

# **LAW OF GEORGIA ON DESIGN**

## **Chapter I General Provisions**

### **Article 1. Scope of Regulation**

1. According to the Constitution of Georgia this Law recognizes the inviolability of the property right of intellectual property subject-matter – design; it shall regulate relations associated with creation, registration, use, legal protection of a design and enforcement of the deriving rights.
2. Application of this Law shall extend to a design registered by the National Intellectual Property Center of Georgia Sakpatenti in the Register of Industrial Property (hereinafter - the Register) according to the rule established by the law or to which an international registration extends.
3. A design which is not registered at Sakpatenti or to which an international registration does not apply shall be subject to protection under the Law of Georgia “On Copyright and Related Rights”.

### **Article 2. Definition of Terms**

1. Terms used in the Law shall have the following meanings:
  - a) National Intellectual Property Center Sakpatenti (hereinafter – Sakpatenti) – legal entity of public law defined by the Patent Law of Georgia;
  - b) International Bureau – the International Bureau of the World Intellectual Property Organization;
  - c) 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<sup>1</sup>) Convention Relating to International Exhibitions – the Paris Convention on International Exhibitions of November 22, 1928;

- d) Designer – a natural person who has created a design as a result of creative intellectual work;
- e) Co-designer - a natural person who has created a design as a result of joint creative intellectual work with other natural person(s);
- f) Design holder– a person who possesses an exclusive right on a design and who is entered as a design holder in the Register by Sakpatenti;
- g) Certificate – a document issued according to this Law in the name of the design holder, which confirms the fact of design registration at Sakpatenti at the moment of its issuance;
- h) Applicant – a natural person or legal entity who requests registration of a design;
- i) Application – unity of the documents necessary for the design registration according to this Law;
- j) Hague Agreement – Hague Act of November 28, 1960 and/or Geneva Act of July 2, 1999 of the Hague Agreement Concerning the International Registration of Industrial Designs;
- k) International Design – a design registered by the International Bureau with the request of extension of rights to the territory of Georgia according to the Hague Agreement;
- l) International Classification of Designs – the international classification established by the Locarno Agreement Establishing an International Classification for Industrial Designs, signed on October 8, 1968;
- m) Priority – the privilege enjoyed by an application as compared with an application filed later;
- n) Convention Priority – the priority established under Article 4 of the Paris Convention which the applicant can exercise in another member state of the Paris Convention or the World Trade Organization;

- o) Exhibition Priority – the priority established under Article 11 of the Paris Convention which the applicant can exercise in another member state of the Paris Convention or the World Trade Organization;
- p) Chamber of Appeals – the Chamber of Appeals, functioning at Sakpatenti, defined by the Patent Law of Georgia.

### **Article 3. Design and its Protection Criteria**

1. A design is the appearance of the whole product or its part resulting from the features of the product proper, including lines, contours, colors, shape, texture and/or material or decoration of the product.
2. A product is any industrial or handmade item, including packaging, get-up, graphical symbol, printing type, component part intended to be incorporated into a complex product, except a computer program.
3. A complex product is a product which is composed of a number of components, which may be replaced by disassembling and re-assembling the product.
4. A design is eligible for protection if it is new and has individual character.
5. A design is novel if no identical design has become available to the public before the application filing date or the date of priority. (02.07.2010 № 3279)
6. Except the circumstances specified in Article 6 of this Law, in the course of determining the novelty of the design, a design filed with Sakpatenti, which has an earlier priority, but was published after filing of the application for the design for which novelty is being established, shall also be deemed made available to the public. This rule also applies to the design registered at the International Bureau for which extension of protection to the territory of Georgia is requested.
7. Designs shall be deemed to be identical even if their features differ only in insignificant details.
8. A design is of individual character if the overall impression it produces on the informed user differs from the overall impression produced on the same user by

another design which has been made available to the public before the application filing date or the priority date. (02.07.2010 № 3279)

9. In the course of assessing individual character, the degree of freedom of the designer during creation of the design shall be considered.
10. A design incorporated in a product or used for it, which is a component part of a complex product, shall be considered novel and individual if it is visible within the complex product in the course of its normal use and the visible parts meet the criteria of novelty and individual character.
11. For the purposes of this Article "normal use" shall mean the use by the end user, except for technical service, current and repair works.

#### **Article 4. Scope of Legal Protection of a Design**

1. The scope of legal protection of a design shall be determined by its appearance.
2. The scope of legal protection shall not extend to a word or sequence of words incorporated in the design.
3. The scope of legal protection of a design shall include any design which does not produce on an informed user a different overall impression.
4. In the course of determining the scope of legal protection of a design, the degree of freedom of the designer during creation of the design shall be considered.

#### **Article 5. Accrual of Exclusive Rights on a Design and the Term of Validity**

1. Exclusive rights on a design originate in case of its registration at Sakpatenti from the date of filing of an application, also according to this Law, through extension of an international registration, based on the Hague Agreement.
2. A certificate shall be issued for a design registered at Sakpatenti.
3. An applicant shall be authorized to register a design at Sakpatenti for one or more periods of five years, but not for more than 25 years from the date of filing the application with Sakpatenti.

## **Article 6. Making a Design Available to the Public**

1. A design shall be deemed made available to the public, if it was published, exhibited or used in trade or otherwise became available to the public before the application filing or the priority date.
2. Notwithstanding the circumstances specified in Paragraph 1 of this Article, a design shall not be deemed to be made available to the public if:
  - a) through the action provided for in Paragraph 1 of this Article a design would not have been made available to the persons carrying out activity in the relevant field on the territory of Georgia;
  - b) information on the design directly or indirectly has been made available to a third party, on condition of protecting confidentiality.
3. Disclosure of information on a design shall not be deemed as making the design to the public , if this information became available to a third party within 12 months before the application filing or the priority date:
  - a) by disclosing information on the design by the designer or his/her successor;
  - b) by disclosure of information about the design by a third party, if this information became available to the third party as a result of providing this information to him/her by the designer or his/her successor or other action taken by the designer or his/her with respect to the third party, through which he/she obtained the mentioned information;
  - c) as a result of an unfair action taken by a third party with respect to the designer or his/her successor.

## **Article 7. Design Determined Solely by its Technical Function and Interconnected Design**

1. Protection shall not extend to those features of a design:
  - a) which are solely determined by their technical function;

- b) which should be necessarily presented in the design exactly in such a form and dimension in order to allow the product into which the design is incorporated, or for which it is applied, to be mechanically connected to or placed in, around or on the opposite side of another product so that each product can perform its own function.
2. Sub-paragraph “b” of Paragraph 1 of this Article shall not extend to a design which serves the purpose of allowing multiple assembly or connection of mutually interchangeable products within a modular system.

### **Article 8. Relationship between Co-designers**

Relationship between co-designers shall be defined by the agreement concluded between them. In case of absence of the agreement, each of them enjoys equal joint rights.

### **Article 9. Right to Register a Design**

1. The right to file an application shall vest in the designer or her/his successor in title, except for the cases referred to in this Article.
2. The right to file an application for a design developed jointly by several designers shall vest in all designers jointly as well as in each of them in case of the written consent of other co-designers, unless otherwise provided for by the agreement between the co-designers.
3. The right to file an application for a design created by a staff member and/or a hired employee in the course of fulfilling the official or contract duty, shall vest in the employer/contractor, unless otherwise provided by the contract.
4. Paragraphs 4 of Article 9 shall be repealed.
5. Paragraphs 5 of Article 9 shall be repealed.
6. If one and the same design is created independently by two or more persons, the exclusive right to the design belongs to the applicant whose application has an earlier priority.

7. If several applications for identical designs have been established the same priority, the right to register design belongs to the person(s) indicated in the agreement of the applicants. A dispute in case of disagreement of the parties shall be resolved by the court.

#### **Article 10. Grounds for Refusal of Design Registration**

A design shall not be registered if:

- a) it does not comply with the requirements of Article 3(1) of this Law.
- b) it is identical to an earlier design, which was filed with Sakpatenti or registered at the International Bureau with the request to extend protection to the territory of Georgia and was published prior to the relevant application filing or the priority date;
- c) it is identical to an earlier design, which was published after the application filing or the priority date, but was filed with Sakpatenti or registered at the International Bureau with the request to extend protection to the territory of Georgia before the above-mentioned date;
- d) its registration is contrary to the public order or recognized moral principles;
- e) it completely or in any of its constituent elements coincides with a sign that is not subject to registration under Article 6<sup>ter</sup> of the Paris Convention, and in addition, there is no appropriate permission from the relevant competent authority of Georgia and/or a foreign country;
- f) it completely or in any of its constituent elements coincides with the herald, flag, emblem or sign of an international organization or the herald, flag or emblem of a state body or a municipal body of Georgia that is not protected under Article 6<sup>ter</sup> of the Paris Convention, but there is a public interest with respect to it in the territory of Georgia, in addition, there is no consent from the owner of this sign and/or the relevant competent authority of Georgia and/or a foreign country for its use;

g) the design or its constituent element displays an appellation of origin of goods or a geographical indication which has been granted protection on the territory of Georgia based on the local registration, a bilateral or international treaty.

## **Chapter II**

### **Filing an Application, Examination and Registration**

#### **Article 11. Application**

1. An application shall be filed with Sakpatenti by the applicant or his/her representative.
2. If the applicant is the designer's successor in title, a document verifying the succession shall be attached to the application at the time of filing or within 2 months from the filing date.
3. If the application was filed by an applicant's representative, a document verifying representation shall be attached to the application at the time of filing or within 2 months from the filing date.
4. The application shall contain:
  - a) a request for the registration of the design (hereinafter - the request);
  - b) a view (representation) of the design.
5. An application may contain a description which is only of explanatory nature.
6. An application shall be filed with Sakpatenti by means of direct submission of the application material or in other way.
7. An application shall be considered to be filed with Sakpatenti from the moment of filing of the application and the view of design.
8. The form of the application and the rule of filing shall be determined by the Instruction on Design Registration (hereinafter - the Instruction).



## **Article 12. Multiple Application, Unification and Division of Applications**

1. An application may contain one or more designs if its constituent designs belong to one class of the International Classification of Designs (multiple application).
2. An applicant is entitled:
  - a) to unify applications and file a unified application if its constituent designs belong to one class of the International Classification of Designs (unified application);
  - b) to divide the filed application into separate applications (divisional application).
3. Each design contained in a multiple or unified application shall be considered independently from others and shall constitute an independent object of protection.

## **Article 13. Priority**

1. An applicant wishing to enjoy the convention priority should file an application with Sakpatenti within 6 months from filing the first application for this design in a member state of the Paris Convention or the World Trade Organization.
2. An applicant wishing to benefit from the exhibition priority shall file an application with Sakpatenti within 6 months from the date of exhibiting the design at an official or officially recognized exhibition, according to the Convention Relating to International Exhibitions, held in a member state of the Paris Convention or the World Trade Organization.
3. The exhibition and convention priorities shall not be cumulative.
4. In cases envisaged by Paragraphs 1 and 2 of Article 12 of this Law an applicant has the right to request for a particular design the priority that it has.
5. A priority shall not be established for an application by the date of filing the application for which an earlier priority has already been claimed.

## **Article 14. Examination of a Design Application**

1. Sakpatenti shall conduct examination of an application, on the basis of which it shall take a decision on the registration of a design.

2. Examination includes confirmation of the application filing date, conducting of examination as to form and substantive examination, the rule of conducting which shall be determined by the Instruction.

#### **Article 15. Confirmation of the Filing Date**

1. Sakpatenti shall confirm the date of filing an application within 2 weeks from its filing.

2. Where an application is found to be lacking any of application materials required by Paragraph 4 of Article 11 of this Law, the applicant shall provide such materials within 1 month from the date of receiving the notification.

3. Where an applicant complies with the requirements of Paragraph 2 of this Article, the date of compliance shall be considered as the application filing date. In case of the failure to comply, the application shall not be considered filed.

#### **Article 16. Examination as to Form**

1. After the confirmation of an application filing date, Sakpatenti shall conduct examination as to form in the course of which the completeness of the application and compliance with the form as well as its correspondence with the requirements of Article 12 of this Law shall be checked.

2. Sakpatenti shall conduct examination as to form within one month from the confirmation of the application filing date.

3. Based on the examination as to form, Sakpatenti shall take a decision on the completion of examination as to form or termination of the application proceedings and shall inform the applicant.

#### **Article 17. Substantive Examination**

1. Within 3 months from the completion of the examination as to form, Sakpatenti shall conduct substantive examination, which envisages checking of

compliance of the design with the requirements of Article 10 of this Law and search to determine novelty.

2. In the course of determining novelty according to Sub-paragraphs “b” and “c” of Article 10 of this Law Sakpatenti shall take into consideration designs filed with Sakpatenti or designs registered by the International Bureau with the request to extend rights to the territory of Georgia.

3. A design revealed as a result of the study indicated in Paragraph 2 of this Article which complies with the condition contained in Sub-paragraph “a” of Paragraph 3 of Article 6 of this Law shall not be considered in the course of establishing novelty.

4. Based on the substantive examination Sakpatenti shall take a decision on the design registration or on refusal to register the design.

5. In case envisaged by Paragraphs 1 and 2 of Article 12 of this Law Sakpatenti may take a positive decision in relation to a part of the designs contained in the application.

#### **Article 18. Extension and Restoration of the Procedural Timeframes**

1. In the course of application proceedings, the applicant has a right to request according to the prescribed rule:

- a) to make an amendment and/or correction to the filed application material, provided that such action does not change the scope of the design protection;
- b) to postpone publication of the design for no more than 30 months from the date of filing the application or the priority date. In case of a multiple application, the request for postponing publication may concern all as well as separate designs contained in it;

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- c) to suspend the consideration of the application;
- d) to extend the timeframe for submission of a reply to the requirement of Sakpatenti;

e) to reinstate the rights related to the application forfeited due to the failure to meet the timeframes.

2. The rule of implementation of the actions under Paragraph 1 of this Article shall be determined by the Instruction.

#### **Article 19. Publication of a Design**

1. In case of taking a decision on the design registration Sakpatenti shall publish the application data and the design view according to the prescribed rule in the Official Bulletin of Industrial Property (hereinafter – Bulletin).

2. In case of replacement of a refusal to register a design, taken by examination by a legally enforced positive decision of the court, Sakpatenti shall publish the application data and the design view according to the prescribed rule in the Bulletin.

3. In case of a designer's request Sakpatenti shall not publish his/her name.

#### **Article 20. Grounds of Appeal at the Chamber of Appeals**

1. An applicant shall be entitled to file an appeal to the Chamber of Appeals against a decision of Sakpatenti on the completion of examination as to form or termination of the application proceedings, as well as a decision of the substantive examination on refusal of the design registration.

2. An interested party shall be entitled to file an appeal to the Chamber of Appeals of against a decision on the substantive examination on the design registration if the requirements of Article 17 of this Law are violated;

3. The person envisaged in Article 29(6) of this Law shall be entitled to file an appeal against a decision of substantive examination on the design registration to the Chamber of Appeals, if the grounds specified in Paragraph 1 of the same Article exist

4. In case of a multiple or a unified application the appeal may concern one or several designs contained in it.

4<sup>1</sup>. In case of invalidation of a decision of substantive examination on a design registration on the grounds specified in Article 29(1)(b), (e) or (f) of this Law, the

design may be registered in a modified form, if the modified design meets the protection criteria and the essence of the original design is preserved.

4<sup>2</sup>. A design may be registered in a modified form:

- a) on the basis of the applicant's request, in which he/she refuses extension of protection on a part of the design;
- b) by entering in the Register data or the application the decision of the court, the Chamber of Appeals or re-examination of the design, by which the design registration was declared partially invalid.

5. An appeal may be filed to the Chamber of Appeals within 3 months from the publication/receipt of the respective decision.

6. The Chamber of Appeals shall hear the appeal under the established rule within 3 months from the filing date of the appeal.

7. A decision of the Chamber of Appeals may be appealed in the court within the term prescribed by law.

## **Article 21. Design Registration**

- 1. If within the term provided for by Paragraph 5 of Article 20 of this Law no appeal is filed to the Chamber of Appeals, or the Chamber of Appeals takes a decision to register a design on the basis of a filed appeal, Sakpatenti shall register the design in the Register under the established rule.
- 2. Sakpatenti shall publish the data on the registered design in the Bulletin and issue a certificate.
- 3. Sakpatenti shall define the form of the certificate and the data to be entered into the Register.
- 4. Any person has the right to familiarize with the Register data.

## **Article 21<sup>1</sup>. Preliminary Search**

1. Any interested person is entitled to apply to Sakpatenti to receive the service of preliminary search in order to determine whether a design identical to a specific design is protected in Georgia by means of registration at Sakpatenti or by extension of the validity of the international registration of the design.
2. Sakpatenti shall conduct preliminary search and notify the interested person about its results within 10 working days after payment of the fee established by it for the service of preliminary search.
3. The procedure for conducting preliminary search shall be determined by the Instruction.”.

## **Article 22. Accelerated Procedure of Design Registration**

1. Unless provided otherwise by this Article, the rule under Chapter II of this Law shall apply for the accelerated procedure of design registration.
2. At the time of filing an application or within a month from the application filing, the applicant may request conducting accelerated examination.
- 2<sup>1</sup>. The applicant is entitled to request transition from the accelerated registration procedure of a design to the procedure provided for in this Chapter at any stage of examination, prior to the design registration.
3. The application requesting accelerated examination shall be accompanied by all documents specified by Article 11 of this Law and the fee prescribed for the accelerated procedure of design registration shall be paid.
4. If an applicant wishes to benefit from the priorities defined in Paragraphs 1 and 2 of Article 13 of this Law, application requesting to conduct accelerated examination shall be accompanied by a document certifying the right to claim priority and the fee prescribed for claiming priority shall be paid.
5. Within 3 days from requesting accelerated examination Sakpatenti shall check 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

shall take a decision to refuse conducting accelerated examination and shall process the application according to the rule provided for in Chapter II of this Law.

6. If the application requesting accelerated examination meets the requirements of Paragraphs 3 and 4 of this Article, within 7 working days Sakpatenti shall conduct substantive examination under Article 17 of this Law and in case of taking a positive decision shall register the design in the Register, publish the data on the registered design in the Bulletin and issue a certificate.

7. Within 3 months from the publication of the data on the design registration in the Bulletin any interested person shall be entitled to file an appeal to the Chamber of Appeals under the rule established by paragraph 20 of this Law.

8. If after the registration of a design through the accelerated procedure, an application entitled to enjoy an earlier priority is filed with Sakpatenti and if there exists the ground or refusal of an application registration provided for by Paragraphs “b” or “c” of Article 10 of this Law exists in relation to the design registered through the accelerated procedure, Sakpatenti shall take a decision on the cancellation of the accelerated registration of the design and shall publish it in Bulletin.

9. The decision on the cancellation of the accelerated registration of the design, referred to Paragraph 8 of this Article may be opposed under the rule established by Paragraph 1 of Article 20 of this Law .

### **Article 22<sup>1</sup>. Re-examination of a Design**

1. An interested party is entitled, during the validity period of the design registration, to request re-examination of the design on one of the following grounds:

- a) the design is represented only by the features envisaged in Article 7(1) of this Law;
- b) at the time of the design registration, any of the grounds envisaged in Article 10 of this Law existed;
- c) the design does not meet the requirements of Articles 3(4-10) of this Law;
- d) the design registration infringes the copyright of a third party;

e) the design uses a distinctive sign and the owner of the right to it, in accordance with the relevant legislation, is entitled to prohibit such use of the distinctive sign.

2. The request for re-examination of the design shall be accompanied by:

a) written argumentation that the design registration is subject to invalidation;

b) a copy of all previously issued registrations, publications or other relevant documents on which the interested party relies for argumentation. In addition, if the documents provided for in this Subparagraph are submitted in a foreign language, the interested party shall submit their notarized Georgian translation within 1 month. Otherwise, documents submitted in a foreign language shall not be considered.

3. The holder of the design is entitled to submit a written response within 2 weeks from submission of the request for re-examination of the design, which shall be taken into account during re-examination of the design.

4. Based on conducting re-examination of the design, Sakpatenti shall take a decision on refusal to invalidate the design registration or on the full or partial invalidation of the design registration.

5. The data of full or partial invalidation of the design registration shall be published in the Bulletin and entered in the Register.

6. Re-examination of the design may also be requested after revocation of the design registration or the expiration of its registration.

7. In case of invalidation of the design registration when the grounds provided for in Paragraphs 1(b), (d) or (e) of this Article, it is possible to maintain the registration of the design in a modified form in accordance with the rule established by Article 20(42) of this Law, if the modified design meets the protection criteria and the essence of the original design is preserved.

8. The rule of conducting re-examination of a design shall be determined by the Instruction.



### **Article 23. Service Fee**

1. For conducting examination as to form, conducting substantive examination, publication and registration of a design, conducting accelerated examination, conducting re-examination of a design, maintenance of the validity of a design registration for every 5 years, preliminary search service, filing an appeal, making amendments to Register data and fulfillment of other actions related to legal protection of a design the fee shall be paid in accordance with the rule established by the legislation of Georgia.
2. Non-payment of the fee determined under Paragraph 1 of this Article within the specified time limit shall entail the termination of application proceedings.
3. The form and amount of the fee shall be determined by the resolution of the Government of Georgia.
4. The form and the rule of payment of the fee shall be determined by the Instruction.

## **Chapter III**

### **International Design**

### **Article 24. Extension of Effect of an International Design Registration to the Territory of Georgia**

An international design the effect of the registration of which is extended to the territory of Georgia shall have the same legal force as a design registered in Georgia.

### **Article 24<sup>1</sup>. Filing an Application with the International Bureau through Sakpatenti**

1. The applicant is entitled to file an application for the purpose of international registration of a design with the International Bureau through Sakpatenti.
2. The conditions for filing an application provided for in Paragraph 1 of this Article shall be determined by the Instruction.

## **Article 25. Examination of an International Design**

1. For an international design Articles 10, 12, 17, 19 and 20, Article 28 (except Article 28(1)(c) and Articles 29-30<sup>1</sup> of this Law shall apply.
2. If a design does not meet the registration requirements of this Law, within the timeframe established by the Hague Agreement Sakpatenti shall take a decision on the refusal of extension of the effect of the international design registration to the territory of Georgia and shall notify the International Bureau.
3. Norms established by the Hague Agreement shall apply to the term of the effect of international design registration and its extension.

## **Chapter IV**

### **Exclusive Rights on Design**

## **Article 26. Scope of the Exclusive Rights on Design**

1. A design holder exploits the design at his/her discretion. The design holder has the right to sell or otherwise alienate the design, issue a private license under the established rule.
2. Design registration assigns the design holder the exclusive right to permit or prohibit making, selling, offering for sale, using, importing, exporting or putting on the market the product, into which the design is incorporated or for which it is used, and storage of such a product for these purposes.
- 2<sup>1</sup>. In case of postponement of the design publication provided for in Article 18(1)(b) of this Law, the holder of the design shall have the right to prohibit the actions specified in Paragraph 2 of this Article only in the event if the disputed use of the design is the result of reproduction of the registered design. The disputed action shall not be considered as reproduction of a registered design if it is the result of independent creation of a third party to whom this design was not available.
3. If the design is held by several persons:
  - a) the right can be assigned or a private license can be issued only with the consent of all holders;

b) each holder has the right to use a registered design in his/her own production without the consent of the other holders.

4. From the day of the publication of an application to its registration the applicant shall be conventionally assigned the same rights which he/she would have been granted after the registration. If the registration is not implemented, the referred rights shall not be deemed originated.

5. The following shall not be deemed as violation of the exclusive rights deriving from the design registration:

a) dissemination after putting on the market or other use of the product prepared by the design holder or by his/her permission into which the design is incorporated or for which it is used;

b) application of the design for personal use, if such an action is not intended for entrepreneurial purposes;

c) use of the design for experimental purposes;

d) copying the design, which is performed for the purposes of citation or teaching, provided that such copying is not considered as a bad faith action and does not damage the normal use of the design and the source is indicated;

e) use of the design on the sea vessel, aircraft or land vehicle of any country during its temporary presence on the territory of Georgia. In this case the design shall be used only on such a vehicle and not for entrepreneurial purposes;

e<sup>1</sup>) use of the design during importation into Georgia of spare parts and accessories for the purpose of repairing the sea vessel, aircraft or land vehicle referred to in Subparagraph “e” of this Paragraph;

e<sup>2</sup>) use of the design in the course of carrying out repair work on the sea vessel, aircraft or land vehicle referred to in Subparagraph “e” of this Paragraph;

f) use of the design in case of urgent necessity (force majeure) determined by the legislation of Georgia.

### **Article 26<sup>1</sup>. Right to a Designer's and a Co-designer's Name**

The designer and co-designer shall have the right to be indicated in the application and the Register in the manner as is provided for indicating the applicant and the design holder.

### **Article 27. Right of Prior Use**

1. The right of prior use means a person's right to use a design regardless of the effect of its registration, if such a person has been using the design in good faith or conducted preparatory works for its use before the date of filing the application with Sakpatenti or the priority date. (02.07.2010 № 3279)
2. The right of prior use allows a third party to exploit the design for a purpose and to such an extent with which he/she has already used this design or for which he/she has made preparation works, before the application filing or priority date.  
(202.07.2010 № 3279)
3. It shall be impermissible to issue a private license for the right of prior use.
4. The right of prior use can be transferred only together with such an enterprise, where the actions envisaged by Paragraph 2 of this Article were implemented.

### **Article 28. Revocation of a Design Registration 1. A**

design registration may be revoked by Sakpatenti:

- a) on the basis of a request of the design holder;
- b) In case of non-payment of the maintenance fee for extension of the term of validity of the design registration by the design holder, if the period specified in Paragraph 2 of this Article has expired;
- c) based on Paragraph 8 of Article 22 of this Law;
- d) in case of the death of the holder of the design – a natural person, if he/she has no heir, or in case of the liquidation of the holder of the design – a legal entity, if its successor does not exist.

2. In case envisaged by Paragraph 1(b) of this Article, the registration of a design shall not be deemed revoked if within 6 months from expiration of the term of validity of the design registration the design holder pays the its maintenance fee for the following period, and if at the same time 25 years have not passed from the commencement of the validity of the design registration. In case of failure to meet the 6-month timeframe specified in this Paragraph, the design registration shall be revoked from the date of expiration of the validity period of its registration, without the right to reinstate it.

2<sup>1</sup>. If there are several holders of a design, the design registration on the basis of Paragraph 1(a) of this Article shall be revoked with the consent of all holders of the design.

2<sup>2</sup>. Revocation of the design registration may affect one or more designs covered by a multiple application.

2<sup>3</sup>. If a license issued for a design is registered in the Register, the request of the design holder for revocation of the design registration may be satisfied only if he/she submits evidence that he/she has notified the licensee about his/her decision.

3. The rights assigned by the design registration shall be considered terminated from the date of the entry of the record on the revocation of the registration into the Register, except for the case provided for in Paragraph 2 of this Article.

4. Information on the revocation of the design registration shall be entered in the Register and published in the Bulletin.

## **Article 29. Invalidation of a Design Registration**

1. A design registration shall be declared invalid by the court if it is ascertained that:

- a) the design is represented only with the features envisaged by Article 7(1) of this Law;
- b) at the time of registration of the design any of the grounds provided for in Article 10 of this Law existed;

- c) the design does not comply with the requirements of Article 3(4-10) of this Law;
- d) at the time of registration of the design the applicant or the design holder was not an authorized person according to Articles 8 and 9 of this Law;
- e) the design infringes the copyright of a third party;
- f) in the design a distinctive sign is used and the holder of the right to it, in accordance with the relevant legislation, is authorized to prohibit such use of a distinctive sign;
- g) registration of the design was carried out in bad faith.

2. In case envisaged by Paragraph 1(d) of this Article, an interested party instead of requesting recognition of design registration invalid may request transfer of rights granted by the design registration/deriving from the design registration. registration. If the interested party is entitled to be indicated as a co-applicant, he may request co-ownership of the design.

3. Invalidation of the design registration may be requested after revocation of the design registration or expiration of the validity term of its registration, except for the case provided for in Paragraph 4 of this Article.

4. A request for invalidation of the design registration on the basis of Paragraph 1(d) of this Article shall be admissible within 3 years from the publication of the design. The above-mentioned limitation period shall not apply to a case where a person who was not an authorized person at the time of registration of the design acted in bad faith at the time of filing the application or obtaining rights on the design.

5. In the case of a multiple application or a unified application, the appeal for invalidation of a design registration may concern one or more designs.

6. Based on Paragraph 1 of this Article, recognition of invalidity of the design registration may be requested by the following persons:

- a) based on Subparagraphs “a”, “b”, “c” or “g” by an interested person;
- b) based on Subparagraph “d” – only by a person who is the authorized person according to Article 8 and 9 of this Law;
- c) based on Subparagraph “e” – only by the copyright owner;

d) based on Subparagraph “f” – only by the holder of the right to the distinctive sign.

7. In case of change in the holder of the design according to Paragraph 1(d) of this Article, all previously issued licenses and other rights on the design shall be deemed revoked from the moment of entering the data on the authorized holder of the design in the Register.

8. If, prior to filing of an appeal for invalidation of the design registration pursuant to Paragraph 1(d) of this Article, the holder or licensee of the design has started using the design or has carried out significant and effective preparatory work to start its using, he/she shall be entitled to request a non-exclusive private license from the new holder of the design within 3 months from the date of entering the data on the new holder of the design in the Register. This license shall be issued for the period necessary to fulfill the obligations existing prior to filing of the mentioned appeal, within the scope of authority with which the previous holder or licensee of the design carried out activities prior to filing of the appeal.

9. Paragraph 8 of this Article shall not apply if the unauthorized holder of the design or licensee acted in bad faith at the time of starting the use of the design or carrying out preparatory work for starting its use.

10. As a result of invalidation of the registration of a design, the rights granted by registration shall be deemed terminated from the date of origin of these rights on the design, unless a different date is indicated in the court decision entered in the legal force.

11. In case of invalidation of a design registration at the time of existence of a ground provided for in Paragraph 1(b), (e) or (f) of this Article, it is possible to maintain the registration of the design in a modified form in accordance with the rule established by Article 20(4<sup>1</sup>) and (4<sup>2</sup>) of this Law.

## **Article 29<sup>1</sup>. Retroactive Effect of a Decision on Invalidation of a Design Registration**

A decision on invalidation of a design registration shall have no retroactive effect:

- a) if a court decision on infringement of exclusive rights on a design entered into legal force before entry into force of the decision on invalidation of the registration of the same design;
- b) with respect a transaction concluded and executed before the entry into legal force of a decision on invalidation of a design registration provided for in Subparagraph “a” of this Article.

### **Article 30. Responsibility for Infringement of Exclusive Rights on a Design**

Producing, sale, use, import or placing on the market of a product into which a design is incorporated, or for which it is used, without the permission of the design holder, or storage of such a product for these purposes, also deliberate disclosure of its essence (except by the designer) prior to the publication of the data on the design by Sakpatenti, or misappropriation of design authorship shall entail responsibility under the rule established according to the legislation of Georgia.

### **Article 30<sup>1</sup>. Protection of Exclusive Rights on a Design (23.12.2017 N1920)**

1. Where exclusive rights on a design are infringed, the holder of exclusive rights on a design is entitled to demand:

- a) prohibition of actions provided for in Article 26(2) of this Law;
- b) removal from public circulation of goods made in violation of exclusive rights on a design or removal of goods in which a design is incorporated or for which is used, imported or stored on the territory of Georgia with the purpose of inclusion in the public circulation;
- c) destruction of goods incorporating the design or used thereof, made in violation of exclusive rights on a design, included in public circulation;



- d) destruction of a picture, label, imprint, packaging, packaging material and advertisement material that contain the design view, is its copy or imitation, including destruction of the material and representations containing the view of the design, published in the internet;
  - e) destruction of the clichés, matrices, other implements, technical equipment and tools intended for the production of the design.
2. The holder of exclusive rights on a design is entitled to demand simultaneous application of several measures provided for in Paragraph 1 of this Article at his/her discretion.
3. In case of infringement of exclusive rights on a design, upon the request of the holder of exclusive rights on the design, the actions provided for by Subparagraph “a” of Paragraph 1 of this Article may apply also with respect to a person who was aware or should have been aware that his/her service is or was used in activities infringing exclusive rights on a design on a commercial scale.
4. On the basis of a request of the infringer of exclusive rights on a design, in special cases, the court is authorized, instead of actions provided for under Subparagraphs “b”-“e” of Paragraph 1 of this Article, to demand from him payment of a lump sum compensation, if the infringer of rights acted unintentionally, or if execution of the relevant measure would cause him/her disproportionate harm and if, along with this, the amount of pecuniary compensation defined by the court appears satisfactory to the holder of the exclusive rights on the design.
5. In addition to the actions provided for Paragraph 1 of this Article, in case of infringement of exclusive rights on a design the holder of exclusive rights on the design shall be entitled to request any one of the following acts:
- a) compensation for damages (including lost profits), if the infringer of the exclusive rights on the design was aware or should have been aware of the infringement of exclusive rights on the design;

- b) confiscation of the profits gained by the infringer of the exclusive rights on the design in violation of exclusive rights on the design in favour of the holder of exclusive rights on the design;
  - c) payment of a lump sum compensation.
6. When determining the amount of damages, the essence of the infringement of exclusive rights on the design, profits gained through infringement of exclusive rights on the design, the economic and moral damage caused to the holder of exclusive rights on the design, as well as the expected income that would have been gained by the holder of exclusive rights on the design as a result of the lawful use of the design shall be taken into consideration.
7. The compensation shall at least the amount which would have been due if the infringer of exclusive rights on the design acquired a permit for the use of the design.
8. When determining the amount of a lump sum compensation, the quantity of the goods made without the permission in of the holder of exclusive rights on the design incorporating the design or used thereof, the intention of the infringer of the exclusive rights on the design, as well as the scale, character and other features of the service offered in violation of exclusive rights on the design and/or any other circumstance which may be taken into account in determining the amount of the compensation, shall be taken into consideration.

### **Article 31. Transfer of Rights on a Design**

1. An agreement on transfer of exclusive rights on a design shall be concluded in writing.
2. An agreement on assignment of exclusive rights on a design as well as amendments there to shall be registered under the established rule in the Register and the data shall be published in the Bulletin.

3. A new holder of the design is not entitled to use the rights deriving from the design registration against a third party before the recording of the relevant amendments in the Register.

### **Article 32. Private License on the Use of a Design**

1. A design holder has a right to issue a private license on the use of the design.
2. A private license is not a license envisaged by the Law of Georgia “On Licenses and Permits”.
3. A private license agreement shall be executed in writing. The license shall define the scope of use of the design.
4. A private license may be exclusive or non-exclusive. If the private license agreement does not define the type of the license, the private license shall be regarded to be non-exclusive.
5. Granting of a non-exclusive private license does not deprive the licensor of the right to issue another license with equivalent terms.
6. Issuance of an exclusive private license deprives the licensor of the right to issue another license with equivalent terms.
7. A private license holder has a right to file an appeal to the court on infringement of the right deriving from the design registration, unless the design holder files an appeal within a reasonable time from the receipt of a notification on infringement of the rights.
8. A private license agreement and its amendments may be recorded in the Register.
9. If a private license agreement envisages restrictions regarding the development, dissemination and/or export of a design only on a definite market, a corresponding indication shall be made in the labeling data of the product. If there is no such indication, the restriction envisaged by the private license agreement shall have no effect for a third party.

### **Article 33. Conflict of Interests**

1. A design application shall not be filed by:

- a) a natural person employed by Sakpatenti currently or 12 months prior to filing an application;
- b) a legal entity in which a person envisaged by Sub-paragraph “a” of this paragraph is a member, partner, stockholder or head.

2. A person directly involved in taking a decision on the appealed design shall not be a member of the Chamber of Appeals in the course of hearing a legal dispute over the design registration.

## **Chapter V**

### **Transitional Provisions**

### **Article 34. Application of the Norms of this Law to the Relations Originated Earlier**

1. This Law shall apply to the relations linked with the development, registration, use and legal protection of the designs:

- a) which originated after the enactment of this Law;
- b) which are in force by the date of the enactment of this Law;

2. An application which by the date of the enactment of this Law is being processed at Sakpatenti shall be considered by the rule established by the Patent Law of Georgia of February 5, 1999. (*The Legislative Herald of Georgia № 5(12) 1999, Art. 21*).

### **Article 35. Measures Related to the Enactment of this Law (26.10.2010.**

*№3742)*

Sakpatenti shall issue the Instruction on Design Registration.

## **Chapter VI**

### **Final Provision**

**Article 36. Enactment of the Law**

This Law shall be enacted after 1 month from the date of its publication.

President of Georgia

*Mikheil Saakashvili*

Tbilisi,

May 4, 2010

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