark is a sign or combination of signs that qualifies for protection as a trademark, under Article 3 of this Law and distinguishes the goods of the members of an association of holders of the said sign or signs from those of other parties with respect to common qualitative features or other features.

2. The holder of or applicant for a collective mark may only be an association or a legal entity governed by public law.

3. It is prohibited to transfer or license a collective mark.

4. All the provisions of this Law are applicable to the collective mark, unless otherwise provided in Chapter V of this Law.

Article 31. USE OF INDICATIONS OF GEOGRAPHICAL ORIGIN AS COLLECTIVE MARKS

1. Subject to the condition specified in Article 4(1)(d) of this Law, it shall be exceptionally permissible to register as a collective mark a sign that designates the place of geographical origin of the goods (locality, district, region or country, or any other indication of the geographical origin of the goods). (20.12.2005 № 2380 is in force from March 1, 2006)

2. An indication of geographical origin shall not be used as a collective mark for goods that do not originate in the geographical locality, district, region or country concerned where it would cause confusion as to the origin of the goods.

3. If the indication of geographical origin includes the special features and quality of the goods, it shall be used as a collective mark only for goods having those features and that quality.

4. Paragraphs (2) and (3) of this Article shall apply to names, indications and signs that are similar to the indication of geographical origin.

Article 32. REGULATIONS GOVERNING THE USE OF COLLECTIVE MARKS

1. An application for a collective mark shall comply with the requirements of Article 9 and be accompanied by the regulations governing the use of the collective mark.

2. The regulations governing the use of the collective mark shall include:

(a) the name of the association;

(b) the names and legal addresses of the members of the association;

(c) the aim of the association;

(d) the conditions governing the use of the collective mark and overseeing that use;

(e) the rights and obligations of the members of the association regarding infringement of the rights in the collective mark;

(f) a list of the goods and common characteristics or indications for which the collective mark is intended.

3. If the collective mark contains a geographical name, the regulations governing the use of the mark must provide that any party whose goods originate within the geographical region so named, and who meets the conditions for use of the mark laid down in those regulations, has the right to become a member of the association and use the mark.

4. Any interested person is entitled to inspect the regulations governing the collective mark.

Article 33. EXAMINATION OF THE APPLICATION (20.12.2005 № 2380 is in force from March 1, 2006)

During the substantive examination it is determined whether the application meets the requirements of Article 30 (1), (2) and Article 32 of this Law as well as the requirements stipulated in Article 14 (2). The examination will not take the decision on the refusal of the registration of the collective mark if the applicant corrects the said regulations in such a way that the grounds for refusal the registration no longer exist.

Article 34. LIMITS OF COLLECTIVE MARK PROTECTION

The registration of a geographical name as a collective mark does not entitle its holder to prevent a third party from using the name in the course of trade, provided that the use is made in accordance with the standards of fair competition and the third party has reasonable grounds for the use of the name.

Article 35. APPEAL

1. A person entitled to use a collective mark has the right to bring an action for infringement of the right to the use of the collective mark only with the permission of the association of holders of the mark, unless otherwise provided in the regulations governing the use of the collective mark.

Article 36. AMENDMENTS TO THE REGULATIONS GOVERNING THE USE OF A COLLECTIVE MARK

1. The holder of a collective mark is obliged to notify «Sakpatenti» of any changes made in the regulations governing the use of the collective mark.

2. Where making amendments in collective mark regulations, the requirements of Articles 31 and 32 shall be taken into account.

Article 37. CANCELLATION OF THE REGISTRATION OF A COLLECTIVE MARK

The registration of a collective mark may be canceled:

- (a) pursuant to Article 27 of this Law;
- (b) if the holder of the collective mark uses the mark in breach of regulations governing its use.

Article 38. NULLITY OF THE REGISTRATION OF A COLLECTIVE MARK DUE TO THE ABSOLUTE GROUNDS FOR REFUSAL OF REGISTRATION

As well as on the grounds given in Article 28 of this Law, a collective mark registration may be considered null and void if it has been registered in breach of the requirements of Article 33 of this Law. If the grounds for the annulment concern the rules for the use of the collective mark, the registration shall not be considered null and void if a collective mark holder amends the regulations in such a way that the grounds for its annulment no longer exist.

CHAPTER VI. PROTECTION OF TRADEMARKS IN ACCORDANCE WITH THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS (20.12.2005 № 2380 is in force from March 1, 2006)

Article 39. APPLICATION FOR INTERNATIONAL REGISTRATION OF A TRADEMARK (20.12.2005 № 2380 is in force from March 1, 2006)

1. This Law applies to the trademarks protection of which is claimed in accordance with the Madrid Protocol, unless otherwise provided in this Chapter of this Law or in the Madrid Protocol.
2. The application for the international registration of a trademark shall be filed with «Sakpatenti» in accordance with Article 3 of the Madrid Protocol.
3. The application shall be completed with an English translation of the list of goods grouped according to the International Classification.

Article 40. RECORDING OF THE INTERNATIONAL REGISTRATION

1. If the international registration is effected on the basis of an application filed with «Sakpatenti», the date and number of the international registration shall be recorded in the application data.
2. If the international registration is effected on the basis of the registration granted on the basis of an application trademark at «Sakpatenti», the date and number of the international registration shall be entered in the Register.
3. If international registration is effected as provided in paragraph (1) of this Article, the date and number of the international registration shall be recorded in the Register after registration of the trademark at «Sakpatenti».

Article 41. EXAMINATION OF A TRADEMARK EXTENDED TO GEORGIA ON THE BASIS OF THE INTERNATIONAL REGISTRATION UNDER THE PROTOCOL

RELATING TO THE MADRID AGREEMENT (20.12.2005 № 2380 is in force from March 1, 2006)

1. In relation to a trademark for which protection is claimed in Georgia on the basis of its international registration under the Protocol Relating to the Madrid Agreement (hereinafter referred to as - international trademark) only substantive examination shall be conducted.

2. The term “registration” used in Chapters I-V of this Law shall be replaced by the term “protection” with respect to international trademarks.

Article 42. PUBLICATION AND APPEAL

1. The particulars of the international registration of a trademark shall be published in the WIPO Gazette of International Marks by the International Bureau of the World Intellectual Property Organization (WIPO).

2. When the decision is taken to grant protection to the international trademark in Georgia, the date and number of the international registration shall be published in the Bulletin within one month from the taking of the decision. (20.12.2005 № 2380 is in force from March 1, 2006)

3. The opposition period provided for in Article 16(4) of this Law shall be calculated from the day of publication of the date and number of the international registration of the trademark.

Article 43. Extracted - (20.12.2005 № 2380 is in force from March 1, 2006)

Article 44. SUBMISSION OF A NATIONAL APPLICATION ON THE BASIS OF THE ANNULLED INTERNATIONAL REGISTRATION (20.12.2005 № 2380 is in force from March 1, 2006)

1. In accordance with Article 9^{quinquies} of the Madrid Protocol, on the filing of a national application on the basis of an annulled international registration, the applicant shall, together with the application, file the document certified by the International Bureau of WIPO confirming that the international registration applied to Georgia before it was annulled.

2. If on the date of filing with «Sakpatenti» of the national application specified in paragraph 1 of this Article, «Sakpatenti» has taken the decision to grant protection to the international trademark, substantive examination shall not be conducted on the national application.

3. If by the date of annulment of the international registration the international trademark was granted protection in Georgia, on the national application «Sakpatenti» conducts only examination as to form, as a result of which registers the trademark in the Register and publishes the data on the registered trademark in the Bulletin.

CHAPTER VII. ENFORCEMENT OF PROTECTION OF EXCLUSIVE TRADEMARK RIGHTS

Article 45. LIABILITY FOR INFRINGEMENT OF EXCLUSIVE TRADEMARK RIGHTS

1. Infringement of exclusive trademark rights incurs liability under the legislation of Georgia.

2. Where his exclusive rights are infringed the holder of the trademark may apply to the court seeking:

(a) prevention of the acts that infringe his rights;

(b) compensation for damages;

(c) destruction of all labels, pictures, imprints, packaging, packaging materials and advertisements that contain the registered trademark or a copy, resemblance or imitation thereof;

(d) destruction of the plates, matrices and printing blocks prepared for making the trademark and, if separation of the trademark from the goods is impossible, the destruction of the goods.

CHAPTER VIII. TRANSITIONAL PROVISIONS

Article 46. APPLICATIONS FILED AND CERTIFICATES GRANTED PRIOR TO THE ENTRY INTO FORCE OF THIS LAW

1. Applications for the registration of trademarks filed prior to the entry into force of this Law shall be considered in accordance with the Resolution N304 of the Cabinet of Ministers of Georgia of March 16, 1992 «Approving and Enacting the Statute on Trademarks».

2. Certificates granted for trademarks registered prior to the entry into force of this Law shall remain in force thereafter.

CHAPTER IX. FINAL PROVISIONS

Article 47. LEGISLATION REPEALED

1. On the entry into force of this Law the following shall be considered as repealed:
 - a) Resolution N304 of the Cabinet of Ministers of Georgia of March 16,1992 «Approving and Enacting the Statute on Trademarks».
 - b) Resolution N 483 «Additional Measures for the Regulation of Trademark Use in Georgia», approved by the Cabinet of Ministers of Georgia on June 25, 1993.

ENTRY INTO FORCE OF THE LAW

Article 48. This Law shall enter into force three months after its publication.

President of Georgia
Eduard Shevardnadze

Tbilisi,
5 February 1999
No. 1795-11s