

LAW OF THE REPUBLIC OF THE TAJIKISTAN

“ON TRADE AND SERVICE MARKS”

CHAPTER 1

TRADE MARKS AND SERVICE MARKS, THEIR LEGAL PROTECTION

Article 1. Trade mark and service mark

Trade mark and service mark (hereinafter referred to as «trade mark») is a duly registered sign capable of distinguishing the goods or services produced or commercialized by an individual or a corporate body from the similar goods or services (hereinafter referred to as «goods») of other individuals or corporate bodies.

Article 2. Legal protection of a trade mark

1. Legal protection of a trade mark in the Republic of Tajikistan shall be effected by registration of the trade mark in accordance with the registration procedure established by this Law or laid down in the international treaties of which Tajikistan is a member.
2. The right in a trade mark shall be protected by the State.
3. A trade mark may be registered in the name of a legal person or in the name of a natural person engaged in entrepreneurship.

Article 3. Certificate of registration

1. A certificate of registration shall be issued for a registered trade mark.
2. The certificate of registration shall contain a reproduction of the trade mark and shall be evidence of the registration of the trade mark, of its priority and of the exclusive right of the trade mark proprietor to use the trade mark with respect to goods specified in the certificate.

Article 4. Exclusive rights in a trade mark

1. A trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to use the trade mark at his own discretion and to prevent others from using it. Nobody shall be entitled to use the trade mark protected in the Republic of Tajikistan without proprietor's consent.
2. Any unsanctioned action referred to in Article 24 (1) of this Law shall constitute an infringement of proprietor's rights. This provision shall apply equally to importation of goods designated by a trade mark that enjoys protection in the Republic of Tajikistan, offering them for sale, and otherwise introducing said goods into the national market.

Article 5. Kinds of trade marks

1. Verbal, pictorial, three-dimensional and other signs or their combinations can be registered as a trade mark.
2. A trade mark can be registered in any colour or combination of colours.

Article 6. Absolute grounds for refusal

1. Not registrable are trade marks which consist exclusively of signs or indications:
 - That are devoid of any distinctive characteristics or are of descriptive character;
 - That have become customary denominations of goods they seek to identify;
 - That reproduce armorial bearings, flags and other State emblems; official names of states; emblems, denominations or abbreviations of denominations of international intergovernmental organisations; official signs and hallmarks indicating control and warranty; seals and stamps; decorations; religious and other distinguishing signs. These signs or indications may be included as unprotected elements in the trade mark, provided the consent of the appropriate competent authority to such use or that of the trade mark proprietor has been obtained;
 - That constitute generally accepted symbols or generic terms;
 - That designate the kind, quality, quantity, characteristic features, intended purpose, value, place of origin, or the time of production or distribution of goods.
2. Not registrable as trade marks or their elements are signs or indications:
 - Which contain false or misleading information about the manufacturer or his products;
 - Which are contrary to public interests, principles of humanity and morality.

Article 7. Other grounds for refusal

1. Not registrable as trade marks are identical or similar signs or indications which are likely to be confused:
 - With a trade mark with an earlier date of registration, or an earlier date of application for registration, applied in the Republic of Tajikistan for similar goods in the name of another person;
 - With trade marks of other persons who enjoy protection without registration by virtue of international treaties of which Tajikistan is a member;
 - With trade names (or parts thereof) owned by other persons who are entitled to use these names on the basis of earlier filed applications for registration of trade marks that cover similar goods;
 - With appellations of origin protected in the Republic of Tajikistan, unless said signs or indications constitute an unprotected element of a trade mark to be registered in the name of a person entitled to use this appellation.
2. Not registrable as trade marks are signs or indications that reproduce:
 - Industrial designs the rights to which in the Republic of Tajikistan reside in other persons;
 - Titles of the works of science, literature and art well-known in the Republic of Tajikistan or quotations therefrom; works of art or fragments thereof, unless the consent of the copyright owner to their registration, or that of the appropriate competent authority, has been obtained;
 - Surnames, given names, pseudonyms or their derivatives, portrays and facsimiles of

renowned people, unless the consent of these people, their successors or that of the appropriate competent authority has been obtained.

Article 8. State service of the Republic of Tajikistan for protection of inventions and registration of trade and service marks

State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks shall accept for examination applications for registration of trade marks, examine them, issue certificates of registration with effect throughout Tajikistan, keep a State Register of the Republic of Tajikistan on trade and service marks, monitor ex officio the observation of the trade mark legislation, generalize experience gained from the practical use of the legislation, interpret the provisions of this Law, offer professional help and services with regard to these issues, seek to collect information on trade marks, and perform activities relating to the international registration of trade marks.

CHAPTER 2

REGISTRATION OF TRADE MARKS

Article 9. Filing of applications

1. An application for a trade mark (hereinafter referred to as «application») shall be filed in the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks by a corporate body or an individual engaged in manufacturing or commerce.

The application may be filed through a patent attorney registered with the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks.

2. Foreign legal persons who are domiciled abroad, citizens of foreign countries and stateless persons domiciled outside the Republic of Tajikistan (or their patent agents) shall file for, maintain and renew the registration of a trade mark, and perform all other related activities through patent agents representing them in the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks.

3. A separate application shall be filed for each trade mark.

4. The application shall contain:

- A request for registration of the submitted sign as a trade mark identifying the applicant and specifying applicant's domicile or place of business;
- The applied sign and description thereof;
- A list of goods and services in respect of which the registration is requested, classified in accordance with the International Classification of Goods and Services for the Purpose of the Registration of Marks;
- The application shall be filed in the official language or in Russian, or in any other language.

5. Enclosed shall be:

- Either a document confirming the payment of the prescribed fee or documentary

proof of applicant's rights to exemption from fee, or a document providing grounds for reduction of fees;

- A document authorizing the patent attorney to act in behalf of the applicant if the application is filed through a patent attorney;
- Regulations governing use shall be submitted in conformity with Article 24 of this Law if the applied mark is a collective mark.

Documents that accompany or form part of the application shall be submitted in the official language and in the Russian language, or in any other language. If the documents are submitted in the official language or in any language other than Russian, a Russian translation of the documents shall be enclosed. The translation shall be filed by the applicant within two months following receipt of the application by the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks.

6. The application requirements shall be established by the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks.

Article 10. Priority

1. A right of priority with respect to a trade mark may be claimed from the date on which the trade mark application was filed with the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks, provided that the application meets the requirements laid down in Article 9 (4) of this Law.

2. A right of priority with respect to a trade mark may be claimed from the date the trade mark application was first filed in a foreign country party to the Paris Convention for the Protection of Industrial Property (convention priority), provided that the application was filed with the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks within 6 months from said date.

If due to circumstances beyond applicant's control, the application for convention priority could not have been filed within mentioned period of time, the latter shall be prolonged at the applicant's request, but for no longer than two months.

3. If the applicant for a trade mark has displayed goods under the mark applied for, at an officially recognized international exhibition on the territory of one of the States parties to the Paris Convention for the Protection of Industrial Property (exhibition priority), he may claim a right of priority from the date of the first display of the goods, provided the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks received his application within 3 months from said date.

4. An applicant desiring to take advantage of the right to convention or exhibition priority has to state so when applying for trade mark registration or within two months following receipt of his application by the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks. The applicant shall prove the lawfulness of his claim by enclosing the necessary documents or by submitting them within 3 months following the receipt of his application by the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of

Trade and Service Marks.

5. A right of priority with respect to a trade mark may be claimed from the date of the international registration of the trade mark in accordance with the international treaties of which Tajikistan is a member.

Article 11. Examination of applications

1. Examination of applications shall be conducted by the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks; it shall include preliminary examination and examination of the applied sign that will be conducted in accordance with this Law and in compliance with the rules established by the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks on the basis of this Law.

The applicant shall be entitled to participate - on his own initiative or at the invitation of the State examiner, personally or through an agent - at the discussion of issues that may arise in the course of the preliminary examination or examination of the applied sign.

2. The applicant shall be entitled to supplement, specify or amend the application materials during two months after the filing date.

If the additional materials substantially change the applied trade mark, or if the newly added goods are not similar to the goods identified in the original application, an examination of these materials shall be refused; they may be applied for in form of a separate application.

3. During the examination period, the applicant may be asked to supplement, specify or amend the application.

Additional materials shall be submitted at examiner's request within two months following receipt of said request. Upon demand, this period can be prolonged, provided the application for prolongation was filed prior to the expiration of the two-month period. If the applicant failed to meet this deadline or neglected to respond to the examiner's request, the application shall be deemed to have been abandoned, of which the applicant shall be notified.

4. The applicant shall be entitled to withdraw his application at any examination stage.

Article 12. Preliminary examination

1. Preliminary examination of an application shall be conducted within one month following the date of filing of the application with the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks.

2. In the course of the preliminary examination, the application shall be examined as to its content; the accompanying documents shall be examined for their completeness and compliance with the established requirements. Depending on the outcome of the preliminary examination, the applicant shall be notified of either acceptance or refusal of the application.

3. If the application has been admitted, the applicant shall be notified about the determined priority, unless he asked for convention or exhibition priority but failed to file the necessary documentary proof of the lawfulness of his claim together with the application.

4. If the applicant disagrees with the outcome of the preliminary examination, he shall

be entitled to file for reconsideration. The application for reconsideration shall be filed with the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks within two months following receipt of the notification about refusal. Examiner's decision with respect to the applicant's request for reconsideration shall be rendered within one month following acceptance of the application for reconsideration.

Article 13. Examination of the applied sign

1. Preliminary examination is followed by the examination of the trade mark presented for registration.

In the course of the examination, priority of the trade mark shall be determined if it was not determined during the preliminary examination; the applied sign shall be examined for compliance with the requirements laid down in Articles 6 and 7 of this Law.

2. The examination shall result in the examiner's decision about registrability of the trade mark. The applicant shall be either found entitled to registration or the registration shall be refused.

The applicant shall be entitled to familiarize himself with the materials used in the process of examination.

Copies of the opposed materials can be requested within one month following receipt of the decision on application.

3. The decision about the registrability of a trade mark shall be reconsidered in accordance with Article 10 of this Law if an application with an earlier priority date has been discovered.

4. If the applicant disagrees with the examiner's decision, he may file for re-examination with the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks within two months following receipt of the decision.

Re-examination shall be conducted within two months following acceptance of the applicant's request for re-examination.

Article 14. Appeal from the decision of the examiner and renewal of the missed deadlines

1. If the applicant disagrees with the outcome of the re-examination, he may take a motivated appeal from the decision of the examiner to the Appeal Board of the Examination Division under the State Service of the Republic of Tajikistan for Protection of inventions and Registration of Trade and Service Marks (hereinafter referred to as «Appeal Board»). The notice of appeal shall be filed within three months from the date on which the applicant was notified of the examiner's decision. The appeal shall be examined within four months following the date of filing. The applicant shall be entitled to participate in person or through an agent at the examination of his appeal.

2. An appeal to the Court shall lie from the decision of the Appeal Board. The appeal shall be taken to the Court within 6 months following the date on which the decision was rendered.

3. If the applicant failed to meet the time limits laid down in Articles 11 (2), 12 (4), 13 (4),

14 (l) of this Law, they can be renewed by the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks at the applicant's request filed 6 months of the expiration date, provided the applicant can give valid reasons for the delay and has paid the prescribed renewal fee.

Article 15. Tajikistan state register of trade and service marks

The State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks shall conduct the registration of trade marks in the Tajikistan State Register of Trade and Service Marks (hereinafter referred to as «Register»). The following shall be entered in the Register: a reproduction of the trade mark, information identifying the applicant, date of priority, date of the registration, the list of goods and services in respect of which the registration is requested.

Other information concerning registration, renewal or invalidation of the registration of a trade mark, and any changes made with regard to this information, shall also be entered in the Register.

Upon request filed with the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks, an interested person shall receive an extract from the Register.

Certificate of registration shall be issued by the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks following registration of the trade mark in the Register and within one month after receipt of the documentary evidence that the prescribed fee has been paid.

Article 16. Duration of registration

1. The registration of a trade mark shall remain in force for ten years counted as from the date of filing of the application with the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks.

2. Each registration may be renewed for successive periods of ten years at the request of the proprietor of the trade mark filed within one year before the expiration of the period for which the registration was issued or renewed.

Upon request, the proprietor of the trade mark shall be granted a grace period of 6 months counted as from the date of the registration of the trade mark, provided that the prescribed additional fee has been paid.

The renewal shall be entered in the Register and in the certificate of registration.

Article 17. Registering of changes

Proprietor of the trade mark shall notify the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks about any changes in the trade name, in his first or last name or patronymic, about any similar goods added to or taken off the original list of goods in respect of which the trade mark was registered, about alteration of any element of the trade mark that does not substantially affect the identify of the trade mark as originally registered, and about any other changes concerning registration of the trade mark.

The changes shall be entered in the Register and in the certificate of registration.

Article 18. Publication

Information pertaining to the registration of a trade mark that has been entered in the Register under the provisions of Article 15 of this Law shall be published by the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks in the Official Gazette within 6 months following registration of the trade mark on the Register.

All further changes related to the registration of a trade mark shall be also subject to publication.

Article 19. Fees

1. Fees shall be charged for filing an application, examination and registration of a trade mark, for issuing a certificate of registration, for renewal of the registration and for all other activities of legal significance. The list of services chargeable to the applicant, collection procedure, amount of a fee, time of payment, grounds for exemption from a fee or those for reduction or restoration of the fee shall be determined by the Cabinet of ministers of the Republic of Tajikistan.

2. The fees shall be paid by the applicant, proprietor of the trade mark, or by another interested natural or legal person by agreement with the applicant/proprietor.

Article 20. Re-registration

An expired trade mark shall not be re-registered for three years in the name of a person other than the previous owner of the trade mark or his legal successor.

This rule shall also apply if the trade mark has been abandoned by the proprietor before expiration of the legal life of the trade mark.

Article 21. Foreign registration of a trade mark

1. Natural and legal persons of the Republic of Tajikistan shall be entitled to register a trade mark in a foreign country or to obtain international registration of a trade mark in accordance with the established procedure.

An application for international registration shall be filed through the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks.

2. Costs relating to the registration of a trade mark in a foreign country or to the international registration shall be born by the applicant or another interested natural or legal person by agreement with the applicant.

CHAPTER 3

COLLECTIVE MARK

Article 22. Rights to a collective mark

1. A collective trade mark is a trade mark of a union, association of manufacturers or traders, concern, or any other voluntary association of enterprises (hereinafter referred to as «association») which is intended to designate the goods with similar qualitative

and other characteristics produced or distributed by this association.

2. Provisions of Articles 26-28 of this Law shall not apply to collective marks.

Article 23. Registration and use of a collective mark

1. An application to register a collective mark must be accompanied by the regulations governing use of the collective mark. The regulations governing use shall specify and contain the name of the association authorized to register the collective mark in its own name, a list of enterprises entitled to use the mark, purpose of registration, a list of goods to be designated by this collective mark with description of their common qualitative and other characteristics, conditions of use, and the liability for breaking the regulations governing use.

2. Information about enterprises entitled to use a collective mark shall be entered in the Register and in the certificate of registration in addition to the information mentioned in Article 15 of this Law. This information and an extract from the regulations governing use of the collective mark specifying common qualitative and other characteristics of the goods in respect of which the collective mark is registered shall be published by the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks in the Official Gazette.

3. The proprietor of a collective mark shall notify the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks about amendments introduced into the regulations governing use.

4. If a collective mark was used on goods that do not show similar qualitative or other common characteristics, the registration of this mark shall be judicially invalidated in respect of all or some of the goods upon petition for cancellation filed by an interested natural or legal person.

CHAPTER 4

USE OF A TRADE MARK

Article 24. Use of a trade mark and consequences of non-use

1. Use of a trade mark on goods in respect of which it has been registered or on packaging thereof by the proprietor of the trade mark or any person who is entitled to use the trade mark under a license agreement in accordance with Article 28 of this Law shall constitute use of a trade mark.

The following shall also be deemed to constitute use of a trade mark: use of a trade mark in advertising, publications, on signboards, on exhibits displayed in fairs and exhibitions organized in the Republic of Tajikistan, and where there are proper reasons for non-use of the trade mark on goods or packaging thereof.

2. Natural and legal persons engaged in commercial intermediation are entitled to use their own trade marks along with that of the producer of goods or services, or instead of it, provided there is an agreement to this effect between the proprietor and the agent. The registration of a trade mark shall be judicially invalidated in whole or in part on the grounds of a petition for cancellation filed by an interested natural or legal person, if the trade mark has not been put to use for a continuous period of 5 years counted as from

the date of registration, or for a period of 5 years preceding the filing of the petition for cancellation.

If the proprietor of a trade mark can prove that the trade mark was not used for some reasons beyond his control, his arguments may be taken into consideration when the decision about the cancellation of the registration is made.

Article 25. Marking of registered goods

The proprietor of a trade mark can make a marking next to the trade mark which would indicate that the sign in question is a trade mark registered in the Republic of Tajikistan.

CHAPTER 5

TRANSFER OF A TRADE MARK

Article 26. Assignment of a trade mark

A trade mark may be assigned by the proprietor of the trade mark to a natural or legal person under an assignment agreement that may be signed in respect of some or all of the goods for which the trade mark is registered.

No assignment of a trade mark shall be allowed if it is likely to mislead the consuming public about the identity of the goods or their producer.

Article 27. Licensing

The right to use a trade mark may be licensed by the proprietor of the trade mark (the licensor) to another person (the licensee) under the license agreement.

The license agreement shall contain a quality clause that will oblige the licensee to produce goods not inferior to those produced by the licensor, and that the licensor shall closely monitor the observation of this quality provision.

Article 28. Registration of assignment and licensing contracts

Both assignment agreements and licensing contracts shall be recorded in the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks. Without this registration they shall be invalid.

CHAPTER 6

DISCONTINUANCE OF LEGAL PROTECTION OF A TRADE MARK

Article 29. Invalidation of registration

1. The registration of a trade mark shall be declared invalid in whole or in part at any time during the term of registration if the trade mark has been registered in breach of Articles 2 and 6 of this Law, or - in case the registration of a trade mark is cancelled on the grounds specified in Article 7 of this Law - during the five-year period following publication of information pertaining to the registration of a trade mark in the Official Gazette.

Any natural or legal person may oppose the registration of a trade mark. The notice of

opposition shall be filed with the Appeal Board within the aforesaid period of time.

2. The opposition shall be examined within 6 months from the date of filing. Both the opposer and the proprietor of the trade mark shall be entitled to take part in the examination of the opposition.
3. An appeal to the Court shall lie from the decision of the Appeal Board. The appeal shall be taken to the Court within 6 months from the date on which the decision was rendered.

Article 30. Cancellation of registration

The registration of a trade mark shall be cancelled by the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trade and Service Marks in the following cases:

- In case of expiration of the registration, as provided for in Article 16 of this Law;
- In case of invalidation of the registration, as provided for in Article 29 of this Law;
- In case of liquidation of the corporate body - proprietor of the trade mark;
- In case of judicial invalidation of the registration caused by the non-use of the trade mark;
- In case of surrender.

CHAPTER 7

PROTECTION OF PROPRIETOR'S RIGHTS

Article 31. Dispute - resolving bodies

Disputes that may arise over the ownership of a trade mark are settled in Court, with the exception of disputes that fall under the jurisdiction of the Appeal Board in accordance with Articles 14 and 30 of this Law.

Article 32. Responsibility for Infringement of proprietor's rights in a trade mark

1. The use of a trade mark in violation of this law, or the use of a sign which is similar to a protected trade mark with respect to similar goods, or any other actions detrimental to the proprietor of the trade mark or to the consuming public shall entail civil responsibility in accordance with the current legislation.
2. A person who unlawfully uses the trade mark of another person shall desist from using the trade mark at the request of the proprietor of the trade mark and make up for the damages sustained by the proprietor.

CHAPTER 8

CONCLUDING PROVISIONS

Article 33. The trade mark legislation of the Republic of Tajikistan

The trade mark legislation consists of this Law and other relevant legislative acts of the Republic of Tajikistan.

Article 34. The rights of foreign legal entities,

foreign citizens and stateless persons

Foreign legal persons, foreign citizens and stateless persons enjoy the rights accorded by this Law and other relevant legislative acts of the Republic of Tajikistan equally with the natural and legal persons of the Republic of Tajikistan, unless this Law or any other act of the current legislation provides otherwise.

Article 35. International treaties

If international treaties of which Tajikistan is a member establish rules different from those set in this Law, the rules of the international treaty shall apply.

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