

Modernization of Ukrainian Trademark Law: A New Generation of Protection

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Abstract

This article examines the current state of Ukrainian trademark law to enhance further Ukrainian integration into the European and global intellectual property law systems. Ukraine must be seen as a jurisdiction with a high level of trademark protection, as the momentum has swung in favor of Ukraine's admission to the European Union (EU). It also serves as a case study of a country transitioning from an older, obsolete trademark system to a modern one. The article explores the facets of trademark law, both substantive and procedural, that make up a modern, progressive trademark protection law system. The article uses United States (US) and EU trademark laws as benchmarks to compare the development of Ukraine's law on the subject. It explores recent legislative reforms and existing proposals to enhance trademark protection. Particular attention is paid to the 2020 and 2023 Amendments that recognize trademark dilution as a separate cause of action and provide a more precise delineation of the fair use of a trademark, as well as the modernization of the registration process and actions related to trademark opposition and infringement. Additionally, issues related to the revocation, invalidity, and enforcement of trademarks are analyzed. The article concludes that, when fully implemented, the existing intellectual property reform legislation will improve the efficiency of trademark protection in Ukraine.

Keywords: Trademark law, New Generation, Ukrainian integration, Property law systems, Ukrainian law

1. INTRODUCTION

It has been over thirty years since Ukraine gained independence from the former Soviet Union. Still, it has been only about ten years since the Euromaidan revolution¹ unseated a pro-Russian government and set Ukraine on a course towards greater integration with Europe. Ukraine has moved to reform its antiquated legal system to make membership in the European Union (EU) possible. One area in which it has lagged is the modernization of its intellectual property (IP) laws. Recent enactments have targeted this divergence to align Ukraine's IP law with the EU system. Despite the existential threat of Russia's recent invasion, Ukraine continues to adopt new laws in the IP area. This article focuses on the recent Ukrainian trademark (TM) law reforms. It analyzes the changes instituted by the 2020 "Law on Amendments on Strengthening the Protection of Trademarks"² and the "Law on Amendments on Strengthening the Protection of Intellectual Property Rights," which entered into force in April 2023³.

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¹ The Euromaidan revolution was a people-led uprising that led to the resignation of a pro-Russian president who had broken his promise to integrate with the EU.

² Verkhovna Rada of Ukraine, "Law on Amendments on Strengthening the Protection of Trademarks" (2020), <https://zakon.rada.gov.ua/laws/show/815-20#Text>. (Ukrainian language).

³ Verkhovna Rada of Ukraine, "Law on Amendments on Strengthening the Protection of Intellectual Property Rights" (2023), <https://zakon.rada.gov.ua/laws/show/2974-20#Text>. (Ukrainian language).

Again, despite the internal turmoil and wrath of the Russo-Ukrainian War, Ukraine continues to enact legislation to modernize its IP law system to join the EU and attract future foreign investment needed to rebuild its war-ravaged infrastructure. Besides the importance of reducing corruption in the government bureaucracy, modernizing IP law is the biggest challenge facing the Ukrainian government. Ukraine's 2023 Amendments to its IP law and the fuller implementations of the 2020 Amendments were delayed due to the war. Ukraine's substantive TM law has risen to EU and United States (US) standards. Further development of Ukraine's new IP office and processing and search systems will be required to complete the modernization.

Part 2 briefly examines the evolution of TM law in the US and the EU. Part 3 reviews the substantive TM and procedural law reforms brought by Ukraine's 2020 and 2023 Amendments, while Part 4 discusses institutional and procedural reforms. Part 5 delves into the details of the registration process as well as the scope of TM rights and the consequences of the non-use of TM. Part 6 concludes with a summary of the findings of the above analysis and assesses the current state of Ukrainian TM law.

2. EVOLUTION OF TRADEMARK LAW. HISTORY OF US TRADEMARK LAW

Before exploring the recent modernization of Ukrainian TM law, this section will briefly review the evolution of the US and EU TM systems to place Ukraine's TM reform in context. The purpose of this review is two-fold. First, it will provide the legal framework for developing a mature TM law system. This will allow for an assessment of Ukraine's TM law in its current state. Second, it will provide benchmarks for the different elements of a full-fledged TM protection system to determine if the recent reforms have resulted in such a system. International TM laws are established by the Paris Convention⁴ and Madrid Protocol⁵.

The beginning of US TM law can be traced back several centuries because IP infringement was recognized in the common law. So, although there was no national TM law or system, IP owners were still able to bring common law actions against infringers. The importance of IP is recognized in the 1789 US Constitution, where section 8, clause 8 (the Copyright Clause) states that Congress has the power to enact laws "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."⁶ Two noteworthy points are the need for a national IP law from the country's beginning and the omission of the word "trademark" in clause 8. This was because the US at that time was best characterized as an agrarian society where sales were local, and the importance of branding in a consumer economy was nonexistent.

The fact remains that TM infringement was recognized under state common law before the promulgation of the US Constitution. Still, there was no federal protection until 1870, when Congress moved to establish a federal TM regime, asserting that TM was implied in the Copyright Clause. This 1870 statute was purported to be an exercise of Congress's Copyright Clause powers. However, in the *Trademark Cases*⁷, the US Supreme Court invalidated the law, holding that TM could not be subsumed under copyright, and it struck down the 1870 statute. In response, Congress enacted the Trademark Act of 1881, arguing that this was an exercise of its powers under the US Constitution's Commerce Clause. The Supreme Court agreed this time, and the US had its first federal TM law.

The landmark Lanham (Trademark) Act is the primary federal TM statute in the US. The act prohibits a number of activities, including TM infringement and false advertising. Two basic requirements must be met for a mark to be eligible for TM protection: it must be in use in commerce and be distinctive. The Trademark Counterfeiting Act of 1984 amended the federal criminal code to make it a federal offense to violate the Lanham Act through the intentional use of a counterfeit TM. The act established penalties of up to five years' imprisonment and/or a US\$250,000 fine (US\$1,000,000 fine for a legal entity) for selling or attempting to sell counterfeit goods or services. Intentional use of a counterfeit TM or the unauthorized use of a counterfeit TM is an offense under Title 18

⁴ Paris Convention for the Protection of Industrial Property of 1883, WIPO (1883), <https://www.wipo.int/wipolex/en/treaties/textdetails/12633>.

⁵ Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, WIPO (1989), <https://www.wipo.int/wipolex/en/treaties/textdetails/12603>.

⁶ US Constitution (1789), https://constitutioncenter.org/the-constitution?gad_source=1&gclid=CjwKCAiAloavBhBOEiwAbtAJOz8er1dDO8dEGJux0VO3pk-Sh0gJSqUXV-haXoVyzAjLx6C-iC9uBoCXQcQAvD_BwE.

⁷ *Trademark Cases*, 100 U.S. 82 (1879), <https://supreme.justia.com/cases/federal/us/100/82/>.

of the *United States Code* (U.S.C.), which provides enhanced enforcement remedies through the use of *ex parte* seizures and the award of treble (triple) damages.⁸ A TM's duration is fixed at a period of five years, with the availability of continuous extensions for additional periods of five years.

The Lanham Act also recognizes collective TMs. There are two types of collective marks as defined by section 45 of the US Trademark Act of 1946:

- (1) collective trademarks or collective service marks; and
- (2) collective membership marks.⁹

A collective trademark or collective service mark is used by members of a collective organization to identify and distinguish their goods or services from those of non-members. By contrast, collective membership marks are used by members of a collective organization to indicate membership in the collective membership organization. Authorized users use certification marks to indicate the following:

- (1) goods or services certified as to quality, materials, or mode of manufacture;
- (2) goods or services certified to originate in a specific geographic region; and/or
- (3) the work or labor on goods or for services certified to have been performed by a member of a union or other organization or certified that the performer meets certain standards.¹⁰

The first significant amendment to the Lanham Act was the enactment of the 1996 Federal Trademark Dilution Act (FTDA).¹¹ It amended the definition of TM protection from infringement based on the likelihood of confusion to include TM dilution. It defines "dilution as the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of—(1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake, or deception."

US federal law protects famous TMs from uses that dilute their distinctiveness, even in the absence of any likelihood of confusion or competition. Courts have previously found that dilution can occur due to either "blurring" or "tarnishment." Blurring typically refers to the whittling away of distinctiveness caused by the unauthorized use of a mark on dissimilar products,¹² while tarnishment involves the unauthorized use of a mark that links it to products that are of poor quality or that portray the mark in an unwholesome or unsavory context, which is likely to reflect adversely on the owner's product.¹³ An example would be using the Barbie doll TM to promote an exotic dance club or online pornography sites.

Section 1125(c)(1) of the FTDA entitles the owner of a famous mark to an injunction against another person's commercial use of a mark or trade name in certain situations. First, the illicit use must begin after the mark has become famous and cause dilution of the mark's distinctive quality. Second, the court must determine if a mark has become famous based on the following factors: "(1) the degree of inherent or acquired distinctiveness of the mark; (2) the duration and extent of the mark's use in connection with the sale of goods or services; (3) the duration and extent of the mark's advertising and publicity; (4) the geographical extent of the trading area in which the mark is used; (5) the channels of trade for the goods or services with which the mark is used; (6) the degree of the mark's recognition in the trading areas and channels of trade used by the mark's owner and the person against whom the injunction is sought; (7) the nature and extent of use of the same or similar marks by third parties; and (8) whether the mark is registered."¹⁴

The FTDA provides three affirmative defenses: fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services with that of the famous mark's owner; non-commercial use of a mark; and any form of news reporting and news commentary.¹⁵ Fair use or

⁸ 18 U.S.C. § 1117 (in cases where the trademark-related counterfeiting was done in a wilfull or grossly negligent manner), <https://www.law.cornell.edu/uscode/text/18/part-I>.

⁹ *Ibid.*

¹⁰ United States Patent and Trademark Office, 79 Fed. Reg. 9678 (Feb. 20, 2014), https://www.uspto.gov/sites/default/files/trademarks/notices/NPRM_Changes_in_Requirements.pdf.

¹¹ Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985, <https://www.congress.gov/bill/104th-congress/house-bill/1295#:~:text=Federal%20Trademark%20Dilution%20Act%20of%201995%20%2D%20Amends%20the%20Trademark%20Act,dilution%20of%20its%20distinctive%20quality>.

¹² 15 U.S.C. § 1125 (c)(2)(B).

¹³ *Ibid.*

¹⁴ *Ibid.*

¹⁵ *Ibid.*

parody occurs when a descriptive mark is used in good faith for its primary rather than secondary meaning, and no consumer confusion is likely to result. So, for example, a cereal manufacturer may be able to describe its cereal as consisting of “all bran” without infringing on the Kellogg’s “All Bran” TM. Such a use is purely descriptive and does not invoke the mark’s secondary meaning.

Some courts have recognized a somewhat different but closely related fair use defense called nominative use. Nominative use occurs when the use of a term is necessary for identifying another producer’s product and not the user’s own product. In *New Kids on the Block v. News America Publishing, Inc.*,¹⁶ a newspaper conducted a survey asking fans who their favorite member of the pop band New Kids on the Block was. New Kids brought a suit for TM infringement. The newspaper prevailed because using the band’s name to conduct the survey was considered a nominative use.

With the creation of the internet, a targeted law was enacted to deal with the taking of domain names of famous companies. The 1999 Anticybersquatting Consumer Protection Act established a cause of action for registering, trafficking, or using a domain name confusingly similar to, or dilutive of, a TM or personal name.¹⁷

The 2006 Trademark Dilution Revision Act¹⁸ responded to the 2003 US Supreme Court decision *Moseley v. V Secret Catalogue, Inc.*,¹⁹ which held that a claimant was required to prove *actual* trademark dilution. Section 2(1) of the act states that a party may seek injunctive relief in cases where another party’s use of its mark “is likely to cause dilution.” Section 2(5)(B) remedies are available when “the mark or trade name is likely to cause dilution by blurring or dilution by tarnishment.” In the area of TM registration, section 3(a) states, “A mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 43(c), may be refused registration.” Again, in the case of a TM’s cancellation, section 3(c) provides a ground for cancellation when there is “a likelihood of dilution by blurring or dilution by tarnishment.” In sum, the revised act overturns *Moseley* by only requiring proof of the likelihood of dilution and not evidence of actual dilution.

3. EU TRADEMARK LAW

EU and US TM laws possess a great deal of commonality.²⁰ They are both grounded on the strength of TMs based on the degree of distinctiveness and infringement determined by a likelihood-of-confusion test. The three essential functions of a TM at the European level include identifying the origin of goods and services, guaranteeing consistent quality through evidence of the company’s commitment to the consumer, and providing a basis for publicity and advertising.²¹ The EU TM is valid for a period of ten years.

EU Directives 89/104/EC and 2008/95/EC introduced the optional provision of protection against TM dilution where evidence of the likelihood of confusion is unnecessary since the registered TM and the infringing TM relate to dissimilar goods or services. To make an infringement claim, the prior TM owner must have a reputation for quality, and the infringing mark “takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the trademark.” Relevant provisions are articles 4(4)(a) and 5(2) of the EU Trademark Directive.

In *Intel Corp. v. CPM United Kingdom Ltd.*, the European Court of Justice listed a number of factors to be weighed in a dilution claim: degree of similarity, nature of goods or services, the earlier mark’s level of reputation, the earlier mark’s degree of distinctive character, and the probability of confusion among consumers. However, a TM dilution claim is more difficult than under US law because the TM owner has the burden of proving *actual* economic damage.

Internationally, the 1883 Paris Convention for the Protection of Industrial Property was the first IP agreement covering inventions, trademarks, and industrial designs. It was subsequently followed by the 1891 Madrid Agreement for the International Registration of Marks. The US, EU, and Ukraine are all members of the Paris

¹⁶ *New Kids on the Block v. News America*, 745 F. Supp. 1540 (C.D. Cal. 1990), <https://law.justia.com/cases/federal/district-courts/FSupp/745/1540/1612234/>.

¹⁷ Anticybersquatting Consumer Protection Act, Pub. L. No. 106-113, 113 Stat. 1501, <https://www.congress.gov/106/plaws/publ113/PLAW-106publ113.pdf>.

¹⁸ Trademark Dilution Revision Act of 2006, Pub. L. No. 109-321, 120 Stat. 1730, <https://www.wipo.int/wipolex/en/legislation/details/15320>.

¹⁹ *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003), <https://supreme.justia.com/cases/federal/us/537/418/>.

²⁰ European Patent Convention (Oct. 5, 1973), <https://www.epo.org/en/legal/epc-1973/2006/convention.html>.

²¹ EUIPO, accessed May 18, 2024, <https://euipo.europa.eu/ohimportal/en/trade-marks-in-the-european-union>.

TABLE 1:
Comparison: US, EU, and Ukrainian Trademark Law

TM Law	United States	European Union	Ukraine
Distinctiveness	Generic/descriptive suggestive/arbitrary fanciful	Distinctive	Distinctive character
Secondary Meaning (acquired distinctiveness)	Yes	Yes	Yes
Likelihood of Confusion	Yes (intent)	Yes	Identical or misleading
Media Exception	Yes	Yes	Yes
Duration	10 years	10 years	10 years
Trade dress	Yes		
Certification or Collective Marks	Yes	Yes	Yes
Three Dimensional	Yes	Yes	Yes
Sound	Yes	Yes	Yes
Famous Marks	Yes	Yes	Yes
TM Dilution	Yes	Yes	Yes
Likelihood of Confusion	Yes	Yes	Yes
Remedies			
Criminal	Pirated or counterfeit government prosecution penalty/prison	Delegated to member States	Threshold of harm private prosecution penalty/barred from certain positions (3 years)
Disgorgement of Profits	Yes	Yes	Yes
Treble (triple) Damages	Yes	No	No
Paris Convention	Yes	Yes	Yes
Madrid Protocol	Yes	Yes	Yes

Source: Compiled by the authors.

Convention and Madrid Agreement. Table 1 provides a brief comparison of important TM concepts across US, EU, and Ukrainian TM law. Notice that after the implementation of the 2020 and 2023 Amendments, there is very little difference between the three TM legal systems.

4. UKRAINE'S LEGAL FRAMEWORK FOR TRADEMARK PROTECTION

In 1993, after the fall of the Soviet Union, Ukraine enacted a Basic Law of Trademark (TL)²², which had been revised or amended on thirteen occasions, representing incremental improvements at best. The path to the modernization of TM law did not begin in earnest until the recent passage of a significant reform package known as the Amendments 2020. This modernization intended to upgrade Ukrainian law to internationally recognized standards to improve market competitiveness, attract foreign investment, and facilitate integration with the EU. Most recently, further amendments were enacted by the Amendments 2023, related to strengthening IP rights.

These amendments were the product of the aforementioned 2014 Euromaidan revolution in which the Ukrainian people demonstrated their desire to move towards Europe as opposed to being economically dominated by the Russian Federation. The motivation for the amendments accelerated with the signing of the Association Agreement between Ukraine and the EU. The 2020 and 2023 Amendments, taken together, constitute a foundational change to Ukraine's TM law. As significant as the substantive law changes were in expanding the TM law's scope, there was also a key institutional reform (with the new rules and practices) aimed at increasing efficiency in the procedures related to the registration, opposition, and invalidation of TMs. Substantively, the amendments expanded the types of things that can be trademarked and clarified the roles of collective TMs, the fair use doctrine, and the scope of legitimate comparative advertising.

Trademark law has increased in importance with the proliferation of brands, especially in the virtual world.²³ A TM is a key element that distinguishes and individualizes a company and its products in the marketplace, whether

²² Verkhovna Rada of Ukraine, Law of Ukraine, "On Protection of Rights to Trademarks for Goods and Services" (Dec. 15, 1993), <https://zakon.rada.gov.ua/laws/show/en/3689-12#Text> or <https://ukrpatent.org/atachs/tm-law-of-ukraine.pdf>.

²³ B.I. Safro and T.S. Keaty, "What's in a Name? Protection of Well-Known Trademarks under International and National Law," *Tulane Journal of Technology & Intellectual Property* 6 (2004): 33–34, <https://journals.tulane.edu/TIP/issue/view/316>.

they are goods, services, or technology (digital content)²⁴. Ukrainian TM law covers the use of TMs in business documents, advertising, and on the internet. Use of a legal TM without the TM owner's consent is illegal. The basic framework of TM protection in Ukraine includes the 1995 Rules on Drafting, Filing, and Consideration of Trademark Applications, approved by the Order of the Ukraine Department for Intellectual Property,²⁵ the Constitution of Ukraine of 1996²⁶, the *Civil Code of Ukraine* of 2003²⁷, the Law of Ukraine on the Protection of Rights to Trademarks for Goods and Services of 1993,²⁸ and the Amendments 2020 and 2023. Furthermore, Ukraine has recognized the Nice Agreement on the International Classification of Goods and Services. Each Ukrainian TM covers a list of services and goods recognized under the Nice classification scheme²⁹.

A TM is a certain designation in the form of words, separate letters or symbols, images, colors, or combinations of words, letters, symbols, and images. The purpose of a TM is to distinguish the services or goods of one manufacturer, company, or person from the goods and services of another³⁰. A TM is often linked with a brand, brand mark, goods and services mark, or a collective mark. A TM may consist of such signs as words, including personal names, letters, numbers, or combinations thereof; pictorial elements, images, or symbols; labels or slogans; colors and their combinations; three-dimensional objects, such as product boxes and packaging; sound marks, odors, and fragrances; and combinations of any of the aforementioned. In the end, a TM's strength is dependent on its degree of distinctiveness. The following section discusses the idea of distinctiveness.

Besides the institutional reforms, the Amendments 2020 included the 'Strengthening Protection of Trademarks and Industrial Designs and Combating Patent Trolling' provisions. It also expanded the scope of TM protection. The types of marks or definitions of marks subject to TM protection were expanded to include things like sound and three-dimensional images, and new rules were included relating to collective marks.

The law provides for a standard procedure for applying and obtaining TMs that are considered to be conventional or figurative marks. Additional requirements apply to TMs involving sound, color, and three-dimensional marks. Color marks may be eligible for legal protection if the applicant provides evidence that the mark has become distinctive due to its use or secondary meaning. Finally, three-dimensional marks cannot simply repeat the appearance of a known subject but must present an original creation, and its shape cannot have a solely functional purpose. The peculiarity of such designations is that they must be specified in all three application dimensions³¹. For combination marks, such as those that include words and figurative marks, the originator has the option of registering for two separate TMs. Obtaining separate TMs for each element in a combined mark provides a greater level of protection against infringement. The amended law reinforces the need to update the TM registry's technical capabilities to process these newly recognized marks³².

The recently amended law has extended the scope of protection to collective TMs that identify the products or certifications of business associations or service organizations.³³ As a result, an association or similar organization may register collective TMs for use by its members to differentiate their goods and services from those of

²⁴ See EU Office for Harmonization in the Internal Market, "Ukraine: IP Country Fact Sheet," at Chapter 02, https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/observatory/documents/News/Ukraine-guide_en.pdf.

²⁵ Trade Marks Regulations. Intellectual Property Rules on Drafting, Filing and Consideration of Trademarks Applications, State Departments for Intellectual Property (1995), https://classic.austlii.edu.au/au/legis/cth/consol_reg/tmr1995230/.

²⁶ Constitution of Ukraine (June 28, 1996), <https://zakon.rada.gov.ua/laws/show/254%D0%BA/96-%D0%B2%D1%80#Text>. (Ukrainian language).

²⁷ *Civil Code of Ukraine* (Jan. 16, 2003), <https://www.wipo.int/wipolex/en/legislation/details/19455>. (Ukrainian language).

²⁸ Verkhovna Rada of Ukraine, "On Protection of Rights to Trademarks for Goods and Services" (n 22).

²⁹ Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (1957), <https://www.wipo.int/treaties/en/classification/nice/index.html>.

³⁰ *Civil Code of Ukraine* (n 27).

³¹ Verkhovna Rada of Ukraine, Law of Ukraine, "On Amendments to Certain Legislative Acts of Ukraine regarding the Creation of the National Intellectual Property Authority" (2023), <https://zakon.rada.gov.ua/laws/show/703-20#Text>. (Ukrainian language).

³² "Intellectual Property Law Reform in Ukraine," Mikhailyuk, Sorokolat & Partners (Aug. 25, 2020), https://mspcorporate.com/news/IP_Law_reform_in_Ukraine.html.

³³ G. Mykhailiuk, "Methods of Protecting the Rights to Commercial Signage: Experience of France and Ukraine," *NaUKMA Research Papers Law* 4, no. 6 (Dec. 2019): 52–58, https://www.researchgate.net/publication/337749063_Methods_of_Protecting_the_Rights_to_Commercial_Signage_Experience_of_France_and_Ukraine#fullTextFileContent.

non-members. Besides the standard criteria for TM registration, a collective TM application needs to include a list of individuals permitted to use the mark and a statement establishing conditions for its use. Examples of collective or service marks include the Good Housekeeping Seal of Approval for quality and Underwriter Laboratories (UL) for electronic devices.

The amendments create the option to register any form of a symbol as a TM as long as it possesses the capability to distinguish goods and services and can be presented in the TM register in a manner that enables both competent authorities and the public to distinctly and precisely determine the extent of protection. The recent legislation includes sound marks on the roster of eligible signs for registration, joining colors, product shapes, and packaging designs.

Two categories of marks do not qualify for TM protection: statutory exclusions and marks that are likely to cause confusion with products or services of previously recognized TMs. Under article 6 of the TL, legal protection is not granted to designations that represent or imitate the following:

- (1) national emblems, flags, and other state symbols;
- (2) official names of states;
- (3) symbols and short and full names of international intergovernmental organizations; or
- (4) official control and guarantee seals and stamps, awards, and other distinctions. However, with the consent of the TM owner, protected symbols may be incorporated as an element of a TM.

Article 6 also excludes from TM protection designations that “lack any distinguishing capacity [distinctiveness requirement] and do not obtain such capacity through their use [secondary meaning].” Examples of non-distinctive marks include those that consist of one letter, number, line, or simple geometrical figure; realistic images of goods; three-dimensional objects whose form serves a purely functional purpose; generally used abbreviations; and TMs that no longer distinguish a specific brand name, mainly due to third-party use.³⁴

Furthermore, article 6 excludes protection for TMs that “consist exclusively of signs that are commonly used for goods and services of a certain type.”³⁵ Marks that are purely descriptive in nature do not meet the threshold for TM protection. Thus, a mark that is derived from the kind, quality, composition, quantity, properties, purposes, value or benefits, place, name, or address of the manufacturer, and time of manufacturing or rendering of goods and services fails to meet the level of distinctiveness required for branding.³⁶

Other grounds for a TM registration’s rejection or a TM’s revocation are when the mark is deemed to be deceptive or liable to mislead as to the person or company that produces the goods or services; consists of signs, symbols, or terms that are commonly used; represents only the form caused by the natural state of goods; or to get a specific technical result.³⁷ This is the case of purely descriptive marks that are not distinct in any way, such as “Steel Shovels.” However, marks or signs not subject to TM protection may be used as minor elements of a TM.³⁸ An example would be “Koger Steel Shovels” or a sign for Koger Tools that incorporates an image of a steel shovel.

The general standard for TM infringement is the likelihood-of-confusion test. A party that uses a mark (junior user) that is likely to confuse an average consumer that its products and services are those of the TM owner (senior user) is liable for infringement. TM infringement aims to protect TM owners that first registered the mark in Ukraine or are subject to the protection provided by international IP conventions. In particular, famous or well-known marks are protected in Ukraine under article 6-*bis* of the Paris Convention for the Protection of Industrial Property Rights.³⁹ Qualified indications of country of origin are protected under the Ukraine Protection of Rights to Appellation of the Origin of Goods.⁴⁰ Country-of-origin marks may be used only

³⁴ DLF Attorneys-at-Law, “Trademark Protection in Ukraine,” § 2.2, at 5 (Oct. 2016), <https://dlf.ua/wp-content/uploads/2016/12/Trademark-protection-in-Ukraine-Doing-business-in-Ukraine.pdf>.

³⁵ Elena Polosmak, “The Battle for Odessa: The Story of Trademark Registration in Ukraine,” IP Watchdog (June 28, 2017), <https://www.ipwatchdog.com/2017/06/28/battle-odessa-trademark-registration-ukraine/id=84891>.

³⁶ Ibid.

³⁷ Verkhovna Rada of Ukraine, Law of Ukraine, “On Protection of Rights to Trademarks for Goods and Services” (n 22).

³⁸ Oleg Zhukhevych, Olga Danish, and Olga Kreshchenko, “Ukraine,” in *International Comparative Legal Guide: Trademark Laws and Regulations 2024* (London: Global Legal Group, 2024, <https://iclg.com/practice-areas/trade-marks-laws-and-regulations/ukraine>).

³⁹ Paris Convention for the Protection of Industrial Property (n 4).

⁴⁰ Verkhovna Rada of Ukraine, Law of Ukraine, “On the Protection of Rights to Appellation of the Origin of Goods” (June 16, 1999), <https://zakon.rada.gov.ua/laws/show/752-14#Text>. (Ukrainian language).

as non-protected elements of marks of a person or company entitled to such indications. Other protective rights include conformity, quality, or certification marks obtained under a recognized process and registered under domestic TM law.

Designations replicating registered industrial designs in Ukraine are not eligible for legal protection, nor are titles of scientific, literary, and artistic works known in Ukraine, quotations and characters from such works, or artistic works and their fragments, without the consent of copyright holders. Surnames, first names, pseudonyms and their derivatives, portraits, and facsimiles of persons known in Ukraine are also ineligible. Finally, any marks, signs, names, or pseudonyms related to the former Soviet Union, Ukrainian SSR, Communist Party, or other autonomous Soviet republics are precluded from TM registration.

TM law includes a fair use defense for the nominative or descriptive use of another's TM. For example, nominative fair use is not an infringement, such as the use of another's mark in comparative advertising. The Amendments 2020 recognize nominative or descriptive fair use as exceptions to TM infringement. First, the use of a registered TM concerning its quality, quantity, intended purpose, value, geographical origin, or any other characteristic is considered descriptive fair use.⁴¹ Second, nominative fair use refers to the use of a registered TM in commerce when it is necessary to determine the purpose of goods or services and when it is compatible with or is a part of the goods or services⁴² sold under the TM.⁴³

TM law's principle of nominative use is the counterpart to the exception of fair use found in copyright law. Nominative or fair use permits the use of someone's TM to refer to the goods and services associated with the mark. For example, a company may use someone's TM in trade to indicate the type of goods and services the user offers, such as selling additional equipment or spare parts related to the trademarked product.

Similarly, using another's TM in comparative advertising is recognized as a form of fair use. The Amendments 2020 expand the list of actions that do not constitute TM infringement in comparative advertising. Suppose the reference to a TM is used solely to distinguish the user's goods and services and emphasize their differences with those of the TM owner. In that instance, such use is permitted as long as there are no violations of unfair competition law.⁴⁴

5. INSTITUTIONAL AND PROCEDURAL REFORMS

5.1 Institutional reform

The principal purpose of the Amendments 2020⁴⁵, along with expanding the scope of TM law, was to reform and modernize the country's IP institutional structure and procedures. At the core of the reform movement was the implementation of a collective management system, including the creation of the Ukraine National Intellectual Property Office (UNIPO). The establishment of UNIPO was a culmination of a five-year goal outlined in the 2015 "Sustainable Development Strategy Ukraine – 2020," the "Concept of Reforming of the State System of Intellectual Property Legal Protection of 2016,"⁴⁶ and the "Plan of Measures on Implementation of the Concept of Reforming of the State System of Intellectual Property Legal Protection," adopted in 2016⁴⁷.

In October 2020, UNIPO replaced the Ukrainian Intellectual Property Institute (Ukrpatent) and subsumed certain functions of the Ministry of Economy of Ukraine (MoE), including the examination of applications for IP registration, the registration of IP, post-grant opposition procedures, the publication of official information, and the maintenance of IP rights registries. UNIPO is responsible for the protection of both industrial property (patent

⁴¹ Verkhovna Rada of Ukraine, "Law on Amendments on Strengthening the Protection of Trademarks" (n 2).

⁴² E. Polosmak, "The Battle for Odessa" (n 35).

⁴³ M. Malytkh and I. Alfiorov, "Ukraine Amends Trademark Law," PETOŠEVIĆ (Sep. 7, 2020), <https://www.petosevic.com/resources/news/2020/09/4333>.

⁴⁴ Verkhovna Rada of Ukraine, "Law on Amendments on Strengthening the Protection of Trademarks" (n 2).

⁴⁵ Verkhovna Rada of Ukraine, "On Amendments to Certain Legislative Acts of Ukraine" (n 31).

⁴⁶ Verkhovna Rada of Ukraine, "Concept of Reforming of the State System of Intellectual Property Legal Protection in Ukraine" (June 1, 2016), <https://zakon.rada.gov.ua/laws/show/402-2016-%D1%80#Text>. (Ukrainian language).

⁴⁷ Verkhovna Rada of Ukraine, "Plan of Measures on Implementation of the Concept of Reforming of the State System of Intellectual Property Legal Protection in Ukraine 2016" (2016a), <https://zakon.rada.gov.ua/laws/show/632-2016-%D1%80#Text>. (Ukrainian language).

and TM) and copyrights. The MoE supervises UNIPO operations and serves as a focal point for the formation and implementation of state IP policy. Furthermore, UNIPO's structure comprises the Appellate Chamber (post-grant oppositions and designation of famous TMs). The reforms seek to "bring more transparency and efficiency" to the patent and TM registration process.⁴⁸

5.2 Procedural reform

As important as the reform of TM substantive law was, the 2020 Amendments substantially changed the procedural aspects of TM law. These changes focused on technical aspects of registration and reregistration and the grounds for challenging the validity of TMs. This section provides a brief overview of the procedural changes, including the alternative pathways to TM refusal, termination, and invalidation. Section 5 provides a deeper investigation of the TM registration process, and Section 6 reviews the rights of the TM owner, non-use, and remedies.

The 2020 Amendments allowed TM applications for marks identical or similar to earlier registered TMs with a letter of consent from the TM owner as long as there was minimal risk of consumer confusion. A number of new challenges or grievances are available under the new law. A new ground for challenging a TM application or registration is a third party's assertion that the mark is confusingly similar to the third party's TM⁴⁹. The amendments also provide the opportunity to file a revocation of a TM petition with the Appeals Chamber within two months of registration approval. This right of petition is limited to those parties that filed a pre-grant opposition. The two-month appeal period is an essential improvement over the previous law's minimal period of five days before the final decision on the application. This new right to petition a grant of a TM provides an alternative to filing a lawsuit. In the case where the petition (appeal) is dismissed, the adverse party is still able to seek cancellation of the TM in court. As previously noted, TM owners who have registered their marks abroad may challenge TM registrations made by their agents or representatives in Ukraine without the owner's authorization. Apart from the invalidation of the TM certificate, the respective owner may request a court to transfer or assign all TM rights.⁵⁰

5.3 Expansion of Absolute and Relative Grounds for Registration Refusal⁵¹

Along with broadening the scope of TM protection, the amendments expanded the list of *absolute* and *relative* grounds for registration refusal and invalidation of TMs. The list of absolute grounds for refusal and invalidation of a TM includes the following:

- (1) The suggested TM contradicts a registered or pending plant variety designation in Ukraine or one that has received protection under an international agreement.
- (2) The TM is at odds with a registered geographical indication in Ukraine or one that has obtained protection through an international agreement. Additionally, it creates confusion regarding the specific quality, attributes, and genuine origin of the goods.
- (3) The TM provides a deceptive representation of the nature, quality, and geographical origin of the goods and services⁵².

There are three new relative grounds for challenging a TM or TM supplication. First, the TM is identical with or similar to an earlier TM right not only in terms of confusion but also in terms of association. Factors weighed in determining the misleading nature of a new mark are the similarity of marks, the mark's association with similar products or services, and the likelihood of confusing purchasers. Secondly, the TM is evaluated for its resemblance or similarity to the extent that it may cause confusion or association with a well-known (famous)

⁴⁸ R. Drobyazko and O. Stolyarenko, "Ukraine Establishes New National Intellectual Property Authority," European Business Authority (Sep. 11, 2020), <https://eba.com.ua/en/ukrayina-stvoryuye-novyj-natsionalnyj-organ-intelektualnoyi-vlasnosti>.

⁴⁹ Verkhovna Rada of Ukraine, "Law on Amendments on Strengthening the Protection of Trademarks" (n 2).

⁵⁰ A. Polikarpov and A. Kolodenska, "Ukraine Amends Trademark and Patent Legislation," CEE Legal Matters (Sep. 24, 2020), <https://ceelgalmatters.com/ukraine/14638-ukraine-amends-trademark-and-patent-legislation>.

⁵¹ Verkhovna Rada of Ukraine, "Law on Amendments on Strengthening the Protection of Trademarks" (n 2).

⁵² Ibid.

TM. This assessment considers whether the TM designates identical or similar goods or services, or if it designates non-similar goods or services but establishes an association with the owner of a well-known trademark, potentially causing harm to the owner's interests in the the famous mark. Thirdly, an agent or representative in their individual capacity submits a TM application without the owner's explicit consent, and there is no supporting evidence to justify such filing⁵³.

A variation of the second ground is the rejection or invalidation of a TM where the competing TM relates to the sale of dissimilar goods or services, but the holder of the earlier registered TM asserts that the similarity nonetheless harms its TM⁵⁴. In the US, this type of harm is referred to as "trademark dilution." The key to this modern expansion of TM law is that there need not be any likelihood of confusion between the trademarked goods or services as required under traditional TM infringement claims. This recognition that a similar mark can diminish a TM in a different market (different goods or services) is a major step towards modern TM law. For example, SONY televisions will not be confused with another company that sells Sony toilet paper. However, the original SONY TM may lose some of its distinction if it is used in association with more and more products. This type of harm is referred to as "blurring," or the slow diminishment of the distinctiveness of a TM through the unauthorized use of the mark on dissimilar products.

The case of *Mattel, Inc. v. Action Apparel*⁵⁵ involved another TM-related law that targets the use of famous trade names in meta tags and the third-party registration of domain names known as cybersquatters. In this case, a company selling beach clothes was ordered to cease using the domain names *barbiesbeachwear.com* and *barbiesclothing.com* since such use was an illegal form of blurring. "Tarnishment" is another type of diminishment of a TM in the sale of dissimilar products or services. It refers to the unauthorized linking of a TM to poor quality or unsavory products or services. An example is the early use of the Mattel toy company's Barbie doll TM in the meta tags of search engines, which resulted in searches providing links to pornography sites. This unsavory association is a clear case of tarnishment.

6. TRADEMARK REGISTRATION

This section reviews the application process to register a TM, which includes a two-stage approval process. The goal of the amendments was to make the registration process simple, transparent, and low-cost to make Ukraine an attractive forum for both domestic and foreign companies with large IP portfolios⁵⁶. TM registration involves a multistep process. First, the applicant files an application with UNIPO, which must include the following:

- (a) the applicant's name and address in the language of origin and in Ukrainian Cyrillic characters;
- (b) the mark's image and description;
- (c) a list of goods and services with which the mark will be associated;
- (d) the number, date, and country code of previous applications for the TM or the mark's date of exhibition to take advantage of a priority claim under the Paris Convention;
- (e) a copy of the previous application with its Ukrainian translation that is the basis for the claim of priority;
- (f) a power of attorney if an applicant's representative is filing the application; and
- (g) a document confirming payment of the official filing fee.⁵⁷

Second, UNIPO, at an initial, first-stage, or cursory review, examines the application to determine if it meets the threshold requirements of TM law (verification of compliance with formal requirements of the law and

⁵³ I. Alfioriv, "Mattel Inc. Overcomes Obstacle to Barbie Trademark Registration in Ukraine," PETOŠEVIĆ (Oct. 9, 2019), <https://www.petosevic.com/resources/news/2019/10/4190>.

⁵⁴ Verkhovna Rada of Ukraine, "Law on Amendments on Strengthening the Protection of Trademarks" (n 2).

⁵⁵ *Mattel, Inc. v. Adventure Apparel*, 00 Civ. 4085 (RWS) (S.D.N.Y. Mar. 22, 2001), <https://casetext.com/case/mattel-inc-v-adventure-apparel-2>.

⁵⁶ G. Prokhorova, "Non-Use Trademark Cancellation in Ukraine: Trends, Challenges, and Solutions," International Trademark Association (May 15, 2019), <https://www.inta.org/perspectives/non-use-trademark-cancellation-in-ukraine-trends-challenges-and-solutions> (password protected).

⁵⁷ Verkhovna Rada of Ukraine, "Law on Protection of Rights to Trademarks for Goods and Services" (n 22).

compliance with all legal protection conditions),⁵⁸ such as the existence of relevant data, goods, or services that will use the mark; payment of the official application fee; and the affixment or certification of the filing date. The declared list of goods and/or services is scrutinized to ensure alignment with the current edition of the International Classification of Goods and Services in accordance with the Nice Agreement. In a case of necessity, the examiner provides a request. The applicant must respond to the request within two months of receiving it, with the possibility of prolonging the term from three to six months. If the application satisfies the official demands, the official examination report is granted, and the application goes to the examination stage on its merits.

The third step involves a substantive examination to determine UNIPO's approval of the registration⁵⁹. During this phase, the asserted TM undergoes an examination to verify its conformity with the criteria for legal protection, considering both absolute and relative grounds. If there are reasons to believe that the claimed mark does not meet the requirements for the provision of legal protection, UNIPO sends a preliminary refusal to the applicant with recommendations on how to bring the application into compliance. The applicant has two months to respond to the provisional refusal, with the option of extending this period from three to six months.

Fourth, the final step in the registration process in cases of a favorable decision is the payment of the state duty for TM registration and issuance of a certificate of TM registration⁶⁰. A trademark certificate is issued upon payment of the official registration fees and the decision to grant protection. Next, UNIPO publishes relevant information on its website (information regarding the registered TM is disseminated in the official bulletin and on the UNIPO website)⁶¹. Before publication, the new TM must be sharply defined and presented in color (or a combination of colors). The TM colors must also be presented on the type of surface used in the TM application. If a sound mark is granted, it must be presented in the form of a phonogram.

Famous TMs, which are registered under the Madrid System for the International Registration of Marks as governed by the Madrid Agreement of 1891 and the Protocol to the Agreement of 1989, may alternatively obtain TM protection in Ukraine. As a member of the Paris Convention, Ukraine may refuse or vacate an application upon the presentation of a certified copy of an earlier application that was filed within six months of the Ukrainian application.

The TM registration process takes about two years, assuming it is not subject to a third-party challenge. However, a fast-track registration procedure (six to eight months) is available for an additional fee. The average fee for the registration of a colored word, figurative, or combined TM within a single class of the International Classification of Goods and Services is US\$400.00.⁶² The applicant is required to submit the official registration and publication fees within three months of receiving the decision. If necessary, the official fee payment term may be extended by not less than three and not more than six months as long as the corresponding petition is presented to UNIPO prior to the specified deadline. The renewal of a missed deadline is also possible if the corresponding application is submitted within three or six months after its expiration. Upon payment of the official registration fees, the MoE proceeds to register the TM and publishes the pertinent information in the official bulletin and online registry.

The issuance of the registration certificate occurs within one month following the registration of the TM and the payment of all necessary fees.⁶³ The rights arising from the issuance of the TM registration certificate are retroactive to the date of the application. The certificate is valid for ten years following the date of application submission, subject to non-use challenges and can be renewed every ten years at the TM owner's request and payment of the required fee⁶⁴.

7. RIGHTS AND LIMITS OF TRADEMARK OWNERSHIP, NON-USE, AND REMEDIES

This section briefly reviews the rights of TM owners. It also discusses the creation of TM rights in otherwise non-distinctive marks and limitations on an owner's ability to bring a claim of TM infringement. One limitation, the

⁵⁸ Ibid.

⁵⁹ Ibid.

⁶⁰ Ibid.

⁶¹ See Zhukhevych, Danish, and Kreshchenko, *International Comparative Legal Guide* (n 38).

⁶² Ibid.

⁶³ Verkhovna Rada of Ukraine, "On Protection of Rights to Trademarks for Goods and Services" (n 22), art. 14.

⁶⁴ Zhukhevych, Danish, and Kreshchenko, *International Comparative Legal Guide* (n 38).

fair use doctrine, was discussed in section 5 above, while the first sale doctrine and challenge for non-use are discussed below.

7.1 Rights and Limits of Trademark Ownership

The rights guaranteed to TM owners include unhindered usage of the TM in association with their goods or services, the exclusive right to permit the use of the TM, the right to prevent the unlawful usage of the TM, the right to use the marking ® or TM, and the right to register a domain name (.ua). Generally, marks lacking distinctive characteristics do not qualify for TM protection. However, a mark can acquire distinctiveness through extensive use to create a secondary meaning. Evidence of prior usage must be submitted to UNIPO to prove that the TM has acquired distinctiveness. The prior use must not be a type that is considered to be an abuse of the TM. One example of abuse is known as “ambush marketing.”⁶⁵ Most ambush marketing campaigns aim to associate a brand with the prominence of a major event. The brand strategically, but not officially, attaches itself to a well-publicized event like the World Cup to gain instant notoriety. Such a strategy cannot be the basis for claiming distinctiveness by use.

The law provides for cases in which a TM may be used without the TM owner’s consent. These exceptions include the following:

- (1) exercise of any right that arose before the date of prior submission of the application for registration;
- (2) non-commercial use of the TM;
- (3) use in news reports and commentary;
- (4) fair use of names and addresses;⁶⁶
- (5) use of TMs for goods commercialized under the consent of the certificate holder unless the consent prohibits further sales, especially when goods change or deteriorate over time;
- (6) businesses dealing with trademarked goods or services when the mark is used to indicate the type, quality, quantity, purpose, value, geographical origin, time of goods production, or goods or services characteristics;⁶⁷
- (7) business use of the TM to indicate the purpose of the goods or services, in particular, their use as additional equipment or spare parts; and
- (8) TM use in comparative advertising to distinguish goods and services by objectively emphasizing their differences.

More importantly, TM protection ends after the original sale of a trademarked product. In sum, a purchaser is not restricted in reselling the trademarked item. In the US, this is referred to as the “first sale doctrine,” internationally known as “exhaustion of rights,” unless the further sale would diminish the TM, such as a decline in quality over time by repeated use or when the reseller modifies the product.

Finally, when a TM expires, the owner has a limited right of reregistration. The original applicant-owner has a preferential right to reregister in cases where the applicant had voluntarily withdrawn a prior application within two years of the new application. This priority is useful when a TM owner fails to renew its TM on time or when it partially surrenders the TM. The time frame for reregistering a TM has been shortened from three to two years after its cancellation. It is possible to reregister TMs that were invalidated due to either nonrenewal within the specified time-frame or the TM owner’s voluntary surrender of the mark, either wholly or partially. Another individual can also reregister TMs with the former owner’s consent.

7.2 Enforcement of Trademark Rights

Trademark owners have exclusive rights to use their TMs. Therefore, any unauthorized commercial use of TMs is treated as infringement. It is illegal to place a TM or confusingly similar mark on labels, goods, or packaging without the TM owner’s consent. Consequently, various legal actions may be brought against TM infringers in

⁶⁵ S. Stepanenko, “Trademarks Management: Struggle against Parasitism,” *Journal of European Economy* 13, no. 1 (2014): 80–82, <https://jeej.wunu.edu.ua/index.php/enjee/article/view/726>.

⁶⁶ DLF Attorneys-at-Law, “Trademark Protection in Ukraine,” § 3.3, at 12 (Oct. 2016), <https://dlf.ua/wp-content/uploads/2016/12/Trademark-protection-in-Ukraine-Doing-business-in-Ukraine.pdf>.

⁶⁷ *Ibid.*, § 2.2, at 5.

criminal, administrative, and civil proceedings. Criminal proceedings allow for the collection of fixed statutory penalties or damages. Administrative proceedings include those for the invalidation or revocation of a conflicting TM. Civil proceedings may also lead to revocation or invalidation but also allow a claim for damages.

The *Criminal Code of Ukraine* provides for criminal liability for TM infringement⁶⁸, punishable by payment of monetary penalties and deprivation of the right to hold managerial positions in companies or engage in certain commercial activities for three years. Two elements need to be satisfied under the *Criminal Code*. First, it must be proven that there was an illegal use of a TM, brand name, or qualified indication of the origin of the goods. Second, the violation must cause significant pecuniary damages. Statutory penalties range from approximately US\$464.00 to US\$929.00 per infringement. If there are repeated violations of a TM from the same company, companies, or groups of persons that caused gross damages, the penalties increase from US\$1,394.00 to US\$4,649.00. The highest level of penalties ranges from US\$4,649.00 to US\$6,974.00. The highest level of penalties is reserved for cases of organized group violations that cause large-scale pecuniary damages.⁶⁹

Guided by newly adopted legislative provisions, Ukrainian law enforcement agencies, particularly the National Police of Ukraine operating under martial law (due to the Russo-Ukrainian War), have gradually renewed the coordinated efforts to respond to violations of IP rights. For instance, in February 2023, the Cyber Unit of the National Police established a working partnership with the Ukrainian National Office of Intellectual Property and Innovations to counter infringement more effectively. The National Police has also fostered cooperation with the largest media corporations and public-private partnerships while initiating the establishment of working groups and proposing legislative amendments aimed at simplifying the procedure of conducting pretrial investigations.⁷⁰

The uniqueness of the application of Ukraine's criminal law in the area of TM infringement is the delegation of prosecutorial authority to private parties. The rationale given for this delegation is that since TMs are private rights, it is a rights holder or licensee who should be entitled to pursue a criminal prosecution of the infringer. There is a parallel in US law where government prosecutors and private parties can enforce some public laws. This is the case of US antitrust (competition) law enforcement. The difference is that only the government can bring a criminal action, while private parties can only bring civil actions. That said, the difference between US antitrust (competition) law's private enforcement and Ukraine's assignment of private standing to TM owners to bring suit under its *Criminal Code*, is mostly a matter of semantics. First, unlike US criminal law's action for piracy or counterfeiting a TM, the *Criminal Code*'s private claim provides for smaller financial sanctions. The infringer is only subject to the payment of penalties and limitations on the right to hold specific positions or participate in particular activities for a period of up to three years. Finally, US antitrust law provides for the unique remedy of treble (triple) damages. This means that the actual proven damages are tripled by statute. This is the essence of a penalty since nothing more needs to be proven, and its purpose is to punish the infringer.

Administrative proceedings are more appropriate in situations when an offense does not cause material damage (greater than US\$382.00). Administrative proceedings are common in cases involving pharmaceutical TMs. However, the paucity of statutory fines⁷¹, ranging from US\$4.60 to US\$92.00 under Ukraine's criminal and administrative law, makes it unlikely that Ukraine will be the venue for major TM disputes other than civil litigation.

Civil litigation often involves seeking non-monetary and monetary remedies. Non-monetary remedies are court orders prohibiting an ongoing infringement or invalidating an infringing TM certificate. In 2019, the Commercial Cassation Court in Case no. 910/18587/16⁷² upheld the lower court's approach of assessing the similarity of TMs in invalidating a TM certificate. The court highlighted the factors to be used in determining the

⁶⁸ Verkhovna Rada of Ukraine, *Criminal Code of Ukraine*, (2001), <https://zakon.rada.gov.ua/laws/show/2341-14#Text>. (Ukrainian language).

⁶⁹ DLF Attorneys-at-Law, "Trademark Protection in Ukraine," § 4, at 13 (Oct. 2016), <https://dlf.ua/wp-content/uploads/2016/12/Trademark-protection-in-Ukraine-Doing-business-in-Ukraine.pdf>.

⁷⁰ "Cyber Police Will Cooperate with the Ukrainian National Office of Intellectual Property and Innovations," National Police of Ukraine (Feb. 4, 2023), <https://www.npu.gov.ua/news/kiberpolitsiia-spivpratsiuvatyme-z-ukrainskym-natsionalnym-ofisom-intelektualnoi-vlasnosti-ta-innovatsii>. (Ukrainian language).

⁷¹ Verkhovna Rada of Ukraine, *Code of Administrative Offences* (2001), <https://zakon.rada.gov.ua/laws/show/80731-10#Text>. (Ukrainian language).

⁷² Supreme Court of Ukraine, Cassation Commercial Court (July 15, 2019), <https://verdictum.ligazakon.net/document/83059424>. (Ukrainian language).

similarity of TMs: (1) the key factor of the likelihood of confusion between the TMs from the perspective of the average consumer; (2) the similarity of TMs based on the overall impression created by the TMs, such as differences in graphic presentation; and (3) the similarity of the marks' packaging. The similarity of packaging is considered more likely to confuse consumers than phonetic similarity because consumers link packaging to a given brand and not to the TM's words.

Article 20 of the Law of Ukraine "On the Protection of Rights to Marks for Goods and Services" permits a TM holder to bring suit against another party that obtains a conflicting registration certificate, especially those involving pharmaceutical products. In *Corvalment v. Cormento*⁷³, the Supreme Court of Ukraine ruled that the Ministry of Health's formal adherence to the existing drug registration procedures should in no way take precedence over IP rights or question the exclusivity of a previously registered TM.

The key venue for major claims of TM infringement is the civil courts, where actual, provable damages may be recovered. Damages can be calculated using multiple approaches, including (1) the TM owner's costs for restoration of the TM or what is called "real damages" and (2) lost profits (reduced market share). Another remedy that should be considered is the remedy of disgorgement as provided in the Amendments 2023. Disgorgement allows the TM owner to recover the infringer's profits related to the infringement. In the area of remedies, the Supreme Court of Ukraine, in Case no.910/18587/16, upheld the recovery of non-pecuniary damages (damages that are hard to calculate, such as emotional distress or pain and suffering) related to the utilization of a comparable symbol on the packaging of goods⁷⁴. However, this type of restitution for moral damage in TM infringement cases is rare. The next section reviews remedies recognized under the Amendments 2023.

7.3 New Remedies for TM Infringement

The Amendments 2023 entered into force on April 15, 2023⁷⁵, amending several IP-related laws and the *Civil Procedure* and *Commercial Codes*. The law further aligns Ukrainian law with that of the EU, specifically EU Directive 2004/48/EC⁷⁶. In the area of TM protection, the Amendments 2023 amend provisions for the TL.⁷⁷ The major change incorporated new provisions to increase liability and regulate the compensation procedure for TM rights violations. Paragraph 2, article 20, allows a TM owner to obtain an order to cease TM infringement and seek "material damages by indemnification or payment of compensation." In determining the damages, the Amendments 2023 state that these are the "loss of profits or income derived by the infringer as a result of his violation of the rights of the certificate owner." This provision, as noted above, recognizes the remedy of disgorgement as an alternative to the TM owner's loss of profits. In cases where it is difficult to calculate the TM owner's amount of sales lost or the reduction in market share caused by the infringement, the profits made by the infringing party can be used as a substitute means of determining damages.

Other factors enumerated in the Amendments 2023 that courts should weigh include "the nature of the violation, the culpability of the infringer and other essential circumstances."⁷⁸ For example, whether the infringement was willful or inadvertent can play a role in the assessment of damages. The Amendments 2023 note that in either case, the standard royalty rate for the TM licensing to the infringing party fixes the minimum amount of damages owed ("compensation shall not be less than the amount of remuneration paid for granting permission to use rights").⁷⁹ This benchmark of minimal damages would be applied in cases where the infringement was inadvertent and without negligence.

⁷³ I. Tomarov, "Trademark v. Medicine Registration Certificate: Case law review" (June 22, 2020), <https://www.vkp.ua/en/publication/trademark-v-medicine-registration-certificate-case-law-review>.

⁷⁴ *Ruling Case no. 522/561/17*, Supreme Court of Ukraine (Dec. 12, 2018), <https://zakononline.com.ua/court-decisions/show/78977577>. (Ukrainian language).

⁷⁵ Verkhovna Rada of Ukraine, "Law on Amendments on Strengthening the Protection of Intellectual Property Rights" (n 3).

⁷⁶ "IPR Enforcement Directive," European Parliament and of the Council (2004), <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A32004L0048R%2801%29>.

⁷⁷ Verkhovna Rada of Ukraine, "On Protection of Rights to Trademarks for Goods and Services" (n 22).

⁷⁸ Verkhovna Rada of Ukraine, "Law on Amendments on Strengthening the Protection of Intellectual Property Rights" (n 3).

⁷⁹ *Ibid.*

The Amendments 2023 now provide the remedy that requires the infringer to pay for the expense of the removal from the market and destruction of infringing goods or services as well as the destruction of materials and tools used in their manufacture. The law also introduced an alternative remedy in the form of payment of cash reimbursement in which the infringer requests such a payment instead of paying the costs for the removal and destruction of infringing goods. This would be used in unintentional infringement cases and when the removal and destruction remedy would be disproportionately expensive.

Finally, at the TM owner's request, the court may order the publication in the media of the infringement and court decision at the infringer's expense. In cases where it is difficult to prove the actual damages caused by an infringement, the Amendments 2023 now permit the courts to award a lump sum.

7.4. Challenge for non-use

As noted above in previous sections and below, TM rights are not absolute, as they are restricted by the fair use and non-use principles. Under Ukrainian law⁸⁰, if a TM owner fails to use its TM for a period of five years, either directly or through licensing, any person has the right to bring a judicial proceeding to invalidate or cancel the TM certificate. A cancellation lawsuit is generally needed before a third party can apply to register the TM on its own behalf.⁸¹

The amendments provide new rules relating to the non-use of TMs. First, non-use is defined as five years of continuous non-use starting from the date of TM registration or five years of continuous non-use thereafter. Previously, the non-use grace period was three years. In such cases, the TM is subject to an action of cancellation⁸². The five-year period was required under the EU-Ukraine Association Agreement (EUUA)⁸³, which came into force on September 1, 2017⁸⁴. Article 197 of the EUUA states that, if within five years from the date of completion of the registration procedure, "the owner has not put a trademark to genuine use in the relevant territory, or if such use has been suspended during an uninterrupted period of five years, the trademark shall be subject to sanctions." Also, a person bringing a claim of cancellation for non-use is no longer required to prove that it is an "interested party." Another change is that resuming use to restore the TM is precluded if such action occurs within three months before filing a non-use claim in cases where the TM owner knew or should have known of the impending challenge.⁸⁵

Adequate use of a TM includes affixing the mark on any goods and services listed in the TM certificate. The mark may be placed on the product package, label, tab, tag, or another item attached to the goods and signboards connected to the goods. Other sufficient uses of TMs include placing marks on storage containers, using the mark when offering or providing services, and using marks in business documents or advertising, on the internet⁸⁶, and in domain names. A third party's use of a TM with the consent of the TM owner, such as a licensee or distributor, and an entitled person's use of a collective TM, are considered genuine uses of a TM.

In an action of cancellation, the TM owner must provide proof of use. Alternatively, the owner may submit proof that the non-use was justifiable. Justifiable reasons for non-use include circumstances preventing the TM's use that are outside the owner's control, such as import restrictions, other legal requirements for goods and services, and litigation involving the TM. Good reasons for non-use are usually understood as obstacles directly affecting the mark's use, making its use impossible or unreasonable⁸⁷. For instance, if a TM is associated with a particular

⁸⁰ Verkhovna Rada of Ukraine, "On Protection of Rights to Trademarks for Goods and Services" (n 22).

⁸¹ A. Chernoknyzhnaya, "The Procedure and Specific Features of Cancellation of the Registered Trademarks on the Ground of Non-Use in Ukraine," IPR Group (Digest #01, 2018), <https://iprgroup.info/the-procedure-and-specific-features-of-cancellation-of-the-registered-trademarks-on-the-ground-of-non-use-in-ukraine>.

⁸² R. Drobyazko and M. Koval-Lavok, "Ukraine: Trademark Law Makeover," European Business Association (Sep. 2, 2020), <https://eba.com.ua/en/ukrayina-pokrashhennya-zakonodavstva-u-sferi-ohorony-prav-na-torgovelni-marky>.

⁸³ European Union, Association Agreement between Ukraine, of the One Part, and the European Union and the European Atomic Energy Community and their Member States, of the Other Part (June 27, 2014), <https://eur-lex.europa.eu/legal-content/EN/ALL/?uri=CELEX%3A22014A0529%2801%29>.

⁸⁴ M. Malytkh and I. Alfiorov, "Ukraine Amends Trademark Law" (n 43).

⁸⁵ A. Polikarpov and A. Kolodenska, "Ukraine Amends Trademark and Patent Legislation" (n 50).

⁸⁶ EU Trade Mark Regulation 2017, European Parliament and of the Council (June 14, 2017), <https://www.ippt.eu/legal-texts/eu-trade-mark-regulation-2017>.

⁸⁷ G. Prokhorova, "Non-Use Trademark Cancellation in Ukraine" (n 56).

medicine, and a regulatory body has not approved its use, this is considered a reasonable non-use. The TM owner bears the burden of proving compelling reasons for non-use.⁸⁸

7.5 Grounds for trademark opposition, revocation, and invalidity

This section reviews the law regarding challenges to TM registration, as well as the rescission of a previously issued TM. Oppositions and responses are considered at the stage of UNIPO's substantive examination of the TM, in which it is determined whether the application is subject to absolute and relative grounds for refusal. As noted above, a party may file an opposition to granting the TM within three months from the date of the publication of the application. The applicant for the TM has two months to file a response to the opposition from the date they received the notification of opposition. Applicants may refute the objections, amend their applications, or withdraw them. Opponents may file an appeal to a final decision granting a TM within two months; previously, the right to appeal was limited to five days.

In cases where the TM application is rejected, the applicant must submit a response, such as providing additional information to UNIPO. The response to the provisional rejection should include arguments supporting the TM's registration. Typically, presenting documentation validating the active utilization of a TM in Ukraine is often regarded as a compelling justification for the TM's registration.⁸⁹ UNIPO reviews the arguments presented in the response to the provisional rejection before making a conclusive decision.

The judicial grounds for a TM's revocation are as follows: (1) the mark has transformed into a widely adopted symbol, serving as a distinctive identifier for goods and services of a specific category, past the filing date of the application; (2) the mark has not been fully utilized in Ukraine within five years, either in its entirety or concerning the goods and services specified in the TM certificate; (3) the revocation is voluntary at the request of the TM owner; and (4) the revocation is automatic for failure to pay the renewal fee.

The law of Ukraine "On the Protection of Rights to Marks for Goods and Services" allows for the full or partial invalidation of a registered TM because the registered mark did not or no longer meets the requirements for granting legal protection. Reasons for invalidation include the TM certificate containing elements of a previously issued TM or the filing of the application infringing on the rights of other parties. The invalidation is retroactive to the application's filing date. The TM owner has the right to lodge a counterclaim against cancellation and appeal a first-instance court decision to the Appeals Chamber and eventually to the Court of Cassation.⁹⁰

As noted above, a TM may be revoked due to non-use. In such cases, there must be *prima facie* evidence of non-use. After this initial presentation, the burden shifts to the defendant to prove either the use or an acceptable reason for non-use.

8. MODERN UKRAINIAN TRADEMARK LAW: FINDINGS

It can now be said that the recent reforms, which the 2020 and 2023 Amendments introduced, have given Ukraine a modern TM law aligned with the EU and US TM systems (see Table 1). In short, Ukraine has implemented all IP rights enforcement-related provisions under the EU-Ukraine Association Agreement (EUUA). The "Pulse of Agreement," a monitoring system on the implementation of the IP measures required in the EUUA, shows that following the enactment of the Amendments 2023, 98% of the IP-related part of the EUUA has been implemented. This is no surprise because EU experts prepared the modernization of Ukraine's IP laws.

Whether the TM system enacted into law becomes a functional system in reality is dependent on its implementation through the new IP infrastructure and systems established under the new law. The long-term functionality of the TM protection system will depend on establishing the High Intellectual Property Court (HIPC)⁹¹, which will hopefully be the vehicle for the continued development of TM law and provide consistency across the Ukrainian court system. The HIPC is a court of first instance, meaning it is the trial court for all cases involving IP rights.

⁸⁸ M. Malytkh and I. Alfiorov, "Ukraine Amends Trademark Law" (n 43).

⁸⁹ Zhukhevych, Danish, and Kreshchenko, *International Comparative Legal Guide* (n 38).

⁹⁰ Ibid.

⁹¹ Verkhovna Rada of Ukraine. Law of Ukraine, "On the Court System and the Status of Judges" (2016b), <https://zakon.rada.gov.ua/laws/show/1402-19#Text>. (Ukrainian language).

Hopefully, it will function much like the US Court of Appeals for the Federal Circuit in Washington, DC, which harmonizes patent law throughout the US by acting as a “mini-Supreme Court” since all trial court decisions involving patents are appealed there. The HIPC instead has the power to set IP law’s meaning and policy from the very beginning at the trial court level.

The impact of IP modernization laws is not only dependent on the HIPC’s establishment but also on the quality of judges appointed to it. The judges must be experts in IP law, willing to streamline the litigation process and create a stable body of jurisprudence. The establishment of the Intellectual Property Chamber of the Supreme Court of Ukraine will hopefully highlight the importance of judicial expertise and the laws’ harmonization. Again, the judges’ levels of professionalism and expertise will determine the success of these new courts.

Finally, based on a Resolution of the Cabinet of Ministers of Ukraine no. 943, UNIPO is being replaced by a new agency, the Ukrainian National Office for Intellectual Property and Innovations (UANIPPIO). UANIPPIO’s objectives are to continue to align and update the law and its implementation with the best practices made available by the World Intellectual Property Organization (WIPO), the European Union Intellectual Property Office (EUIPO), and the US Patent and Trademark Office (USPTO). This is an invaluable function since those entities continuously publish materials and can be used as benchmarks and sources for the implementation of new laws and revisions to future laws to respond to technology acceleration, such as the metaverse, and a likely need for broader image rights protection. This new agency will have a broad scope of authority, including fostering international cooperation, education, information, and publishing activities, and providing services and consultations on IP matters. In the area of TM, UANIPPIO has a long list of goals and responsibilities, including

- (1) bringing the list of exclusive rights of the TM owner into compliance with EU requirements;
- (2) updating the procedure for submitting an application for TM registration in line with EU regulations;
- (3) determining the classification of goods and services for which a TM is registered;
- (4) introducing expertise on the absolute grounds for refusal to register a TM;
- (5) implementing the procedure for publishing an application for TM registration;
- (6) determining the procedure for the transfer of ownership rights;
- (7) introducing the procedure for filing objections by third parties against submitted applications for TM registration;
- (8) determining the procedure for renewal of TM registration;
- (9) coordinating the grounds for cancellation of the TM;
- (10) bringing the provisions of the law on the definition of the term “collective mark” and its use;
- (11) implementing the appropriate decision-making mechanism regarding objections to the registration of TMs;
- (12) implementing the appropriate decision-making mechanism on refusal and cancellation of TM registration; and
- (13) implementing the appropriate mechanism for transparent decision-making and creating the possibility of revocation in the field of protection of TM rights in accordance with EU regulations. UANIPPIO recently announced its plan to launch a mediation center to help resolve disputes.

9. CONCLUSION

In a short period of time, Ukraine has moved from a first-generation TM law (prevention of the likelihood of confusion between different brands) to a second-generation law (dilution of the value of a TM; expansion of recognizable marks). Since the enactment of the TL in 1993, following the collapse of the Soviet Union, Ukraine has been building a modern TM law through constant attention and revision to the extent that it has reached the threshold of a sophisticated and modern TM law system. This article reviews the major changes in institutional, substantive, and procedural law reforms enacted by the 2020 and 2023 Amendments to Ukraine’s TM law.

The reform of Ukrainian TM law is a look to the future as the amendments provide the basis for further advancement, but more still needs to be done at the institutional level. The TM “law in the books” is substantial and sufficient, but the “law in action” is still yet to be proved. Ukraine’s government must build the infrastructure (offices, courts, databases) to create a fully functional, modern IP legal system. Those applying for TMs must have trust in the system in place—access to government databases to check the similarity of pre-existing TMs, fair and efficient review of TM applications, and efficient procedures to challenge applications for TMs and invalidate existing TMs.

The advancement of further reforms will be achieved in two ways—legislation and decisions of the newly created HCIP, which includes a Court of First Instance and an Appeals Court. These courts can strengthen TM protection through their interpretation of existing law. The ability of these new courts to harmonize and modernize Ukraine's TM law will depend on the judges' levels of expertise in national and international IP law. If the HCIP fails to take the initiative, it will fall back to the legislature to provide additional and more detailed reforms to guide the courts.

Despite the disruption of the Russo-Ukrainian War, Ukraine has continued the process of adapting national IP law to conform to EU law as outlined in the EUUA. Recent amendments have served to simplify the process of obtaining TM protection and to safeguard the commercialization of innovative and creative products in Ukraine. This article has noted that modern TM law will need to continue to evolve with technological changes. This will involve expanding TM law into the area of digital image rights, which affects private individuals engaged in new-generation gaming; online influencers; content providers; and the metaverse. This will only be possible through the proper functioning of the new institutions created under the 2020 and 2023 Amendments.

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