

**Order N05 of the Chairman of Legal Entity of Public Law National Intellectual
Property Center of Georgia Sakpatenti
August 19, 2014, Tbilisi**

**On Approving of the Instruction “On the Procedures Related with Filing a
Trademark Application and Registration”**

In accordance with Article 8¹ of the “Patent Law of Georgia” and Article 12(6) of the
“Trademark Law” of Georgia:

Article 1

1. The attached Instruction “On Procedures Related with Filing a Trademark Application and Registration” shall be approved (Annex №1).
2. The application form shall be approved (Annex №2).
3. The effect of the Instruction shall apply to the trademarks registered and applications filed for registration before publication of the Instruction.

Article 2

The Order shall enter into force after its publication.

Nikoloz Gogilidze
Chairman

LEPL National Intellectual Property Center of Georgia

**Instruction “On Procedures Related with Filing a Trademark Application and
Registration”**

Chapter I

General Provisions

Article 1. Field of Regulation of the Instruction

The present Instruction is developed in accordance with the “Trademark Law” of Georgia and defines the rules of application drafting and filing, examination, appealing against a decision of examination, suspension, extention and reinstatement of the procedural terms on trademarks, service marks and collective marks as well as other rules related to the trademark registration.

Article 2. Definition of Terms

Terms used in the Instruction shall have the following meaning:

- a) Law - the “Trademark Law” of Georgia;
- b) National Intellectual Property Center of Georgia Sakpatenti - (hereinafter referred to as Sakpatenti) - Legal Entity of Public Law defined by Article 2(a) of the “Patent Law of Georgia”;
- c) World Intellectual Property Organization (hereinafter referred to as WIPO)
- d) Paris Convention - the Paris Convention for the Protection of Industrial Property of March 20, 1883 (as revised in Stockholm on July 14, 1967, and as amended on September 28, 1979);
- e) Madrid Protocol - the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, signed on June 27, 1989;
- f) International Classification - the International Classification established by the Nice Agreement Concerning the International Classification of Goods and Services, adopted

and signed on June 15, 1957, (as revised in Stockholm on July 14, 1967 and in Geneva on May 13, 1977);

g) List of goods – the list of goods and/or services, submitted in accordance with the International Classification for the purpose of trademark registration,;

h) Goods – goods and/or services;

i) Certificate – the document, issued in accordance with this Law in the name of the trademark holder, certifying his/her exclusive rights;

j) Application – a set of documents, necessary for issuing a certificate, drawn up in accordance with the requirements prescribed by this instruction;

k) Applicant – a natural person or legal entity applying for a certificate;

l) Priority – a preference that is given to an application as compared with one that has been submitted later.

m) Convention priority – the priority established under Article 4 of the Paris Convention;

n) Exhibition priority – the priority established under Article 11 of the Paris Convention;

o) Patent attorney – a natural person registered in the Register of Patent Attorneys of Sakpatenti, who is engaged in activity in the intellectual property field according to the legislation.

p) Chamber of Appeals – the body defined by Article 9 of the “Patent Law of Georgia”;

q) Feature of a trademark not qualifying for protection – a part of a trademark to which the exclusive rights of the holder do not apply;

r) Code – Three-digit number code approved by the standard of the WIPO St. 60, for identification of data;

s) Country code – Two-digit code approved by the WIPO Standard St.3, corresponding to the names of countries, intergovernmental and other organizations;

t) International Bureau - International Bureau of the WIPO;

u) International application – an application filed for international registration under the Article 3 of the Madrid Protocol;

- v) Bulletin – Official Bulletin of Industrial Property;
- w) Register – Register of Trademarks;
- x) Gazette of the International Bureau – the gazette of the International Bureau of the WIPO (WIPO Gazette);
- y) WIPO Digital Access System “DAS” (hereinafter referred to as “DAS”) – the electronic system of WIPO, allowing participating IP offices securely exchange priority documents of an application under the Paris Convention through the electronic system;
- z) Madrid eFiling – electronic interface of the WIPO Madrid System for international applications.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Chapter II

Application Form and Rule of its Filing

Article 3. Filing an Application

1. An application shall be filed with Sakpatenti on paper or using Sakpatenti electronic filing system of intellectual property subject-matters (hereinafter referred to as the electronic system) - <https://online.sakpatenti.gov.ge/>.
2. In case of filing an application on paper, the request shall be submitted on the special form of request, approved by the Chairman of Sakpatenti (hereinafter – form) and according to the rule prescribed by this Article, and in case of filing using the electronic system, application materials shall be filed using Sakpatenti electronic filing system of intellectual property subject-matters.
3. In case of filing an application with Sakpatenti on paper, documents of all types within the proceedings shall be sent to the applicant on paper.

4. In case of filing an application with Sakpatenti using the electronic system, documents of all types within the proceedings shall be sent to the applicant through Sakpatenti electronic system and shall be deemed as delivered as soon as it is reflected in the system. From this moment the computation of periods stipulated by the legislation for all relevant subsequent actions shall start.

5. After electronic filing of an application with Sakpatenti, if the applicant requests continuation of proceedings on paper, from the day of such a request the reduction on fees related with electronic proceedings provided for by the legislation shall no longer apply to the application, if such a reduction exists.

6. After filing of an application with Sakpatenti on paper, the applicant may request continuation of proceedings electronically. In this case the reduction on fees related with electronic proceedings provided for by the legislation shall not apply to the application, if such a reduction exists.

7. To inform additionally, a short text message may be sent to the applicant concerning the actions related with the application.

8. The application shall refer to one trademark.

9. In case of requesting conducting accelerated examination of the application for registration of a trademark, the applicant shall tick in the form the appropriate box by “X”

10. Boxes of the form shall be filled out in the following way:

a) Box 1 of the form contains:

a.a) a request for registration of the submitted symbol as a trademark, full name and address (legal address) of the applicant (code 731). If the applicant is a natural person – his/her surname, name, identification number, full postal address, indicating the index, the name of the country a citizen of which he/she is or in which he/she has a permanent residence or an operating enterprise. In case of a legal entity, its legal form, full name,

country (where the legal entity was registered), full postal address, indicating the index and the identification number;

a.b) a request to establish priority for which the applicant shall tick the appropriate box by “X” for the requested priority;

a.c) country code and filing date (Code 220), which shall be filled out by Sakpatenti.

b) Box 2 of the form shall be filled out in case of requesting earlier priority. Namely, in case of requesting the convention priority the first application number (Code 310), the date of filing first application (Code 320) and the country or office receiving the first application (Code 330) shall be filled out. In case of requesting the exhibition priority the date of display at the exhibition (Code 230) shall be indicated. The international application number and the priority requested by the international registration shall be indicated if the applicant requests transformation of a cancelled international registration into a national application.

c) Box 3 of the form shall contain the name and surname, identification number and registration number of the representative/patent attorney, if the application is filed by a patent attorney (Code 740), and in case of a legal entity, the full name and identification code.

d) Box 4 of the form shall contain the address of correspondence (Code 750), the name and surname of the addressee, the full name in case of a legal entity-, identification code, as well as the actual address, telephone number and e-mail. The addressee may be a representative/patent attorney or an applicant. In the latter case, if the address coincides with the address indicated in Box 1, it shall be repeated in Box 4.

e) Box 5 of the form shall contain the representation of the sign submitted for registration (Code 540). The representation of the sign shall be clear and shall not exceed the size of 6cm x 6cm. If the sign submitted for registration is three-dimensional, the view of its representation shall be selected so as to create the best possible idea of it. If the sign

submitted for registration is a sound symbol, the given box shall contain the graphical expression of this sign (E.g. musical notation).

f) Box 6 of the form (Code 571) shall contain the verbal description of a trademark, in case of a verbal sign represented in a foreign language – its transliteration, transcription and, if possible, its translation, in case of figurative and three-dimensional signs – the list and description of their constituent figurative elements.

g) In Box 7 of the form the appropriate box corresponding to the type of the sign submitted for registration shall be ticked.

h) In Box 8 of the form (Code 591), the colour or combination of colours representing the subject of protection shall be indicated.

i) In Box 9 of the form, the list of goods and/or services shall be indicated, for which registration of the submitted sign is requested, with the indication of the relevant class (Code 511).

J) In Box 10 of the form, the appropriate box corresponding to the document accompanying the application upon filing shall be ticked, and number of copies of each document and pages in each copy shall be indicated.

11. The form shall be signed by the applicant, authorized person or representative/patent attorney and shall be dated by the date of signature. At the end of the form the name and surname of the signatory shall be indicated clearly, otherwise the application shall not be considered as filed with Sakpatenti.

12. The rules provided for in Paragraphs 8-10 of this Article shall also apply in case of filing an application using the electronic system.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 4. Documents Related to the Application

1. An application shall contain a clear representation of the sign submitted for registration in printed or electronic form. If the sign is a sound symbol, audio recording and the electronic version of its graphical representation (musical notation) shall be submitted or uploaded in the electronic system.

2. If the list of goods does not fit in the Box 9 assigned for it (Code 511), it may be submitted upon filing the application, in the form of an annex. If the list of goods is submitted in a foreign language, within a month after the application is filed, the list of goods shall be submitted in the Georgian language as well.

3. The power of attorney on the authority of a representative/patent attorney shall be submitted to Sakpatenti upon filing the application or within one month from the filing date. It is permissible to extend this term for one month, if within one month from the filing of the application with Sakpatenti, the representative/patent attorney submits a request for extension of the term and pays the fee prescribed for the extension of the term.

4. Upon filing the application with Sakpatenti or within one month from filing, the following shall be paid:

a) the fee prescribed for examination as to form. If the fee for examination as to form is not paid within one month from filing the application, Sakpatenti shall take a decision on refusal to process the application.

b) the fee prescribed for requesting the convention and/or exhibition priority, if such a priority is requested. Otherwise, the priority shall be established according to the date of filing of the application with Sakpatenti.

5) In the case provided for by Paragraph 4 of Article 11 of the Law, within the prescribed term applicant shall submit the following:

a) In case of requesting the convention priority - a copy of the first application certified by the office of the first application;

- b) In case of requesting the exhibition priority - a certificate issued by the administration or organization committee of an official or officially recognized exhibition, with the indication of the date of the display of the exhibit at the exhibition.
- 6) In case of submission of a certified copy of the first application using the “DAS” system, the applicant shall submit to Sakpatenti the relevant “DAS” code and a duly certified Georgian translation of the document made available in “DAS”.
- 7) It is permissible to extend the period of requesting the convention and/or exhibition priority by one month, if within the three-month period prescribed by the Law the applicant submits a request with Sakpatenti for extension of the term and pays the fee prescribed for the extension of the term. Otherwise the applicant loses the right to request the convention and/or exhibition priority and the priority shall be established according to the date of filing of the application with Sakpatenti.
- 8) If the application is filed for a collective mark, the regulations governing the collective mark shall be submitted upon filing the application or within one month from the date of filing.
- 9) If the application is filed on the basis of a cancelled international registration, in accordance with Article 9^{quinquies} of the Madrid Protocol, at the time of filing or within one month from filing of a national application, the applicant shall file the document certified by the WIPO, confirming that the international registration was extended to Georgia before it was cancelled. If the registration of an international mark was not extended to Georgia, the priority shall be established according to the date of filing of the application with Sakpatenti.
10. The documents provided for by Paragraphs 3, 5-9 of this Article and other additional documents may be submitted in a foreign language. A duly certified Georgian translation of the document submitted in a foreign language shall be filed with Sakpatenti within one month from submitting the document. It is permissible to extend the term for submission of the translation by one month, if from the date of filing the application with Sakpatenti,

the applicant submits a request with Sakpatenti for extension of the term and pays the fee prescribed for the extension of the term. Otherwise, the submitted document shall not be taken into consideration.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 5. Establishing the Date of Filing an Application

1. The date of filing of an application with Sakpatenti shall be considered the date of filing the application with Sakpatenti, if the application is filed in the Georgian language electronically or on paper, contains the name and surname/title and address of the applicant, the representation of the trademark, the list of goods, the name and surname/title and address of the representative/patent attorney, if the application is filed by a representative and is signed according to the requirements of Paragraph 11 of Article 3 of this Instruction.

2. If the application satisfies the requirements of Paragraph 1 of this Article, the application shall be assigned a reference number and the office certificate is issued concerning the filing of the application, indicating the reference number, date of filing and the data and documents applied with the application.

3. If the filed application does not meet the requirements of Paragraph 1 of this Article, the application shall not be considered as filed, and the application materials shall be returned to the person submitting it.

Order № 2 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of August 8, 2018 – website, 10.08.2018.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 6. Appointment of a Representative

1. Upon filing an application with Sakpatenti or after filing the application, the applicant is entitled to appoint a representative/patent attorney on the basis of a written power of attorney.

2. The power of attorney issued in the name of a representative/patent attorney shall include:

a) the name and surname/title, the legal address of the principal; in case of a natural person, the identification number of the principal and attorney (except patent attorneys); in case of a legal entity, the identification number;

b) the scope of authority of the representative/patent attorney;

c) the date and place of drawing up the power of attorney;

d) the signature of principal;

e) the term of validity of the power of attorney. If the term is not indicated, the power of attorney is valid until the termination of the authority of the principal.

3. The power of attorney shall be drawn up in accordance with the legislation of the country where it is drawn up.

4. A foreign applicant having no permanent residence in Georgia or is registered without indicating an address, within 15 days from the request of Sakpatenti shall appoint a capable person as a representative/patent attorney registered at a definite address of Georgia, to whom all documents intended for the applicant shall be sent. A foreign applicant shall issue a power of attorney to a representative/patent attorney himself/herself or through a duly authorized trustee. If the applicant fails to comply with the requirement of this paragraph, Sakpatenti shall take a decision on termination of the application proceedings. In addition, not sending to the party the decision of the application proceeding termination shall not become a basis for declaring the decision invalidated.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 7. Correspondence with Sakpatenti

1. The correspondence with Sakpatenti shall be carried out by the applicant or his/her representative/patent attorney, for each application separately.
2. All the materials submitted after filing the application on paper shall include the reference number. The materials submitted without indicating the reference number and signature shall not be accepted for processing.
3. The materials submitted after filing the application shall be submitted to Sakpatenti within the terms defined by the Law and this Instruction.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 8. Supplementing, Modifying, Amending and Specifying the Application Materials

1. In cases envisaged by Subparagraph “c” of Paragraph 5 of Article 12, application materials may be supplemented, modified, amended and specified on the basis of the applicant’s request. If the modification is requested after establishing the priority, the prescribed fee shall be paid. Amendments after establishing the priority are allowed only before the trademark is registered. In addition, at the time of modification related with a trademark, only an insignificant modification of the trademark shall be allowed, which does not extend the scope of its protection, and in case of modification of the list of goods, only its limitation or clarification shall be allowed. If the fee is not paid or the paid amount is not in compliance with the prescribed fee, the request shall not be satisfied, about which the applicant shall be notified in writing.

2. If the change is related to the representation of a trademark, which does not modify it substantially, the representation of the modified trademark shall be submitted to Sakpatenti.

3. In case of change of the name and surname (title) of the applicant, a document confirming this amendment shall be submitted to Sakpatenti. If the document is submitted by a representative/patent attorney, the request shall be accompanied by a document certifying representation issued by the acting applicant according to the rule. The document shall be submitted to Sakpatenti at the time of submitting a request for the change or within one month from its submitting. It shall be permissible to extend this term by one month, if within a one-month period the representative/patent attorney submits to Sakpatenti a request for extension of the term and pays the prescribed fee. If the power of attorney is not submitted within the prescribed term, the amendment provided for this Paragraph shall not be reflected in the application.

4. The applicant may transfer the right to the application to another person/successor for the entire list of goods or for its part. In this case, the following shall be submitted to Sakpatenti: a request, an agreement confirming the transfer of the right on the application, signed by the applicant and his/her successor, and the power of attorney issued by the successor, if the proceedings are conducted through a representative/patent attorney.

5. In the case provided for by Paragraph 4 of this Article, the power of attorney shall be submitted to Sakpatenti upon submission of the document confirming the transfer of right on the application to Sakpatenti or within one month from its submission. It is permissible to extend this term by one month if the representative submits a request for extension of the term and pays the fee prescribed for the extension of the term. If the power of attorney is not submitted within the prescribed term, the amendment provided for this Paragraph shall not be reflected in the application.

6. From the date of reflection of the amendments referred to in Paragraph 4 of this Article in the application, Sakpatenti shall carry out correspondence with the successor or his/her representative/patent attorney.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 9. Division of the Application

1. An application, which contains two or more appellations of goods, upon the applicant's request, before the registration of a trademark, may be divided into two or more applications, with the distribution of the goods contained in the first application on each application. The divisional applications shall retain the date of filing of the first application.

2. It shall be allowed to divide an application on the basis of a written request of the applicant. The request shall contain:

- a) the name and surname/title and address of the applicant;
- b) the reference number of the application;
- c) a request for division of the application;
- d) the list of the goods to be divided with the indication of the relevant classes.

3. If the request for division of the application fails to satisfy the requirements of Paragraphs 1 and 2 of this Article, the applicant shall be given a one-month term to remedy the shortcoming. Otherwise, the request shall not be considered and the applicant shall be notified accordingly.

4. Registration procedure on a separated application shall continue according to the rule prescribed by the legislation and the fee for all relevant actions shall be paid.

5. The applicant is entitled to request issuing a certificate for a separated application,

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 10. Introduction with the Application Materials

The applicant is entitled to introduce with the materials used during application proceedings and to request their copy.

Article 11. Suspension of the Application Proceedings

1. The applicant is entitled to request suspension of proceedings of his/her application for one month, at any stage of examination after paying the fee set for each separate month. The total term of suspension shall not exceed 3 months.
2. The request for suspension of the application proceedings shall be submitted to Sakpatenti. Within one month from submitting the request the prescribed fee shall be paid. In case of non-payment, the request on the suspension shall not be considered.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 11¹. Requesting a Certified Copy of an Application

1. After completion of the examination as to form, the applicant is entitled to request a certified copy of the application.
2. The request for a certified copy of the application shall be submitted to Sakpatenti and within one month from submitting the prescribed fee shall be paid.
3. Upon the request of the applicant, Sakpatenti may issue a certified copy using the “DAS”.
4. Sakpatenti shall issue a certified copy of the application within 10 working days from payment of the fee defined by Paragraph 2 of this Article. If the fee is not paid within the prescribed term, the request shall not be considered.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 12. Termination of the Application Proceedings

1. Sakpatenti shall terminate application proceedings upon the request of the applicant or in cases envisaged by the legislation.
2. The application proceedings shall be terminated from the date of submission of the request on termination of application proceedings with Sakpatenti by the applicant or within 10 days from arising the grounds envisaged by the legislation and a relevant written notification shall be sent to the applicant.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 12¹. Reinstatement of the Application Proceedings

1. If the application proceedings were terminated by the applicant's request, or the decision is taken by Sakpatenti on the refusal to process the application or due to non-compliance with the procedural terms prescribed by this Instruction on termination of application proceedings, within one month after termination of the application proceedings, the applicant is entitled to request reinstatement of the application proceedings after payment of the prescribed fee. For an application reinstated according to this rule, the priority date shall be retained.
2. Along with the fee for reinstatement of the application proceedings, the applicant shall pay the fee prescribed for the relevant stage of the examination. Otherwise, the request for reinstatement of the proceedings shall not be considered.

3. Sakpatenti shall reinstate the application proceedings within 10 days from the submission of the relevant request.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Chapter III

Examination of the Application

Article 13. Examination of as to form

1. Examination as to form shall be conducted within 2 months from the date of filing the application, which may be extended by the period prescribed by Paragraph 5 of Article 4 and Paragraph 4 of Article 14 of this Instruction. At the stage of examination as to form, the examiner checks whether the application fully satisfies the requirements set forth in Articles 3 and 4 of this Instruction.

2. Sakpatenti may request from the applicant to submit additional materials for examination. The additional materials shall be submitted to Sakpatenti within 2 months from the date of receipt of the relevant notice to the applicant. If this deadline is not met, Sakpatenti shall take a decision on refusal to process the application. In case of accelerated registration of the application, the reply to the notice referred to in this Article shall be submitted within 15 days from the date of receipt of the notice.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 14. Results of Examination as to Form and Related Correspondence

1. If the application and accompanying materials satisfy the requirements of the Law and of this Instruction, examination shall take a decision on receiving the application for consideration and establishing priority, and shall inform the applicant about that accordingly.

2. If the application is filed by the representative/patent attorney and the requirements of Paragraph 3 of Article 4 of this Instruction are not met, the application shall not be processed and the applicant shall be notified of this.

3. If the application refers to the registration of a collective trademark and within one month from filing the application the regulations governing the collective mark are not submitted, the application proceedings shall be terminated and the applicant shall be notified about this.

4. If the application materials need further clarification, a written notification shall be sent to the applicant in which all the requirements and necessary amendments shall be listed performance of which is required to continue examination of the given application. The applicant shall submit a written reply to Sakpatenti within two months from the date of receipt of the notification. The applicant has the right to extend the term for submitting a reply by one month, if within the above-mentioned two-month period he/she submits a request for extension of the term and pays the prescribed fee.

5. the notification shall be sent if:

a) an application concerns to more than one trademark. The applicant is given an opportunity to submit an independent application for each sign. If the prescribed deadline for submitting a reply to the notification is not met, the application proceedings shall be terminated and a relevant notification shall be sent to applicant;

b) an earlier priority is requested, in particular, the convention, exhibition priority or priority based on a cancelled international registration, and the document confirming the

right to claim such a priority is not submitted according to the prescribed rule and/or its data differ from the data of the applications submitted to Sakpatenti; if the applicant does not submit a reply to the notification within the prescribed term, the applicant loses the right to claim the earlier priority and the priority shall be established according to the date of filing the application with Sakpatenti;

c) the representation of the sign applied for registration does not comply with the requirements of Paragraph 1 of Article 4 of this Instruction and/or the colour or combination of colours indicated in the application do not correspond with the colours of this representation. If the applicant does not submit a reply to the notification within the prescribed term, the examiner shall define the colour or combination of colours on the basis of the sign submitted for registration;

d) the applied list of goods is not classified or requires specification. If the applicant does not submit a reply concerning the specification of the list of goods within the prescribed term, Sakpatenti shall specify the list of goods;

e) the amount of fee prescribed for the examination as to form does not correspond to the amount set for the number of classes of the list of goods indicated in the application or specified through correspondence. The applicant is proposed to add the missing amount to the paid fee or to indicate the classes for which the paid amount is sufficient. If the applicant does not submit a reply to the notification referred in this paragraph within the prescribed term, examination shall be conducted according to the list, for as many of the first classes for which the paid fee is sufficient;

f) the materials received in response to the sent notification require clarification;

g) other materials of the application are deficient and require clarification.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 15. Substantive Examination

1. Within 3 months after the receipt of the notification relating to the acceptance of the application for consideration, the applicant shall pay the fee prescribed for substantive examination and publication. Otherwise the application proceedings shall be terminated, about which a written notification shall be sent to the applicant.

2. Substantive examination may be suspended:

a) before the entry into force of the decision on the registration of the conflicting sign with earlier priority;

b) upon the applicant's request, for the period indicated in Article 11 (1) of this Instruction;

c) for the term specified in Paragraph 5 of Article 16;

d) for the remaining period before expiration of 6 months after the cancellation of the registration of conflicting mark, if the conflicting mark registration is cancelled by the moment of taking a decision of substantive examination;

e) before expiration of the three-month period established for appealing against the decision of examination as to form on the application of conflicting sign according to Paragraph 1 of Article 19 of this Instruction, or in case of appeal of the decision of examination as to form by the applicant, before taking a decision by the Chamber of Appeals.

3. At the stage of substantive examination the examiner shall check whether there are grounds of refusal for registration of applied sign defined by Articles 4 and/or 5 of the Law.

4. In order to establish whether there are the grounds of refusal under Subparagraph "i" of Paragraph 1 of Article 4 and Subparagraphs "a"- "c", "e"- "g" of Article 5 of the Law, the submitted symbol shall be compared to the signs protected by Article 6^{ter} of the Paris Convention, geographical indications or appellations of origin protected/registered in

Georgia, designs protected/registered in Georgia, trademarks protected/registered in Georgia and trademarks applied to Sakpatenti for the registration.

5. The main criteria during the comparison for determining the similarity of the signs can be acoustic (phonetics, musical sound), visual (graphics, colour combination), conceptual (semantics, essence) similarity. The overall impression has the crucial significance when comparing the signs.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 16. Results of Substantive Examination and Related Correspondence

1. If there are no grounds of refusal for registration under Articles 4 and/or 5 of the Law, on the basis of the decision of examination Sakpatenti shall take a decision on registration of the submitted sign as a trademark with respect to the entire list of goods indicated in the application, about which the applicant shall be notified.

2. If there are any grounds of refusal for registration under Articles 4 and/or 5 of the Law with respect to the entire list of goods indicated in the application, on the basis of the decision of examination Sakpatenti shall take a decision on refusal of registration of the submitted sign as a trademark with respect to the entire list of goods indicated in the application, about which the applicant shall be notified.

3. If there are grounds of refusal for registration under Articles 4 and/or 5 of the Law with respect to a part of the list of goods indicated in the application, on the basis of the decision of examination Sakpatenti shall take a decision on registration of the submitted sign with respect to the remaining part of the list of goods, about which the applicant shall be notified.

4. If in case of presence of grounds of refusal determined by Subparagraphs “a”-“d”, “f” and “g” of Article 5 of the Law, Sakpatenti considers that the applicant or holder of the

opposing trademark and/or design is one and the same person or a legally related persons, the applicant shall be sent a written notification about this. If a reply is not submitted within two months from the receipt of the notification, Sakpatenti shall take a relevant decision.

5. If there are grounds for requesting the consent provided for in Subparagraph “i” of Paragraph 1 of Article 4 and Subparagraphs “h” and “i” of Article 5 of the Law, or the application materials require specification, a written notification shall be sent to the applicant. Within 2 months from the date of receipt of the notification, the applicant is obliged to submit a reply to Sakpatenti. The applicant has the right to extend the term for submitting a reply for one month, if within the above-mentioned two months he/she submits to Sakpatenti a written request for extension of the term and pays the fee prescribed for extension of the term. In case of accelerated procedure of registration of an application, the reply to the notification indicated in this Article shall be submitted within 15 days from the date of receipt of the notification. If within the above-mentioned term consent is not submitted, Sakpatenti shall take a decision on refusal of registration in accordance with Paragraph 2 of this Article.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 17. Examination of a National Application Filed on the Basis of a Cancelled International Registration

1. If by the date of filing an application with Sakpatenti on the basis of a cancelled international registration the term set out in Paragraph 2 of Article 5 of the Madrid Protocol is expired and no decision is taken on the refusal of protection, the trademark shall be registered in accordance with this Instruction without substantive examination and publication.

2. If the application referred to in Paragraph 1 of this Article is filed before the expiration of the period indicated in Paragraph 2 of Article 5 of the Madrid Protocol, its substantive examination and registration shall be carried out in accordance with this Instruction.

Article 18. Substantive Examination of an International Application

1. Substantive examination of an international application shall be conducted in accordance with Paragraphs 1, 2 and 3 of Article 16 of this Instruction.

2. The decision of substantive examination of the international application shall be taken within the term prescribed in Paragraph 2 of Article 5 of the Madrid Protocol from the date of notification of the International Bureau.

3. On a trademark for which granting of protection is requested on the basis of its international registration, according to the Madrid Protocol only substantive examination shall be conducted.

4. If there are grounds for requesting the consent provided for in Subparagraph “i” of Paragraph 1 of Article 4 and Subparagraphs “e”, “h” or “i” of Article 5 of the Law or the application materials require specification, a notification shall be sent to the applicant. The applicant shall submit a written reply to Sakpatenti within 2 months from the date of receipt of the notification. It shall be permissible to extend this term by one month, if the applicant submits to Sakpatenti a written request for extension of the term within the above-mentioned two-month period and pays the fee prescribed for extension of the term. In case of failure to meet the deadline for submitting a reply to the notification indicated in this Paragraph, the decision on the refusal of registration of the trademark in Georgia shall be sent to the International Bureau in the form determined by the International Bureau.

5. If there are any grounds for refusal of registration provided for by Article 4 and/or Article 5 of the Law, examination shall take the decision on refusal of registration of the submitted sign in Georgia with respect to the entire list of goods indicated in the

application and/or its part, and the relevant written notification shall be sent to the International Bureau in the form determined by the International Bureau.

6. If there are no grounds for refusal of registration under Article 4 and/or 5 of the Law, on the basis of the examination decision, Sakpatenti shall take a decision on the protection of the trademark in Georgia, which shall be sent to the International Bureau. The opposition period shall be computed from the day of publication of the international registration date and number of the trademark in the Bulletin.

7. If within the term specified in Paragraph 2 of this Article a decision on refusal of protection is not taken, the trademark is considered to be protected in Georgia.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 19. Appeal against a Decision of Examination as to Form and Substantive Examination

1. The applicant may appeal against a decision concerning refusal of processing the application, taken after examination as to form, at the Chamber of Appeals within 3 months from the date of official introduction with the decision.

2. The applicant may appeal against a decision concerning registration of a trademark or refusal of registration of a trademark with respect to the entire list of goods or its part, taken after substantive examination, at the Chamber of Appeals within 3 months from the date of official with the decision.

3. Any interested person has the right to appeal against a decision of Sakpatenti at the Chamber of Appeals on the grounds established by the Law, within 3 months from the date of publication of the application related data in the Bulletin.

4. The applicant may appeal against a decision concerning refusal of granting protection to an international trademark with respect to the entire list of goods or its part, taken on

the basis of examination, at the Chamber of Appeals, within 3 months from the publication of the decision in the Official Bulletin of the International Bureau (WIPO Gazette).

5. A prescribed fee shall be paid for hearing an appeal.

6. The decisions referred to in Paragraphs 1, 2-4 of this Article may be appealed according to the administrative rule at the court within one month.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 20. Procedure of Accelerated Registration of Trademark

1. For accelerated registration of a trademark the procedure for accelerated registration of a trademark prescribed by Article 15¹ of the Law shall apply.

2. Subparagraphs “a” and “d” of Paragraph 2 of Article 15 of the Instruction shall apply for the procedure of accelerated registration of a trademark.

3. In case of trademark proceedings by accelerated procedure, upon taking a decision on refusal of registration, within one month from submitting a written request, the publication and registration fee shall be returned to the applicant.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Chapter IV

Publication

Article 21. Publication of Application Data

1. In the case envisaged by Article 15 of the Law, the following shall be published in the Bulletin:

- a) reference number;
 - b) application filing date;
 - c) first application number;
 - d) date of filing of the first application;
 - e) code of the country/office receiving the first application;
 - f) name and surname/title of the applicant and legal address;
 - g) sign submitted for registration;
 - h) indicated colour or combination of colours;
 - i) list of goods grouped according to the international classification, with respect to which registration is requested.
2. The data of the international trademark registration shall be published in the Bulletin of the International Bureau (WIPO Gazette).
3. In case of taking a decision concerning protection in Georgia of the sign submitted by the international application, within one month after taking this decision, the date of the international registration, registration number and date of expiration of the registration validity term shall be published in the Bulletin additionally.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 22. Publication of Data of the Trademark Register

1. If no amendments were made in the application data published in accordance with Article 21 of this Instruction before the registration of the trademark, within one month after the registration date, the registration number, registration date, date of expiration of the registration validity term, the application filing date and the reference number shall be published in the Bulletin.

2. If the application data published in accordance with Article 21 of this Instruction underwent changes before the registration of the trademark, within one month after the registration date, the registration number, registration date, the date of expiration of the registration validity term, the application filing date, the reference number and the amended application data shall be published in the Bulletin.
3. Amendments made in the Register in accordance with Articles 24 and 25 of this Instruction shall be published in the next Bulletin.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 23. Trademark Registration

1. If the Chamber of Appeals takes a decision on registration of a trademark, on the appeal filed under Paragraph 4 of Article 16 of the Law or if no such appeal is filed within the term indicated in the above-mentioned Paragraph or, if the requirements referred to in Paragraph 1 of Article 17 of this Instruction are fulfilled, the applicant shall be sent a written notification for the payment of the prescribed fee for issuing a certificate and for registration for 10 years.
2. The applicant shall pay the fee referred to in Paragraph 1 of this Article within 3 months from the date of official introduction with the mentioned written notification.
3. If the applicant fails to pay the fee prescribed for issuing a certificate and registration for 10 years within the term referred to in Paragraph 2 of this Article, the application shall be cancelled and a written notification shall be sent to the applicant.
4. If the applicant pays the fee prescribed for issuing a certificate and registration for 10 years according to the requirements of this Instruction, Sakpatenti shall register the trademark in the Register and within one month from the date of payment of the above-mentioned fee shall issue a certificate.

4¹. The form of the certificate shall be approved by the order of the Chairman of Sakpatenti.

4². The certificate shall be reflected in the electronic system. In case of the application proceedings on paper, the certificate shall be handed over to the applicant on paper, and in case of electronic proceedings, the certificate shall be issued on paper upon the request of the holder, within 5 days from submitting the request.

5. Along with the information referred to in Paragraph 2 of Article 17 of the Law, the following data shall be entered in the Register:

- a) registration number;
- b) registration date;
- c) the date of expiration of the registration validity term;
- d) reference number;
- e) application filing date;
- f) first application number;
- g) the date of filing of the first application;
- h) code of the country/office receiving the first application;
- i) name and surname/title of the trademark holder and legal address;
- j) trademark representation;
- k) indicated colour or combination of colours;
- l) list of goods grouped according to the international classification with respect to which the trademark is registered;
- m) name and surname/title of the representative/patent attorney and legal address;
- n) list of parts of the trademark not qualifying for protection.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 23¹. Public Notification

1. In case if upon the first sending of the notification is failed to be delivered to the addressee, it shall be sent to the addressee at least once again to the same or another address known to Sakpatenti.
2. If the location of the applicant is unknown or it is impossible to be delivered the notification to him/her otherwise, Sakpatenti is entitled to disseminate the notification publicly. The public notification shall be disseminated by means of publishing on Sakpatenti official website or using other means of information.
3. In the case referred to in Paragraph 2 of this Article, the notification shall be regarded as delivered to the applicant on the 7th day of publication of the notification on the website.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 24. Actions in the Register

1. Each amendment of the data necessary for registration, provided for by Subparagraphs “i”, “j”, “l” and “m” of Paragraph 5 of Article 23 of the Instruction, shall be entered in the Register on the basis of a request of the trademark holder or his/her representative/patent attorney.
2. If the trademark holder submits a request to Sakpatenti on the amendment of the data provided for by Subparagraphs “i”, “j” and “l” of Paragraph 5 of Article 23, these amendments shall be entered in the Register after payment of the fee prescribed for entering amendments. The fee shall be paid within one month from submitting the request to Sakpatenti, otherwise Sakpatenti shall take a decision on refusal to process the request. Amendments related with Subparagraphs “j” and “l” of Paragraph 5 of Article 23 shall be permissible only when a minor change is made to the trademark or the limitation of the list of goods is requested.

3. The amendments entered in the Register shall be published in the next Bulletin and the amendments shall be reflected in the certificate.
4. In case of transfer of rights on a trademark, with respect to the entire list of goods or its part, on the basis of submitted agreement on transfer of rights, the relevant amendment shall be made in the Register after payment of the prescribed fee. The fee shall be paid within one month from filing the request with Sakpatenti, otherwise Sakpatenti shall take a decision on refusal to process the request.
5. If the agreement on transfer of rights is submitted to Sakpatenti by a representative/patent attorney, along with the agreement, a power of attorney issued by the holder or successor shall be submitted as well. Otherwise, the agreement on transfer of rights shall not be considered.
6. If on the basis of submitted documents on transfer of rights on a trademark Sakpatenti considers that the transfer of rights might mislead consumers as to the features, quality or geographical origin, manufacturer or other characteristics of the goods, for which it is registered, a written notification shall be sent to the successor on removal of the misleading goods from the list of goods. Sakpatenti shall not enter in the Register the information concerning the transfer until it receives the successor's consent on removal of the misleading goods from the list. .
7. If the trademark holder has pledged the trademark and/or issued a license for its use, the pledge and/or license agreement shall be registered and the relevant data shall be entered in the Register after the payment of the fee prescribed for the registration of the pledge and/or license agreement. The fee shall be paid within one month from submitting a request to Sakpatenti, otherwise, Sakpatenti shall take a decision on refusal to process the application. If the pledge and/or license agreement is submitted to Sakpatenti by a representative/patent attorney, along with the agreement, a power of attorney issued by one of the parties shall be submitted too. Otherwise, the request shall not be considered.

8. In case of applying to Sakpatenti with a request of recording of a seizure on a trademark, a document issued by the relevant authority or the court shall be submitted.

9. If the trademark holder submits to Sakpatenti a request on cancellation of the trademark registration or the court takes a decision on the cancellation, annulment or reinstatement of the trademark registration, Sakpatenti shall enter relevant amendments in the Register.

10. In case of the amendment entered in the Register, transfer of rights, as well as the registration of the license or pledge agreement, the annex of the certificate shall be issued. The annex shall be printed on the form approved by the Chairman of Sakpatenti, the annex of the certificate shall be reflected in the electronic system and, in case of application proceedings on paper, it shall be handed over to the holder on paper form, and in case of electronic proceedings, it shall be issued on paper form only upon the request of the holder, within 5 days from submitting the request.

Order № 2 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of August 8, 2018 – website, 10.08.2018.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 24¹. Issuance of a Duplicate

1. If the trademark holder or his/her representative/patent attorney submits a request to Sakpatenti and pays the prescribed fee, a trademark certificate duplicate may be issued.

2. If the request is submitted to Sakpatenti by a representative/patent attorney, along with the request, a power of attorney issued by the holder shall be submitted.

3. The fee prescribed for requesting a trademark certificate duplicate shall be paid within one month from submitting the request, otherwise, the request shall not be considered.

4. A duplicate shall be issued by Sakpatenti within one month if the registration of the trademark is valid.

5. A trademark certificate duplicate shall be issued in the form specified in Paragraph 4¹ of Article 23 of this Instruction, according to the data available in the Register at the time of issuance of this duplicate and shall be certified by the stamp “duplicate” in the upper right corner. The duplicate shall be reflected in the electronic system and, in case of application proceedings on paper shall be handed over to the holder on paper form, and in case of electronic proceedings, it shall be issued to on paper form only upon the request of the holder, within 5 days from submitting the request.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 24². Extract from the Register

1. The trademark holder or any person, upon submitting a request to Sakpatenti, is entitled to request an extract from the Register.

2. A fee prescribed by the Law shall be paid for obtaining an extract from the Register. The fee shall be paid within one month after submission of a request to Sakpatenti, otherwise, the request shall not be considered.

3. The extract shall be issued with the signature of an authorized person within 10 working days from payment of the fee and shall be reflected in the database in electronic form. It shall be issued on paper form too upon the request of the applicant.

4. Extract from the Register shall contain the following data:

- a) trademark;
- b) registration number;
- c) trademark status;
- d) data of the trademark holder(s);

- e) registration validity starting date;
- d) date of expiry of the trademark registration validity;
- e) number and date of publication of the application;
- f) number and date of publication of the registration;
- g) reference number;
- h) application filing date;
- i) list of goods;
- j) priority data;
- k) data of the representative/patent attorney (if any);
- l) information on amendments entered in the Register, transfer of rights, seizure, granting of a license or pledge and other actions.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 25. Extension of Validity Term of Registration

1. The term of validity of the 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.

2. If the fee prescribed for extension of validity term of the trademark registration is not paid within the term specified in Paragraph 1 of this Article, a written notification shall be sent to the holder of the trademark with a request to pay the fee within 6 months from the expiration date of the term of validity of the registration. This notification is only informative in nature and failure of its delivery shall not affect the decision on cancellation of the trademark registration.

2¹. The fee prescribed under Paragraphs 1 and 2 of this Article shall be paid within one month from submitting to Sakpatenti a request on extension of validity term by the trademark holder, otherwise Sakpatenti shall take a decision on refusal to process the request.

3. If the fee for extension of the validity term of the registration is not paid within the term indicated in Paragraph 2 of this Article, the trademark registration shall be cancelled and the trademark holder shall be sent a written notification concerning the cancellation of the registration.

Order № 2 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of August 8, 2018 – website, 10.08.2018.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 26. Request for International Registration of a Trademark

1. For the purpose of international registration of a trademark, under Article 3 of the Madrid Protocol, the applicant shall file an application with the International Bureau through Sakpatenti. The application shall be filed with Sakpatenti on paper or using WIPO Madrid eFiling.

2. In case of filing an application on paper, the applicant shall apply to Sakpatenti with a relevant request and apply a duly filled out international application form, (MM2) of WIPO. If the application is filed by a representative/patent attorney, the application shall be accompanied by a document certifying the authority of representation issued by the applicant.

3. An international application shall be filled out in the English language and the fee prescribed by WIPO shall be paid to the International Bureau.

4. The application shall be accompanied by an English translation of the list of goods grouped according to the International Nice Classification.
5. If the international registration was based on the application filed with Sakpatenti or registered trademark, the date and number of the international registration shall be entered in the application data or the Register.
6. Within 10 days from the receipt of an international application, Sakpatenti shall check the compliance of the application with the requirements of the Madrid Protocol and the amount of the paid fee.
7. If the filled out application fails to comply with the requirements of this Article, a notification on remedying the identified shortcoming to within one month shall be sent to the applicant. If the shortcoming is remedied, the date of remedying the shortcoming shall be deemed as the filing date of the application. If the requirements are not fulfilled within the specified term, the request shall not be considered.
8. If an international application complies with the specified requirements, Sakpatenti shall submit the international application to the International Bureau within one month.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 27. Registration of a Collective Mark

For registration of a collective mark, the rules prescribed for trademark registration apply, unless otherwise provided by the Law.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 28. Cancellation of a Trademark Registration

1. In the case envisaged under Article 27(1)(a) of the Law, Sakpatenti shall cancel the trademark registration upon the request of the trademark holder or his/her representative/patent attorney on the basis of a written request.
2. In the case envisaged under Article 27(1)(b) of the Law, on the basis of the request of an interested party, Sakpatenti shall cancel the trademark registration if the document, issued by a competent authority, concerning the absence of successor(s) or, in case of a legal entity, concerning the absence of an assignee, is submitted.
3. In the cases determined under Paragraphs 1 and 2 of this Article, Sakpatenti shall take a decision on a trademark cancellation within one month from submitting the relevant request.
4. If the documentation referred to in Paragraph 2 of this Article is not submitted, Sakpatenti shall take a decision on the refusal to consider the request.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.

Article 29. Annulment of a Trademark Registration

In case of annulment of a trademark registration by the court with respect to the entire list of goods or its part, relevant amendments shall be entered in the Register and information shall be published in the Bulletin.

Order № 5 of the Chairman of Legal Entity of Public Law - National Intellectual Property Center of Georgia Sakpatenti of September 13, 2021 – website, 14.09.2021.