

# TRADEMARK LAW OF GEORGIA

## CHAPTER I

### GENERAL PROVISIONS

#### **Article 1. PURPOSE OF THE LAW**

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

#### **Article 2. DEFINITION OF TERMS USED IN THE LAW**

The terms used in the Law shall have the following meaning:

- a) National Intellectual Property Center of Georgia “Sakpatenti” (hereinafter - Sakpatenti) - the legal entity of public law defined by the Patent Law of Georgia; *(28.06.2010. № 3159 shall enter into force after 1 month from the publication.)*
- b) Paris Convention - the Paris Convention for the Protection of Industrial Property, signed at Paris on March 20, 1883 (as revised at Stockholm on July 14, 1967, and as amended on September 28, 1979);
- c) Madrid Protocol - the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, signed on June 27, 1989; *(20.12.2005 № 2380 is in force from March 1, 2006)*
- d) International Classification - the International Classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, adopted and signed on June 15, 1957, (as revised at Stockholm on July 14, 1967 and at Geneva May 13, 1977);
- e) Certificate - the document, granted under this Law in the name of the trademark holder, certifying his/her exclusive rights;
- f) Application - the package of documents, necessary for granting of a certificate, drawn up in accordance with the prescribed requirements;
- g) Applicant - a natural person or legal entity applying for a certificate;
- h) Priority - the privilege enjoyed by an application as compared with an application filed later;

- i) Convention priority - the priority established under Article 4 of the Paris Convention;
- j) Exhibition priority – the priority established under Article 11 of the Paris Convention;
- k) Repealed; *(28.06.2010. №3159 shall enter into force after 1 month from the publication);*
- l) Chamber of Appeals - the body functioning at “Sakpatenti”, hearing disputes arising in connection with acquisition of rights in industrial property subject-matters; *(20.12.2005 № 2380 is in force from March 1, 2006)*
- m) Association - any association of producers, established under the legislation of Georgia or its country of origin;
- n) Feature of a trademark not qualifying for protection - a part of a trademark to which the exclusive rights of the right holder do not apply. *(20.12.2005 № 2380 is in force from March 1, 2006)*
- o) Goods bearing a sign in violation of exclusive rights on a trademark - goods that contain (on which are imprinted) a sign identical or similar with a registered trademark, or has the shape identical or similar with a registered three-dimensional trademark, the manufacturing, importation to the territory of Georgia, storage, inclusion in the public circulation or storage/warehousing (temporary storage) or any other use of which causes infringement of exclusive rights of the holder of a registered trademark, regardless of the place of bearing the sign.*(23.12.2017 N1922)*

### **Article 3. TRADEMARK**

1. A trademark is a sign or combination of signs that can be represented graphically and is capable of distinguishing the goods and/or services of one undertaking from the goods and/or services of another undertaking (hereinafter referred to as “goods”).

2. The sign may be: a word or words, also a proper name; letters; figures; sounds; an image; a three-dimensional figure, including the shape or wrapping of goods, as well as other type of external appearance using colours or combination of colours.
3. A trademark is protected by means of its registration at “Sakpatenti” or on the basis of an international agreement.
4. Well-known trademarks are protected in Georgia without registration, under Article 6<sup>bis</sup> of the Paris Convention. The trademark is recognized as well-known by the Chamber of Appeals of “Sakpatenti” or by the court, within its competence, upon the request of an interested person. *(20.12.2005 № 2380 is in force from March 1, 2006)*

#### **Article 4. ABSOLUTE GROUNDS FOR REFUSAL OF TRADEMARK REGISTRATION**

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

1. A sign or combination of signs shall not be registered as a trademark where it:
  - a) does not comply with the requirements of Article 3 (1) of this Law;
  - b) represents a single non-stylized (standard) letter or figure, or a single colour taken separately;
  - c) is not capable of distinguishing the relevant goods;
  - d) is descriptive in respect of the goods for which its registration is requested, consists exclusively of the kind, quality, quantity, feature, value, intended purpose, geographical origin, place or time of sale or other characteristics of the goods or is regarded as such;
  - e) is widely used as a generic term for goods of a particular type;
  - f) represents a widely established trade term or sign, characteristic of goods, for which the registration is sought;
  - g) insults or is contrary to the national dignity, religious sentiment and traditions, and moral standards;

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

i) completely or in any of its constituent elements coincides with the armorial bearings, flag or emblem, full or abbreviated name of a foreign country; the emblem, full or abbreviated name of an international or intergovernmental organization; an official control, warranty and test hallmark, sign (including certification mark of goods), seal, order or medal; the current or historical name, armorial bearings, flag, emblem or banknote of Georgia or its territorial unit or an imitation of any sign provided for under this Subparagraph. Such a sign shall be included in a trademark, as a feature not qualifying for protection, if the permission of the Ministry of Education, Science, Culture and Sport of Georgia or the holder has been obtained. (05.07.2018 N3054)

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

a) is determined exclusively by the features of the goods;

b) is necessary to achieve the technical result.

3. The provisions of Paragraphs 1(c), (d), (e), (f) and (h) of this Article shall not apply if, before taking a decision on the trademark registration, through use in the course of trade the trademark has become a distinctive sign in relation to the goods specified in the application.

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

A trademark shall not be registered if it:

a) is identical to another trademark registered for the same goods, having earlier priority;

b) is identical to the trademark, registered in the name of a third party, having earlier priority, and the goods are so similar as to create a risk of confusion between the trademarks, including confusion based on association;

c) is similar to the trademark, registered in the name of a third party, having earlier priority, and the goods are identical or so similar as to create a risk of confusion between the trademarks, including confusion based on association;

d) is identical or so similar to a trademark, well known in Georgia before filing the application for registration, that there is a risk of confusion with it, including confusion based on association. This rule shall apply even where the list of goods is different;

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

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

g) is identical or similar to a trademark, registered in the name of a third party, having earlier priority, enjoying good reputation in Georgia, and the use of this trademark creates unfair advantages for its applicant or damages the reputation of the protected trademark. This rule shall apply even where the list of goods is different;

h) includes the name, pseudonym, facsimile or portrait of a person, famous in Georgia before filing the application for registration, without the consent of this person or his/her legatees, and if they belong to the history and culture of Georgia - without the consent of the Ministry of Education, Science, Culture and Sport of Georgia;  
(05.07.2018 N3054)

i) includes the name or representation of a historical monument of Georgia without the consent of the Ministry of Education, Science, Culture and Sport of Georgia.  
(05.07.2018 N3054)

## **Article 6. EXCLUSIVE RIGHT**

1. The holder's exclusive right on a trademark, protected by the registration, arises on the date of the registration of the trademark.
2. The holder of the exclusive right may prevent a third party from using in the course of trade without his/her consent a trademark which:
  - a) is identical to the protected trademark of the holder of the exclusive right and the goods are identical too;
  - b) is identical to the protected trademark of the holder of the exclusive right and the goods are so similar, that there is a risk of confusion between these marks, including confusion based on association;
  - c) is similar to the protected trademark of the holder of the exclusive right, and the goods are identical or so similar that there is a risk of confusion of the marks, including confusion based on association;
  - d) is identical or similar to the protected trademark of the holder of the exclusive right, and is protected on account of the good reputation of the trademark in Georgia, so that the use of the mark affords unfair advantages to a third party or damages the good reputation of the trademark or its distinctiveness.
3. In the cases provided for in paragraph (2) of this Article, except other possible prohibitions, it is prohibited:
  - a) to print a trademark on goods or their packaging;
  - b) to offer, put on the market or store for that purpose, import or export the goods bearing the trademark, except where the act is performed with the goods bearing the sign affixed by the holder of the exclusive right in the trademark; *(20.12.2005 № 2380 is in force from March 1, 2006)*
  - c) to offer or render services using the trademark;
  - d) to use the trademark for advertisements or business papers.
4. Without the consent of the trademark holder, it is prohibited for a third party:

- a) to affix a sign identical or similar to the trademark on packaging materials, label, etc.;
- b) to offer, put on the market, sell or prepare for sale, import or export packaging material or packaging bearing a sign identical or similar to the trademark.

#### **Article 7. SCOPE OF EXCLUSIVE RIGHTS**

1. The holder of the exclusive right may not prevent a third party from using in the course of trade as a trademark:

- a) a proper name or address if they coincide with the trademark of the holder of the exclusive right;
  - b) a sign or combination of signs representing the kind, quality, quantity, feature, value, intended purpose, geographical origin, place of sale, time or other characteristics of the goods;
  - c) the protected trademark, if it is necessary for the goods to be used according to their intended purpose, including where the goods bearing the trademark are used as a component or spare part. In this case the third party shall use the protected trademark in accordance with fair practice of entrepreneurial activity.
2. The holder of the exclusive right in the trademark may not prevent a third party from using the protected trademark on goods that have been put on the market directly by the holder of the trademark or with his/her consent. This rule shall not apply where the features of the goods have changed, the quality has become worse or there are other important grounds for this prohibition.

#### **Article 8. PUBLICATION OF TRADEMARK IN REFERENCE LITERATURE**

If the reproduction of a trademark in a dictionary, encyclopedia or other reference literature produces an impression that it represents a generic term with respect to the goods for which it is registered or its registration is sought, the publisher, at the request of the holder of the mark in question, shall indicate in the next edition of the reference literature that the published sign is a registered trademark.

## **CHAPTER II**

### **ACQUISITION AND MAINTENANCE OF AN EXCLUSIVE RIGHT ON A TRADEMARK**

#### **Article 9. APPLICATION FOR A TRADEMARK REGISTRATION**

1. An application for registration shall be filed with “Sakpatenti” by an applicant or his/her representative.
2. The application shall be filled out in the Georgian language in accordance with the established rule.
3. **Repealed** (28.06.2010. №3159 shall enter into force after 1 month from the publication);
4. The application shall refer only to one trademark.
5. The application shall contain:
  - a) a request for trademark registration;
  - b) the full name and legal address of the applicant;
  - c) the representation of the trademark;
  - d) the list of the goods for which the registration is sought. It is permitted to submit the list of goods in a foreign language as an annex, provided that its Georgian translation is also submitted to “Sakpatenti” within one month from the application filing date;
  - e) the name and address of the representative, if the application is filed by a representative;
  - f) the signature of the applicant or the representative on the application.
6. The list of other data and documents necessary for examination, the terms and conditions for its filing shall be defined by the legislation of Georgia.

#### **Article 10. DATE OF FILING THE APPLICATION WITH “SAKPATENTI”**

The day on which an application is submitted to “Sakpatenti” shall be considered the filing date of the application, if the application complies with the requirements of



Paragraphs (2) and (5) of Article (9) of this Law.

### **Article 11. PRIORITY**

1. The priority of a trademark shall be established by the filing date of the application, provided that the prescribed fee for examination as to form of the application is paid no later than within a month from filing the application (*20.12.2005 № 2380 is in force from March 1, 2006*);

2. Trademark priority may be established by the filing date of the first application in a contracting state of the Paris Convention (convention priority), provided that no more than 6 months have elapsed from that date to the filing date of the application with “Sakpatenti”.

3 The priority of a trademark used on an exhibit presented at an official or officially recognized international exhibition held by a contracting state of the Paris Convention, shall be established by the first day of the exhibition (exhibition priority), provided that no more than 6 months have elapsed from the day of its showing at the exhibition to the filing date of the relevant application with “Sakpatenti”. The exhibition and convention priorities shall not be cumulative.

4. An applicant wishing to benefit from the convention or exhibition priority shall notify thereof “Sakpatenti” within one month from the filing date of the application with “Sakpatenti” and within 3 months from the application filing shall submit the documents confirming his/her right for such a claim.

5. The fee payable under the rule governing claiming the convention or exhibition priority shall be paid within one month from the date of filing the application with “Sakpatenti”.

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

### **Article 12. EXAMINATION OF A TRADEMARK APPLICATION**

1. “Sakpatenti” shall conduct examination as to form and substantive examination of the trademark application.
2. “Sakpatenti” is authorized to request from the applicant additional material necessary for examination. The additional material shall be submitted to “Sakpatenti” within 2 months from the date on which the relevant notification is handed to the applicant. If this term is violated, “Sakpatenti” shall take a decision on the refusal of the application processing.
3. An application which contains two or more names of goods, at the request of the applicant, before the trademark registration can be divided into two or more applications by redistribution of the goods of the first application to each application, after payment of the prescribed fee. The divisional applications retain the filing date of the first application.
4. “Sakpatenti” shall offer information on trademark applications only after establishing the priority.
5. The applicant is entitled to: *(20.12.2005 № 2380 is in force from March 1, 2006)*
  - a) request at any stage of the examination to suspend consideration of his/her application subject to payment of the prescribed fee. The total period of suspension shall not exceed 3 months;
  - b) familiarize with the material used during the examination and request its copy;
  - c) complement, amend, correct or specify the application material before the application priority is established. After establishing the priority, such changes shall be made only subject to payment of the prescribed fee, but no later than the registration of the trademark. In addition, in case of amending the trademark only such a minor change is allowed, which does not extend the scope of its protection, whereas in case of amending the list of goods only its restriction or specification is allowed;
  - d) withdraw the application before the trademark registration.

e) renew the application proceedings upon payment of the prescribed fee. The renewal of the application proceedings is allowed if its termination occurred prior to the publication of the application data, according to Article 15 of this Law.

6. The rules of application drafting and filing, examination, appealing against a decision of examination, suspension, renewal and reinstatement of the procedural terms as well as other rules related to the trademark registration are determined by the Instruction “On Procedures Related with Filing a Trademark Application and Registration”, issued by the Chairman of Sakpatenti according to the rule established by the legislation of Georgia. (26.10.2010. N3743)

### **Article 13. EXAMINATION OF AN APPLICATION AS TO FORM**

1. Examination of an application as to form shall be conducted within 2 months after the filing of the application, and if the applicant claims convention priority or exhibition priority - within the term provided for in Article 11(4) of this Law. If a notification requiring additional material was sent to the applicant, examination shall be suspended until the receipt of a response to the notification, but no later than the time limit provided for in Article 12(2) of this Law.

2. Examination as to form serves to ascertain whether the application is drafted in accordance with this Law.

3. If the application satisfies the requirements of Article 9(2) and (5) of this Law, a certificate on establishing the filing date, with the indication of the record number and the list of submitted documents, shall be issued in the name of the applicant. Otherwise, the applicant shall be notified of the substantiated refusal to accept the application.

4. If within one month from the filing date of the application, the fee prescribed for examination as to form is not paid, or if the paid amount is less than that payable for one class, “Sakpatenti” shall take a decision on the refusal of the application processing. If, within this period, an amount is paid which is less than that payable for filing the number of classes covered by the application, but is enough for filing one

class, examination shall be conducted for the classes selected by the applicant, or in case of absence of such a selection, for the first classes for which the paid fee is sufficient.

5. On the basis of the examination as to form, “Sakpatenti” shall take a decision on accepting the application for processing and establishing priority or on the refusal of the application processing, and shall notify the applicant.

#### **Article 14. SUBSTANTIVE EXAMINATION**

1. Substantive examination shall be carried out within 6 months from the completion of the examination of the application as to form.
2. Substantive examination serves to ascertain whether there are grounds for refusal of trademark registration, provided for by Articles 4 and 5 of this Law.
3. On the basis of the substantive examination, the applicant shall be sent a substantiated decision on the trademark registration or on the refusal of registration of the trademark for the entire list of goods or its part. (23.12.2017 N1922)

#### **Article 15. PUBLICATION**

1. Within one month after taking a decision on the registration of a trademark based on substantive examination, “Sakpatenti” shall publish the application data in the Official Bulletin of the Industrial Property (hereinafter - the Bulletin).
2. If the applicant makes use of the right defined in Article 16 (2) of this Law “Sakpatenti” shall publish the application data in the Bulletin within one month after taking a relevant decision by the Chamber of Appeals.
- 2<sup>1</sup>. If a decision on the refusal of the registration of a trademark for the entire list of goods or its part, taken after substantive examination, is replaced by a legally enforced positive decision of the court, “Sakpatenti” shall publish the trademark data in the Bulletin. (20.12.2005 № 2380 is in force from March 1, 2006)

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

4. From the date of publication of the trademark application until its registration the applicant shall be conventionally granted the same rights which would have been granted to him/her by the registration. If the registration is not implemented, these rights shall not be regarded as arisen. (28.06.2010. №3159 shall enter into force after 1 month from the publication)

**Article 15<sup>1</sup>. PROCEDURE OF ACCELERATED REGISTRATION OF A TRADEMARK** (28.06.2010. №3159 shall enter into force after a month from the publication)

1. Unless otherwise specified by this Article, rules prescribed by Chapter II of this Law shall regulate the procedure of accelerated registration of a trademark.

2. At the time of filing the application or within one month from the filing, the applicant may request conducting accelerated examination of the application.

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

4. If an applicant wishes to benefit from the priorities defined in Paragraphs (2) and (3) of Article 11 of this Law or Article 9<sup>quinquies</sup> of the Madrid Protocol, the application requesting 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 days “Sakpatenti” shall check whether there are grounds for refusal of the trademark registration according to Articles 4 and 5 of this Law and in case of taking a positive decision shall register the trademark in the Trademark Register, publish data on the registered trademark in the Bulletin and issue a certificate.

7. Within 3 months from the publication of the data on the trademark registration in the Bulletin any interested person shall be entitled to file an appeal with the Chamber of Appeals requesting cancellation of the registration on the grounds that the requirements of Articles 4 and 5 are violated.

8. If after the registration of a trademark through the accelerated procedure an application having earlier priority is filed with “Sakpatenti” and if there exists the ground for refusal of the trademark registration stipulated in Article 5 of this Law in relation to the trademark registered through the accelerated procedure, “Sakpatenti” shall take a decision on the cancellation of the accelerated registration of the trademark and shall publish it in the Bulletin.

9. The decision on the cancellation of the accelerated registration of the trademark, referred to in Paragraph 8 of this Article may be opposed according to the rule under Article 16 (2) of this Law.

## **Article 16. APPEALING AGAINST EXAMINATION DECISION AT THE CHAMBER OF APPEALS**

1. An applicant can appeal against a decision of examination as to form at the Chamber of Appeals within 3 months from taking the decision.

2. An applicant can appeal against a decision of substantive examination to refuse the registration of the trademark in respect of the entire list of the goods or its part at the Chamber of Appeals within 3 months from taking the decision.
3. Repealed (*20.12.2005 № 2380 is in force from March 1, 2006*)
4. Within 3 months from the date of publication of the application data in the Bulletin, any interested party is entitled to bring an action before the Chamber of Appeals against the decision on trademark registration only on the grounds that the requirements of Article 4 or 5 of this Law is violated. In addition, it is not admissible to appeal against a decision concerning the trademark registration on the basis of an enacted court decision at the Chamber of Appeals on the same grounds. (*20.12.2005 № 2380 is in force from March 1, 2006*)
5. The Chamber of Appeals shall hear the appeal within 3 months from the date of its filing. (*20.12.2005 № 2380 is in force from March 1, 2006*)
6. The decision of the Chamber of Appeals may be appealed in a court.

## **Article 17. TRADEMARK REGISTRATION**

1. If within the period prescribed in Article 16 (4) of this Law an appeal is not filed with the Chamber of Appeals, or if on the basis of the appeal filed in accordance with Article 16 (4) the Chamber of Appeals takes a decision to register a trademark, “Sakpatenti” shall register the trademark in the Trademark Register (hereinafter - the Register) and publish the data on the registered trademark in the Bulletin. (*20.12.2005 № 2380 is in force from March 1, 2006*)
2. The Register shall contain a representation of the trademark, the personal information of the holder, the trademark priority date, the trademark registration date, the list of goods, grouped according to the International Classification, for which the trademark is registered and other information regarding the registration.
3. Any interested person is authorized, after filing a proper request with “Sakpatenti”, to familiarize with the Register data and request the issue of a certified excerpt from the Register.

## **Article 18. TRADEMARK CERTIFICATE**

1. After the registration of the trademark in the Register, “Sakpatenti” shall issue a trademark certificate.
2. The certificate shall confirm the registration of a sign as a trademark, the trademark priority date, the holder’s exclusive right in the trademark in question and its term of validity of the trademark registration.

## **Article 19. RECORDING OF AMENDMENTS IN THE REGISTER**

1. Any amendments to the data, mandatory for the registration under Article 17 (2) of this Law shall be entered in the Register on the basis of a request of the trademark holder or his/her representative. In addition, in case of amending the trademark only such a minor change is allowed, which does not extend the scope of its protection, whereas in case of amending the list of goods only its restriction or specification is allowed. An amendment shall enter into force only after its registration. *(20.12.2005 № 2380 is in force from March 1, 2006)*
2. Amendments entered in the Register shall be published in the following Bulletin.
3. Amendments shall also be entered in the certificate.

## **Article 20. TERM OF VALIDITY OF THE TRADEMARK REGISTRATION**

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

1. The term of validity of a trademark registration shall be 10 years from the date of registration of the trademark at “Sakpatenti”.
2. The term of validity of a trademark registration may be extended indefinitely by consecutive periods of 10 years. “Sakpatenti” shall extend the term of validity of a trademark registration upon a request filed by the holder with “Sakpatenti”, after payment of the prescribed fee. The request shall be filed with “Sakpatenti” and the fee shall be paid during the final year of the validity of the certificate.
3. A notice on the extension of the term of validity of a trademark registration shall be entered in the Register and the certificate, and shall be published in the Bulletin.



4. If the request for the extension of the term of validity of the trademark registration was not filed with “Sakpatenti” or the prescribed fee was not paid during the term determined in Paragraph 2 of this Article, the holder of the trademark is entitled to pay the above-mentioned fee within 6 months from the date of expiration of the term of validity of the trademark registration. If this deadline is failed to be met, the trademark registration is canceled from the date of expiration of the term of validity of the trademark registration without the right of its reinstatement, and the relevant notification shall be published in the Bulletin.

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

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

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

**Article 22. FEES** *(28.06.2010. №3159 shall enter into force within 1month after the publication)*

For examination as to form of a trademark application, substantive examination, accelerated examination, claiming priority, opposition to the examination decision, trademark registration, registration of amendments, publication, issuing a certificate, issuing an excerpt from the Register, suspension, renewal and extension of the procedural time limits related to the registration, as well as all other acts in relation to legal protection of a trademark, fees determined by the rule prescribed by the legislation of Georgia shall be paid. The amount of fees shall be determined by the resolution of the Government of Georgia.

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

## **CHAPTER III**

### **USE OF A TRADEMARK AND TRANSFER OF RIGHTS DERIVING FROM TRADEMARK REGISTRATION**

**Article 24. USE OF A TRADEMARK** *(20.12.2005 № 2380 is in force from March 1, 2006)*

1. The acts, carried out on the territory of Georgia, such as affixation of a trademark on the goods for which it has been registered, on the packaging of these goods, on exhibits displayed at exhibitions and fairs, on signboards, official forms, labels, advertisements, printed matter, as well as other use of the trademark by the holder, a licensee or a third party on the basis of the right granted by the holder, shall be considered the use of a trademark. The use of a slightly different sign instead of the registered trademark shall likewise be considered the use of the trademark.
2. The use of trademarks, incorporating as a feature not qualifying for protection an appellation of origin or a geographical indication protected in Georgia, is allowed with the consent of the respective competent authority, which is regulated by the legislation of Georgia and international agreements to which Georgia is a party.

### **Article 25. TRANSFER OF RIGHTS DERIVING FROM A TRADEMARK REGISTRATION**

1. The rights deriving from a trademark registration may be transferred to another natural person or legal entity according to the rule established by the legislation of Georgia.
2. The trademark may be transferred to another party with or without the enterprise.
3. The transfer of rights deriving from a trademark registration shall apply to the entire list of goods or its part.
4. The transfer of the enterprise shall imply the trademark transfer as well, unless otherwise provided in the transfer contract.

5. A contracts on a trademark transfer shall be executed in writing. The failure to use the written form shall cause the annulment of the contract.

6. If on the basis of the documents submitted in connection with the transfer of a trademark, “Sakpatenti» regards that the trademark transfer may mislead consumers as to the features, quality, geographical origin, producer or other characteristics of the goods for which it is registered, “Sakpatenti” shall not enter in the Register a record on the transfer until it receives the consent of the transferee to remove from the list the misleading goods. *(20.12.2005 № 2380 is in force from March 1, 2006)*

6<sup>1</sup>. The transfer of rights on a trademark, incorporating as a feature not qualifying for protection an appellation of origin or a geographical indication, protected in Georgia, is allowed only in the case if the transferee has the right to use this appellation of origin or geographical indication. *(20.12.2005 № 2380 is in force from March 1, 2006)*

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

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

## **Article 26. LICENCE AGREEMENTS**

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

2. The license shall be exclusive or simple.

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

4. An exclusive license does not allow the licensor to enter into another license agreement and use the trademark, unless otherwise provided in the agreement. The

rights deriving from the exclusive license shall remain in force throughout the term of validity of the trademark registration, unless otherwise provided in the agreement.

5. The licensee is prohibited from assigning the rights deriving from the license agreement or from issuing a sublicense, unless it directly derives from the agreement.

*(20.12.2005 № 238 0 is in force from March 1, 2006)*

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

7. The fact of conclusion of a license agreement for a trademark shall be registered at “Sakpatenti” and the relevant information shall be published in the Bulletin upon payment of the prescribed fee.

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

9. The licensee is entitled, with a view to compensation for the damages caused to him/her, to engage in the court proceedings for infringement of the trademark rights.

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

11. A license contract on a trademark which involves an appellation of origin or a geographical indication protected in Georgia as a feature not qualifying for protection may be concluded only in the case, when the licensee has the right to use this appellation

of origin or geographical indications of goods. *(20.12.2005 № 2380 is in force from March 1, 2006)*

## **CHAPTER IV**

### **TERMINATION OF EXCLUSIVE RIGHTS ON A TRADEMARK**

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

1. “Sakpatenti” shall cancel a trademark registration:

- a) on the basis of the request of the trademark holder;
- b) in the case of the death of the trademark holder (being a natural person), if he/she has no successor, or in the case of the liquidation of the trademark holder (being a legal entity), if a legatee is not appointed.
- c) on the grounds of Article 15(8) of this Law. *(28.06.2010. №3159 shall enter into 1 force after 1 month from the publication)*

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

- a) the trademark was not used continuously during 5 years in relation to the goods for which it was registered in Georgia. If the use of the mark started or was resumed in the interval from the expiry of the above-mentioned five-year period to the filing of a request to cancel the trademark registration, no one may seek cancellation of the registration;
- b) the trademark has become a generic term for the goods for which it has been registered;
- c) the use of the trademark by the trademark holder or with his/her consent is misleading consumers as to the kind, feature, quality, value, geographical origin or other characteristics of the goods.

3. Paragraph (2) (a) of this Law shall not apply, if the non-use of the trademark is caused by the circumstances arising independently of the will of the trademark holder. As such circumstances shall be considered e.g. import restrictions imposed on the goods protected by the trademark or other requirements established by the Government.

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

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

**Article 28. ANNULMENT OF A TRADEMARK REGISTRATION** (20.12.2005 № 2380 is in force from March 1, 2006)

1. A trademark registration may be annulled by the court at the request of a third party, if:

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

b) the trademark has been registered with a dishonest intent;

c) the trademark has been registered in a member state of the Paris Convention by a representative or agent of the trademark holder in his/her own name, without the consent of the trademark holder;

d) the trademark contains the brand name for which the rights are originated before the filing of the application for the trademark registration, as a result of which a likelihood of confusion arises;

e) such a registration violates the copyright of a third party, originated before the priority date established for the trademark.

2. If there are grounds for a trademark registration to be annulled only for a part of the registered list of goods, the registration shall be considered null only in respect of that part.

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

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

1. If a trademark registration is cancelled under Article 27 of this Law, the rights accorded by the registration shall be considered terminated as of the date of the entering of the notification on the registration cancellation, unless the court decision refers to other date.
2. If a trademark registration is annulled under Article 28 of this Law, the rights accorded by the registration shall be considered terminated as of the date of the arising these rights in the trademark, unless the court decision refers to other date.
3. The issues of compensation for damages shall be governed by the legislation of Georgia.

**CHAPTER V  
COLLECTIVE MARK**

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

1. A collective mark is a sign or combination of signs that can be protected as a trademark under Article 3 of this Law and distinguishes the goods of the members of an association holding the collective mark from goods of other parties according to the geographical origin, common qualitative features or other features.
2. The holder or applicant for a collective mark may be only an association or a legal entity of public law.
3. It is prohibited to transfer or license a collective mark.
4. The rules provided for by this Law shall apply fully to collective marks, unless otherwise provided for in this Chapter.

**Article 31. USE OF AN INDICATION OF GEOGRAPHICAL ORIGIN AS A COLLECTIVE MARK**

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

2. An indication of geographical origin shall not be used as a collective mark for goods which do not originate in the geographical locality, district, region or country concerned, if such an indication produces a false impression as to the origin of the goods.

3. If an indication of geographical origin points to the special features and quality of goods such an indication shall be used as a collective mark only for goods having relevant features and that quality.

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

## **Article 32. REGULATIONS GOVERNING COLLECTIVE MARKS**

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

2. The regulations governing the collective marks shall include:

- a) the name of the association;
- b) the names and legal addresses of the members of the association;
- c) the aim of the association;
- d) the conditions for the use of the collective mark and overseeing its use;
- e) the rights and obligations of the members of the association regarding infringement of the rights in the collective mark;
- f) the list of the goods and common characteristics or common indications for which the collective mark is intended.



3. If a collective mark contains a geographical name, the regulations shall provide that any person whose goods are originated within the above-mentioned geographical region and who meets the conditions for use of the mark specified by the regulations, has the right to become a member of the association and to use the mark.

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

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

During the substantive examination of a collective mark, along with the requirements stipulated in Article 14 (2), it is determined whether the application meets the requirements of Article 30 (1), (2) and Article 32 of this Law. At the same time, the examination will not take a decision on the refusal of the registration of the collective mark if the applicant amends the regulations governing the collective mark so that the grounds for refusal of the registration no longer exist.

**Article 34. RESTRICTION OF PROTECTION OF A COLLECTIVE MARK**

The registration of a geographical name as a collective mark does not entitle its holder to prevent a third party from using this name in the course of trade, provided that such a use does not violate the norms of fair competition and the third party has lawful grounds for the use of the name.

**Article 35. APPEAL**

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

**Article 36. AMENDMENTS TO THE REGULATIONS GOVERNING COLLECTIVE MARKS**

1. The holder of a collective mark shall notify “Sakpatenti” about making any amendment to the regulations governing the collective mark.

2. In case of making amendments to the regulations governing the collective mark, the requirements of Articles 31 and 32 of this Law shall be taken into account.

### **Article 37. CANCELLATION OF THE REGISTRATION OF A COLLECTIVE MARK**

The registration of a collective mark may be canceled:

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

### **Article 38. ANNULMENT OF THE REGISTRATION OF A COLLECTIVE MARK DUE TO THE ABSOLUTE GROUNDS FOR REFUSAL OF THE REGISTRATION**

In addition to the grounds provided for in Article 28 of this Law, a collective mark registration shall be annulled if it has been registered in breach of the requirements of Article 33 of this Law. If the grounds for the annulment concern the regulations governing the collective mark, the registration shall not be annulled if the holder of the collective mark, within 2 months from the date when he/she became aware of the necessity of making the amendment, amends the regulations so that the grounds for its annulment will no longer exist.

## **CHAPTER VI**

### **PROTECTION OF TRADEMARKS IN ACCORDANCE WITH THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS**

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

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

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

#### **Article 40. RECORD OF THE INTERNATIONAL REGISTRATION**

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

#### **Article 41. EXAMINATION OF A TRADEMARK EXTENDED TO GEORGIA ON THE BASIS OF THE INTERNATIONAL REGISTRATION UNDER THE PROTOCOL RELATING TO THE MADRID AGREEMENT**

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

1. In relation to a trademark for which protection is claimed in Georgia on the basis of its international registration under the Protocol Relating to the Madrid Agreement (hereinafter - international trademark) only substantive examination shall be conducted.
2. Instead of the term “registration” used in Chapters I-V of this Law, the term “protection” shall be used with respect to international trademarks.

## **Article 42. PUBLICATION AND APPEAL**

1. The data of the international registration of a trademark shall be published in the WIPO Gazette of International Marks of the International Bureau of the World Intellectual Property Organization (WIPO).
2. When the decision is taken to grant protection to the international trademark in Georgia, the date and number of the international registration shall be published in the Bulletin within one month from taking the decision. *(20.12.2005 № 2380 is in force from March 1, 2006)*
3. The opposition period provided for in Article 16(4) of this Law shall be calculated from the day of publication in the Bulletin of the date and number of the international registration of the trademark.

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

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

1. In accordance with Article 9<sup>quinquies</sup> of the Madrid Protocol, at the time of filing of a national application on the basis of a cancelled international registration, the applicant shall also file the document certified by the International Bureau of the World Intellectual Property Organization (WIPO), confirming that the international registration was extended to Georgia before it was cancelled.
2. If by the date of filing with “Sakpatenti” of the national application specified in paragraph 1 of this Article, “Sakpatenti” has taken the decision to grant protection to the relevant international trademark, substantive examination shall not be conducted on the national application.
3. If by the date of cancelling of the international registration the international trademark was granted protection in Georgia, “Sakpatenti” shall conduct only examination as to form of the national application specified in paragraph 1 of this

Article, after which shall register the trademark in the Register and publish the data on the registered trademark in the Bulletin.

## **CHAPTER VII**

### **ENFORCEMENT OF PROTECTION OF EXCLUSIVE RIGHTS ON A TRADEMARK**

#### **Article 45. PROTECTION OF EXCLUSIVE RIGHTS ON A TRADEMARK** (23.12.2017 N1922)

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

a) termination of actions provided for in Articles 6(2)-(4) of this Law;

b) removal from public circulation of goods bearing a sign in violation of the exclusive rights on a trademark or removal of goods imported or stored on the territory of Georgia with the purpose of inclusion in the public circulation;

c) destruction of goods bearing a sign in violation of the exclusive rights on a trademark, if separation of the trademark from the goods is impossible, or if the trademark is imprinted on the goods;

d) destruction of images, labels, imprints, packaging, packaging materials and advertisement materials that contain the trademark, its copy or imitation, including destruction of the material and representations containing the trademark, published in the internet;

e) destruction of the clichés, matrices, other implements, technical equipment and tools intended for the production of the trademark.

2. The holder of exclusive rights on a trademark 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 trademark, 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 trademark on a commercial scale.

4. On the basis of a request of the infringer of exclusive rights on a trademark, 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 trademark.

5. In addition to the actions provided for Paragraph 1 of this Article, in case of infringement of exclusive rights on a trademark the holder of exclusive rights on the trademark 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 trademark was aware or should have been aware of the infringement of exclusive rights on the trademark;
- b) confiscation of the profits gained by the infringer of the exclusive rights on the trademark in violation of exclusive rights on the trademark in favour of the holder of exclusive rights on the trademark;
- c) payment of a lump sum compensation.

6. When determining the amount of damages, the essence of the infringement of exclusive rights on the trademark, profits gained through infringement of exclusive rights on the trademark, the economic and moral damage caused to the holder of exclusive rights on the trademark, as well as the expected income that would have

been gained by the holder of exclusive rights on the trademark as a result of the lawful use of the trademark 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 trademark acquired a permit for the use of the trademark.

8. When determining the amount of a lump sum compensation, the quantity of the goods bearing a sign in violation of exclusive rights on the trademark, the identity or degree of similarity of the used trademark with the protected trademark, the reputation of the trademark in Georgia, the infringer's intention, as well as the scale, character and other features of the service offered in violation of exclusive rights on the trademark and/or any other circumstance which may be taken into account in determining the amount of the compensation, shall be taken into consideration.

## **CHAPTER VIII**

### **TRANSITIONAL PROVISIONS**

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

1. An application for registration of a trademark, filed prior to the entry into force of this Law, shall be considered in accordance with Resolution N304 of the Cabinet of Ministers of the Republic of Georgia of March 16, 1992 "On Approving and Enacting the Statute "On Trademarks".

2. A certificate granted for a trademark registered prior to the entry into force of this Law shall remain in force thereafter.

## **CHAPTER IX**

### **FINAL PROVISIONS**

#### **Article 47. INVALIDATED NORMATIVE ACTS**

Upon the entry into force of this Law the following shall be considered as invalidated:

- a) Resolution N304 of the Cabinet of Ministers of the Republic of Georgia of March 16, 1992 “On Approving and Enacting the Statute “On Trademarks”.
- b) Resolution N 483 of the Cabinet of Ministers of the Republic of Georgia of June 25, 1993 “On Additional Measures for the Regulation of the Use of Trademark in Georgia”.

**Article 48. ENTRY INTO FORCE OF THE LAW**

This Law shall enter into force after 3 months from its publication.

President of Georgia

Eduard Shevardnadze

Tbilisi

February 5, 1999

N 1795 IIS