

**LAW
OF THE REPUBLIC OF TAJIKISTAN
ON TRADEMARKS AND SERVICE MARKS**

This Law shall govern relations arising in connection with the legal protection and use of trademarks and service marks.

**CHAPTER 1
GENERAL PROVISIONS**

Article 1. Basic terms

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

Paris Convention - The Paris Convention for the Protection of Industrial Property of March 20, 1883 with subsequent amendments;

International Classification of Goods and Services (hereinafter “Nice Classification”) shall mean the classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, signed at Nice on June 15, 1957, as revised and amended.

An application for trademark registration shall mean a set of documents filed by the applicant or a person empowered to act for the applicant and containing a request for the grant of a title of protection.

Priority of a trademark shall mean the fact that the right in a trademark arose in the first place.

A right holder shall mean any natural person or legal entity enjoying the exclusive right in the trademark.

A patent attorney shall mean a national of the Republic of Tajikistan who, in accordance with the legislation, is granted the right to represent natural persons and legal entities before the Patent Office.

Article 2. Trademark and service mark

A trademark and a service mark (hereinafter "trademark") shall be designations capable of individualizing goods, performed jobs or services (hereinafter "goods") of legal entities or natural persons engaged in entrepreneurial activity.

Article 3. Legislation of the Republic of Tajikistan on Trademarks and Service Marks

The legislation of the Republic of Tajikistan on trademarks and service marks shall be based on the Constitution of the Republic of Tajikistan and shall consist of the Civil Code of the Republic of Tajikistan, this Law and other legislative acts of the Republic of Tajikistan, as well as international legal acts recognized by the Republic of Tajikistan.

Article 4. Authorized State body

Implementation of the state policy and functions in the field of the legal protection of trademarks stipulated by this Law shall be entrusted to the Authorized State Body (hereinafter “Patent Office”).

In cases stipulated by this Law, the Patent Office, in accordance with its competence, shall issue regulatory legal acts on the application of this Law.

An Appeal Board shall be set up, attached to the Patent Office, and shall consider the issues attributed to its competence by this Law. The Appeal Board shall carry out its authorized functions on the basis of the legislation of the Republic of Tajikistan, the “Appeal Board Statute” approved by the head of the Patent Office.

Article 5. Representation

Natural persons permanently residing outside the Republic of Tajikistan, or foreign legal entities or their representatives shall deal with the Patent Office through patent attorneys authorized by a power of attorney and who obtained the right to perform as patent attorneys according to the legislation of the Republic of Tajikistan.

CHAPTER 2.

LEGAL PROTECTION OF TRADEMARK

Article 6. Legal protection of a trademark

1. Legal protection of a trademark in the Republic of Tajikistan shall be accorded either on the basis of its state registration (hereinafter “registration”) pursuant to the procedure established by this Law or by virtue of the international treaties of which Tajikistan is a member.
2. The right in a trademark shall be protected by law.
3. An exclusive right in a trademark may be registered in the name of (right holder) a legal entity or a natural person engaged in entrepreneurial activity.

Article 7. A certificate for a trademark

1. A certificate shall be granted for a registered trademark.
2. The certificate shall attest the priority of the trademark, the exclusive right in the trademark in respect of the goods listed in the certificate.

Article 8. Exclusive right in a trademark

1. The right holder shall have the right to use the trademark and to forbid use of the trademark by other persons.

No person may use a trademark protected in the Republic of Tajikistan without the authorization of the right holder.

2. An infringement of the rights of the right holder (illegal use of a trademark) shall be recognized as any unauthorized commercial use of a trademark or a confusingly similar designation in the territory of the Republic of Tajikistan in respect of the goods for which the trademark has been registered, or of similar goods, including the placement of the trademark or a confusingly similar designation:

on the goods, labels, packages of these goods, which are manufactured, offered for sale, sold, displayed at exhibitions and fairs or used commercially on the territory of the Republic of Tajikistan, or stored and (or) transported with this purpose, or imported into the territory of the Republic of Tajikistan;

while performing jobs, providing services;

on documents related to commercial introduction of the goods;

in offer for sale of the goods;

on the Internet, particularly in domain names and in other forms of addressing.

The goods, labels, packages of these goods on which the trademark or a confusingly similar sign are used shall be regarded as counterfeits.

CHAPTER 3.

PROTECTABILITY OF A TRADEMARK

Article 9. Types of trademarks

1. Verbal, figurative, three-dimensional and other designations or their combinations may be registered as trademarks.
2. A trademark may be registered in any colour or combination of colours.

Article 10. Absolute grounds for refusal of registration

1. No registration shall be allowed for trademarks consisting only of designations that are devoid of distinctive ability or consist only of the elements:

that have come into common use as designations of goods of a certain type;

that are generally accepted symbols and terms;

that characterize goods and point to the kind, quality, quantity, property, intended purpose, value, as well as the place and time of their manufacture or sale.

that represent the shape of the goods which is determined exclusively or predominantly by the property or designated purpose of such goods.

The components indicated in Subparagraphs 2, 3, 4 and 5 of this Paragraph may be incorporated in the trademark as non-protected components, provided they do not hold a dominant position therein.

The provisions of this Paragraph shall not apply to designations which have acquired a distinctive character as a result of their use.

2. By virtue of the international treaties to which the Republic of Tajikistan is a party, registration as trademarks shall not be allowed for designations, that consist only of the elements representing official names of states, State armorial bearings, flags and other State emblems, abbreviated or full names of international intergovernmental organizations, their armorial bearings, flags and other emblems, official signs and hall-marks of control and warranty, seals, awards and other marks of distinction or designations confusingly similar to the above. Such elements may be incorporated in a trademark as non-protected elements, subject to the consent of a relevant competent authority.

3. No registration as trademarks shall be allowed for the designations or their elements:

that are deceitful or capable of misleading the consumer as to the good or its manufacturer;

that are contrary to public interests, principles of humanity or morals.

4. By virtue of an international treaty to which the Republic of Tajikistan is a party, no registration as trademarks on the territory of the Republic of Tajikistan shall be allowed for the designations that represent or incorporate the elements that are protected in one of the States-parties to that treaty in the capacity of the designations, identifying wines or alcoholic beverages as originating from its territory (produced within the geographic boundaries of that State), and possessing individual quality, reputation or other properties that are mainly determined by their origin, if the trademark shall be used for identifying wines or alcoholic beverages not originating from the territory of the given geographic object.

Article 11. Other grounds for refusal of registration

1. The following designations shall not be registered as trademarks if they are identical with or confusingly similar to:

trademarks of other persons, applied for registration (provided applications for them have not been withdrawn) or protected in the Republic of Tajikistan by virtue of the international treaties to which the Republic of Tajikistan is a party, in respect of similar goods with an earlier priority;

trademarks of other persons, recognized as well-known in the Republic of Tajikistan in respect of similar goods in accordance with the procedure prescribed by this Law.

The registration of a designation as a trademark in respect of similar goods, confusingly similar to a trademark, specified in Subparagraph 2 and 3 of this Paragraph shall be allowed only with the consent of the right holder.

2. Designations, identical with or confusingly similar to the appellations of origin of goods, protected on the territory of the Republic of Tajikistan, shall not be registered as trademarks in respect of any goods, except for cases where these designations are incorporated as non-protected elements into trademarks, registered in the name of persons eligible to use such appellations.

2. The following designations shall not be registered as trademarks if they are identical with:

a trade name (or its part) protected in the Republic of Tajikistan in respect of similar goods, an industrial design, a compliance mark, the rights in which arose to other persons in the Republic of Tajikistan, prior to the priority date of the trademark being registered;

a title of a work of science, literature or art, known in the Republic of Tajikistan as of the date of filing of the application, characters or quotations therefrom, a work of art or its fragment without the consent of a copyright owner or his successor in title, provided the rights in those works had arisen prior to the priority date of the registered trademark;

a family name, a given name, a pseudonym or their derivatives, a portrait and facsimile of the person famous as of the filing date of the application, without the consent of that person or his successor.

CHAPTER 4. PRIORITY OF A TRADEMARK

Article 12. Priority of a trademark

1. The priority of a trademark shall be established by the date of filing the application with the Patent Office.

2. The priority of a trademark may be determined by the filing date of the first application in a foreign country party to the Paris Convention (convention priority), provided the filing of the application with the Patent Office was completed within six months from the said date.
3. The priority of a trademark placed on exhibits at official or officially recognized international exhibitions organized in the territory of one of the countries-members of the Paris Convention may be established by the date of commencement of the public showing of the exhibit at the exhibition (exhibition priority), if the filing of the application with the Patent Office was completed within six months from the said date.
4. An applicant wishing to exercise the right of convention or exhibition priority shall be obliged to state so while filing the application for a trademark or within two months following receipt of the application by the Patent Office, and attach the necessary documents confirming the lawfulness of such claim or furnish these documents within three months from the date of receipt of the application in the Patent Office.
5. The priority of a trademark filed by an applicant in compliance with Paragraph 6 of Article 14 of this Law (hereinafter "divisional application") on the basis of another application of that applicant for the same designation (hereinafter "original application") shall be established by the date of filing of the initial application with the Patent Office, where the right exists to establish an earlier priority by the initial application, - by the priority date, provided that as of the date of filing the divisional application, the initial application is not withdrawn nor deemed to be withdrawn, and that the divisional application is filed prior to a decision being made with respect to the initial application.
6. Where different applicants filed applications for identical trademarks with the same priority date in respect of fully or partially coinciding lists of goods, registration of the trademark with respect to the goods for which the above-mentioned lists coincide, may be effected in the name of one of them on the basis of the agreement reached between the applicants.

In the event that identical trademarks with the same priority date and fully or partially coinciding lists of goods have been applied for registration by one and the same applicant, then the registration of the trademark in respect of such goods may be effected under one of the applications selected by the applicant.

Within six months of the date of receipt of the corresponding notification, the applicants (applicant) shall inform of the agreement reached by them (his choice) in respect of which particular application the registration of the trademark is sought.

If, within the prescribed time period, no such information is communicated to the Patent Office and no request is submitted for the extension of the prescribed time, the applications shall be deemed withdrawn.

7. The priority of a trademark may be determined by the date of its international registration in accordance with the international agreements of the Republic of Tajikistan.

CHAPTER 6. REGISTRATION OF A TRADEMARK

Article 13. Application for registration of a trademark

1. An application for registration of a trademark (hereinafter "application") shall be filed with the Patent Office by a legal entity or a natural person engaged in entrepreneurial activity (hereinafter "applicant").

2. Dealings with the Patent Office may be conducted by an applicant, the right holder or any other person concerned either independently or through a patent attorney registered with the Patent Office.

3. An application shall pertain to a single trademark.

4. An application shall contain:

a request for registration of a designation as a trademark with an indication of the applicant, as well as of his location or place of residence;

the designation applied for;

a list of goods in respect of which the registration of the trademark is requested, grouped by classes of the Nice Classification;

a description of the designation applied for;

The application shall be filed in the official language or in Russian.

The application shall be signed by the applicant or, where such application is filed through a patent attorney, by the applicant or the patent attorney.

5. The following must be attached to the application:

a document confirming payment of the obligatory payment for filing in the prescribed amount;

a Charter of a collective mark if the application is filed in respect of a collective mark.

The documents accompanying an application shall be filed in the official or another language. Where such documents are filed in another language, their translation into the official language shall be enclosed. The translation into the official language may be submitted by the applicant not later than two months after the date of when the Patent Office notified him of the need to comply with this requirement.

6. The date of filing of an application with the Patent Office shall be the date of receipt of the documents provided by Paragraphs 2, 3, and 4 of this Article, or,

where the said documents were not filed simultaneously, by the date of receipt of the last of the documents submitted.

7. Upon the filing of an application with the Patent Office, any person shall be entitled to inspect the documents of the application originally attached thereto at the filing date. The procedure for inspecting the materials attached to an application shall be laid down by the Patent Office.

8. The requirements for the documents attached to the application shall be determined by the Patent Office

Article 14. Examination of the application for a trademark

1. The examination of an application shall be conducted by the Patent Office and shall comprise a formal examination and an examination of the designation applied for.

2. While an application is being examined and while a decision in respect thereof is pending, the applicant shall be entitled to supplement, update or amend the material attached to the application.

If the supplementary materials refer to goods not included in the application as of the date of its filing or substantially alter the designation applied for, such materials shall not be accepted for consideration and may be submitted by the applicant as a separate application.

3. Any change in the identity of the applicant in the event of assignment of an application or in the event of change of the applicant's name and also corrections of obvious and clerical mistakes in documents comprising the application may be made prior to the date of registration of the trademark.

4. During the examination the Patent Office shall be entitled to request from the applicant supplementary materials the absence of which would make the examination impossible.

The procedure laid down by Paragraph 2 of this Article shall apply to any supplementary material which refer to goods not included in the application as of the date of its filing or substantially alter the designation applied for.

The supplementary materials, requested by the examiners, shall be submitted within two months from the date of receipt of such request by the applicant or copies of the materials referred to in the request of examination, provided that these copies were requested by an applicant within one month after receiving the request of examination. If, within such time period, the applicant fails to submit the requested materials or a request for the extension of the said time period, the application shall be deemed withdrawn. At the request of the applicant, the Patent Office may extend this period by not more than six months. Provided that the reason given for having missed such time periods is confirmed, the Patent Office can extend it by more than six months.

5. An application may be withdrawn at the request of the applicant at any stage of examination, but not later than the date of registration of the trademark.
6. While an application is being examined and while a decision in respect thereof is pending, the applicant shall have the right to file a divisional application for the same designation, which incorporates the list of goods, mentioned in the initial application as of the date of its filing with the Patent Office, and dissimilar to the goods covered by the initial application.

Article 15. Formal Examination

1. A formal examination of an application shall be carried out within one month from the date of its filing with the Patent Office.
2. During the course of a formal examination, the presence of the necessary documents and their conformity with the established requirements shall be checked. Depending on the findings of the formal examination, a decision shall be made either to accept it for further examination or to deny its acceptance, of which the applicant shall be informed.
3. Simultaneously with notification of the positive outcome of the formal examination, the applicant shall be informed of the filing date established pursuant to Paragraph 6 of Article 13 of this Law.

Article 16. Examination of the designation applied for

1. The examination of the designation applied for shall be conducted upon completion of the formal examination.

In the course of examination, a designation applied for shall be checked for its compliance with the requirements set out in Articles 2, 10 and Paragraph 1 and 2 of Article 11 of this Law, and the priority of the trademark shall be established.

2. Depending on the findings of the examination, a decision shall be made either to register the trademark or to deny its registration.

Copies of materials opposed to the designation applied for may be requested within one month of the date of receipt of the decision on the application.

3. The decision to register a trademark may be re-considered by the Patent Office in connection with the receipt of an application which enjoys an earlier priority in accordance with Article 12 of this Law.
4. In the event of disagreement of the applicant with the examiner's decision, he shall have the right, within two months of the date of receipt of the decision, to file with the Patent Office a request for re-examination.

Re-examination shall be conducted within two months of the date of receipt of the applicant's request.

Article 17. Appeal against the decision on the application and restoration of the missed time periods

1. In the event of disagreement with

the decision taken on the results of the formal examination, or with the refusal to accept it for consideration,

the decision passed on the results of examination of a designation applied for, the decision to recognize an application as having been withdrawn,

the applicant may lodge an objection with the Appeal Board within three months after the date of receipt of the corresponding decision, or of copies of the material counter-posed to the application, as requested from the Patent Office, provided that the applicant requested the same within one month of the date when he received the corresponding decision.

2. The time periods provided for by Part 4 of Article 14 of this Law and Part 1 of this Article and missed by an applicant, may be restored by the Patent Office pursuant to an appropriate request of the applicant, which shall be filed not more than two months after the date of their expiry, provided that the reasons are confirmed to be valid and that the appropriate obligatory payment is paid.

Such request shall be submitted to the Patent Office simultaneously with the supplementary materials, requested by the examiners, or with a request for extending the time for their submission, or, alternatively, simultaneously with filing an appeal with the Appeal Board.

Article 18. Registration of a trademark

On the basis of the decision to register the trademark the Patent Office shall, within one month after the date of receipt of a document about payment of an obligatory payment, enter the trademark in the Register. Such entry in the Register shall include the trademark, information about its right holder, the priority date of the trademark, the date of its registration, the list of goods in respect of which the trademark is registered, other information relating to the registration of the trademark, as well as any subsequent changes in such information.

In the event of failure to submit, as may be established, a document evidencing the payment of an obligatory payment for the registration of a trademark and the issuance of a certificate in respect thereof, the trademark shall not be registered, and the corresponding application shall be deemed to have been withdrawn.

Article 19. Issuance of a certificate for a trademark

1. A trademark certificate shall be issued by the Patent Office within one month from the date of the registration of the trademark in the Register.

2. The form of the certificate and its contents shall be determined by the Patent Office.

Article 20. Duration of registration

1. The registration of a trademark shall remain valid for ten years as from the date of the application's filing with the Patent Office.
2. The term of validity of a trademark registration may be extended at the request of the right holder to be filed during the last year of such validity term, each time for a period of ten years.

Upon the request of the right holder for extension of the period of validity of the registration of the trademark he may be granted a grace period of six months after expiration of the registration, provided that an additional obligatory payment has been paid.

3. A record to the effect that the term of validity of a trademark registration has been extended shall be entered in the Register and in the certificate of a trademark registration.

Article 21. Recordal of changes in the registration

1. The right holder shall notify the Patent Office of any changes in the legal name, in his first or last name or patronymic, any reduction of the list of goods, in respect of which the trademark has been registered, any alteration of individual elements of the trademark, not affecting its substance, and of other changes concerning the registration of the trademark.

In the event that the grant of legal protection for a trademark is contested on such grounds and under such procedure as are determined by Article 35 of this Law, from the registration of the trademark valid for several goods a separate registration of such trademark for the goods or part of the goods, which are not similar to the goods the list of which remains in the primary registration, can be effected at the request of the right holder. This request may be submitted by the right holder before the action is taken on the results of dispute settlement on the registration of the trademark.

The changes relating to the trademark registration shall be entered in the Register and in the trademark certificate, subject to payment of an appropriate obligatory payment.

2. The Patent Office may enter changes in the Register and in the trademark certificate to remedy obvious and technical errors.

Article 22. Publishing information concerning registration

Information pertaining to the registration of a trademark and entered in the Register under the provisions of Article 18 of this Law shall be published by the Patent Office in the Official Gazette immediately after registration of the trademark in the Register or after the changes in the registration of the trademark have been entered in the Register.

Article 23. Registration of a trademark in foreign countries

Legal entities and natural persons of the Republic of Tajikistan shall have the right to register a trademark in foreign countries or to obtain its international registration.

The application for international registration of a trademark shall be filed through the Patent Office.

Article 24. Conditions for re-registration

A trademark, a trademark identical to it or a designation confusingly similar to it, the duration of the registration of which has expired and a request for renewal of which has not been submitted according to part 2 of Article 20 of this Law shall not be re-registered for a period of three years from the date of termination of the registration of the trademark, in the name of a person other than the previous right holder of the trademark or his legal successor.

This rule shall also apply in the case where the owner of a trademark has abandoned the trademark before the expiration of the registration.

CHAPTER 6. WELL-KNOWN TRADEMARK

Article 25. Well-known trademark, its legal protection

1. At the request of a legal entity or a natural person, a trademark, protected on the territory of the Republic of Tajikistan on the basis of its registration; a trademark, protected on the territory of the Republic of Tajikistan without registration by virtue of an international treaty of the Republic of Tajikistan, and also a designation, used as a trademark but having no legal protection on the territory of the Republic of Tajikistan may be recognized to be well-known trademarks in the Republic of Tajikistan if such trademarks or designation, as a result of their intensive use at the date, indicated in the application, became widely known in the Republic of Tajikistan among corresponding consumers in respect of goods of that person.

A trademark or a designation may not be recognized as a well-known trademark if they became widely known after the date of priority of an identical or confusingly similar trademark of another person, intended to be used in respect of similar goods.

2. A well-known trademark shall be accorded legal protection provided for by this Law.

In recognizing the trademark already registered as a well-known trademark, legal protection of such a trademark shall also extend to the goods non-similar to those in respect of which the trademark is recognized as well-known, provided the use of

that trademark by another person in respect of the above-mentioned goods will be associated by consumers with the right holder and may harm his legitimate interests.

Article 26. Granting legal protection to a well-known trademark

1. The legal protection for a well-known trademark shall be granted pursuant to a decision of the Appeal Board, taken following a request submitted in conformity with Subparagraph 1 of Paragraph 1 of Article 25 of this Law.
2. A trademark, recognized to be well-known, shall be entered by the Patent Office in the List of well-known trademarks in the Republic of Tajikistan (hereinafter "List") within one month after receipt of the document confirming payment of a prescribed fee and a procedural payment.
3. A certificate for a well-known trademark shall be issued by the Patent Office within one month after the date of entering the trademark in the List. The form of a certificate and the content thereof shall be determined by the Patent Office.
4. Information relating to a well-known trademark shall be published by the Patent Office in the Official Gazette immediately after its recording in the List.
5. Legal protection of a well-known trademark shall be valid perpetually.

CHAPTER 7. COLLECTIVE MARK

Article 27. Right in a collective mark

1. In conformity with an international treaty of the Republic of Tajikistan an association of persons, the establishment and business activities of which are not contrary to the legislation of the country where it has been established, shall have the right to register a collective mark in the Republic of Tajikistan, which shall be a trademark of a business association, intended to designate the goods manufactured and (or) marketed by the persons, being part of this association, and possessing uniform qualitative or other common characteristics.
2. A collective mark and the right to use it may not be transferred to other persons.

Article 28. Registration of a collective mark

1. An application for a collective mark shall be accompanied by the Charter of the collective mark, which shall contain the name of the association authorized to register the collective mark in its own name, a list of persons entitled to use the mark, the objective of its registration, a list of goods to be designated by the collective mark with a description of their uniform qualitative or other common characteristics, conditions of its use, the procedure for control over its use, and liability for breaching the Charter of the collective mark.

2. In the Register and in the certificate for a collective mark in addition to information provided for in Article 18 of this Law the information about persons entitled to use the collective mark shall be entered. Such information and an excerpt from the Charter of the collective mark about uniform qualitative and other common characteristics of the goods in respect of which the collective mark has been registered shall be published by the Patent Office in the Official Gazette.
3. In the event that a collective mark is used on goods not possessing uniform qualitative or other common characteristics, its legal protection may be terminated in full or in part pursuant to a court judgement passed upon the request of any interested person.
4. A collective mark and an application for its registration may be converted, accordingly, into a trademark and an application for the registration of a trademark and vice versa. The procedure for such conversion shall be laid down by the Patent Office.

CHAPTER 8.

USE OF A TRADEMARK

Article 29. Use of a trademark and consequences of its non-use

1. Use of a trademark shall be understood to mean its use on the goods in respect of which it has been registered and (or) on packaging thereof by the right holder or a person to whom such right has been conferred under a license agreement in accordance with Article 32 of this Law.

Application of a trademark in advertising, printed publications, on letterheads, on signboards, during demonstration of exhibits displayed at exhibitions and fairs held in the Republic of Tajikistan, may be recognized as its use, provided valid reasons exist for non-use of the trademark on goods and (or) packaging thereof.

2. Legal entities and natural persons engaged in business as intermediaries may, on the basis of an agreement, use their own trademark alongside with that of the manufacturer of goods, or instead of the trademark of the latter.

3. Legal protection of a trademark may be invalidated prematurely in respect of all or part of the goods in connection with non-use of the trademark for any continuous period of three years after its registration. A petition for premature invalidation in connection with non-use of the trademark may be submitted to the Appeal Board on the expiry of the above-mentioned three years provided that the trademark had not been used before such a petition was submitted.

Proof of use of a trademark shall be adduced by the right holder

For the purposes of this Paragraph use of a trademark with changes in some of its elements that do not alter its substance shall be recognized as the use of a trademark.

Whenever a decision is to be taken on a premature invalidation of the registration of a trademark in connection with its non-use, the proof adduced by the right holder to the effect that the trademark has not been used for reasons beyond the right holder's control shall be taken into consideration.

Article 30. Exhaustion of rights based on trademark registration

The registration of a trademark shall not entitle its right holder to prohibit other persons from using such trademark in respect of the goods, which have been commercially introduced on the territory of the Republic of Tajikistan either directly by the right holder or with the consent thereof.

Article 31. Precautionary marking

The right holder of a trademark may affix, next to the trademark, a marking in the form of the Latin letter "R" or a circled letter "R" (®) or a verbal designation indicating that the applied designation is a trademark registered in the Republic of Tajikistan.

CHAPTER 9.

TRANSFER OF THE EXCLUSIVE RIGHT IN A TRADEMARK

Article 32. Transfer of an exclusive right in a trademark (assignment of a trademark)

An exclusive right in a trademark in respect of all or part of the goods in respect of which it has been registered may be assigned by the right holder to a legal entity or a natural person engaged in entrepreneurial activity under a contract of transfer of an exclusive right in a trademark (contract of assignment of a trademark).

Assignment of a trademark shall not be allowed if it may be the reason for misleading the consumer with respect to goods or its manufacturer.

Article 33. Grant of a license for the use of a trademark

The right for the use of a trademark may be granted by the right holder (the licensor) to another legal entity or a natural person engaged in entrepreneurial activity (the licensee) under a license agreement in respect of all or part of the goods in respect of which it has been registered.

A license agreement must contain a clause that the quality of the goods of the licensee will not be inferior to those of the licensor, and that the licensor shall exert control over the observation of this clause.

Article 34. Registration of contracts

A contract of the transfer of an exclusive right in a trademark (contract on assignment of a trademark) or a license contract shall be registered with the Patent Office. Without such registration the said contracts shall be deemed invalid.

The procedure for registration of the above-mentioned contracts shall be laid down by the Patent Office.

CHAPTER 10.

TERMINATION OF LEGAL PROTECTION OF A TRADEMARK

Article 35. Contest and recognition of the grant of the registration to a trademark as invalid

1. Grant of legal protection to a trademark may be challenged and invalidated:
 - 1) in full or in part at any time during its term of validity, if effected in breach of the requirements set out in Article 10 and Paragraph 3 of Article 11 of this Law or within five years after the publishing of information in the Official Gazette, if effected in breach of the requirements set out in Paragraph 1 and 2 of Article 11 of this Law;
 - 2) in full or in part at any time during its term of validity, if effected in breach of the requirements set out in Paragraph 3 of Article 6 of this Law;
 - 3) in full at any time during its term of validity, if effected in the name of an agent or representative of the person which is the right holder of an exclusive right in this trademark in one of the countries - members of the Paris Convention, in breach of the requirements set out in that Convention;
 - 4) in full or in part at any time during its term of validity, if actions undertaken by the right holder in registering the trademark have been recognized, in the order set by the law, to be an act of unfair competition.
2. The extension of legal protection to a trademark well known in the Republic of Tajikistan may be challenged and invalidated in full or in part at any time during its term of validity, if effected in breach of the requirements set out in Paragraph 1 of Article 25 of this Law.
3. Any person may file an opposition with the Appeal Board, within such time and on such grounds as provided by Subparagraph 1 and 2 of Paragraph 1 of this Article, against the extension of legal protection to a trademark.

An opposition against the extension of legal protection to a trademark, if by reason provided for by Subparagraph 3, Paragraph 1 of this Article, shall be filed with the Appeal Board by the interested right holder of an exclusive right in the trademark in one of the countries - members of the Paris Convention.

An opposition against the extension of legal protection to a trademark, well-known in the Republic of Tajikistan on the grounds provided for by Paragraph 2 of this Article, may be filed by any person with the Appeal Board.

A request for invalidating an extension of legal protection to a trademark pursuant to a decision made in order provided for by Subparagraph 4 of Paragraph 1 of this Article shall be filed with the Patent Office by any person.

4. The extension of legal protection to a trademark shall be declared invalid in full or in part pursuant to a decision made on the basis of opposition or a request submitted in accordance with Paragraph 3 of this Article.

Article 36. Termination of legal protection of a trademark

1. Legal protection of a trademark is terminated:

in connection with the expiration of the term of validity of a trademark registration;

on the grounds of a court judgement that has taken legal effect concerning an early termination of the legal protection of a collective mark due to the use of that mark on goods that do not possess uniform qualitative or other common characteristics as set forth in Paragraph 3 of Article 28 of this Law;

on the basis of a decision on earlier termination of the legal protection of a trademark on the grounds of its non-use as set forth in Paragraph 3 of Article 29 of this Law;

on the basis of a decision of the Patent Office on earlier termination of the legal protection of a trademark in the event of liquidation of the legal entity- the right holder or in the event of discontinuance of the entrepreneurial activity of the natural person - the right holder;

in the event that the right holder abandons it;

on the basis of the decision taken on the application of any person filed with the Appeal Board on earlier termination of legal protection of a trademark where a registered trademark has become a commonplace designation used to designate a certain kind of goods.

2. Legal protection of a well-known trademark shall be terminated on the grounds set forth by Subparagraphs 4 to 7 of Paragraph 1 of this Article, and also on the basis of the decision of the Appeal Board in the event that a well-known trademark loses the features set forth in Subparagraph 1 of Paragraph 1 of Article 25 of this Law.

CHAPTER 11.

PROTECTION OF THE RIGHTS OF THE RIGHT HOLDER OF A TRADEMARK

Article 37. Disputes examined by courts

1. Disputes relating to the implementation of this Law shall be examined by courts within the limits of their jurisdiction in accordance with the procedure laid down by the legislation of the Republic of Tajikistan, including disputes over:

infringement of the exclusive right in a trademark;

early termination of the legal protection of a collective mark due to its use on goods which do not possess uniform qualitative and other common characteristics;

conclusion and implementation of license contracts and contracts of assignment of an exclusive right in a trademark (contract on assignment of a trademark);

Article 38. Liability for illegal use of a trademark

1. Any use of a trademark or a designation similar to a trademark in contravention of Paragraph 2 of Article 8 of this Law shall entail civil, administrative or criminal liability as prescribed by the legislation of the Republic of Tajikistan.

2. Protection of civil rights against the illegal use of a trademark shall include the following, in addition to claims for the discontinuance of such infringement or for payment of related damages:

official publication of a court judgement with the aim of restoring goodwill of the injured party;

removal from counterfeited goods, labels or their packages of the illegally used trademark or a designation confusingly similar to it, or destruction at the expense of the infringer of counterfeited goods, labels, packages, if it is impossible to remove an illegally used trademark or designation confusingly similar to it, except for the cases where these counterfeited goods, labels and packages shall be appropriated by the State or handed over to the right holder at his request to compensate for the damage or with the purpose of their further destruction.

3. A person affixing a precautionary marking in respect of a trademark unregistered in the Republic of Tajikistan shall be liable pursuant to the procedure laid down by the legislation of the Republic of Tajikistan.

CHAPTER 12I

CONCLUDING PROVISIONS

Article 39. Decisions of the Appeal Board

A procedure for filing oppositions and requests with the Appeal Board and a procedure for their consideration shall be prescribed by the Patent Office.

Decisions of the Appeal Board taken on oppositions and requests, filed in the order set forth in Articles 17, 26, 29, 35, 36 of this Law shall be approved by the Head of the Patent Office and shall come into force from the date of their approval and may be appealed in Court in conformity with legislation of the Republic of Tajikistan.

Article 40. Obligatory payments and procedural payment

1. For filing of an application, registration and issuing a certificate for a trademark, renewal of registration and reinstatement of missed time periods as well as for all other legally significant acts connected with registration and renewal of trademark registrations obligatory payments shall be charged.

2. For carrying out examination, entering changes and corrections in the documents of the application, publication of particulars of a trademark registration, consideration of oppositions and application by the Appeal Board, as well as for other acts connected with examination of the application the Patent Office shall charge a procedural payment.

3. The obligatory payments and procedural payment shall be paid by the applicant, right holder, or, in agreement with them, by any legal entity or natural person.

Article 41. Rights of foreign legal entities and foreign individuals

Foreign individuals and legal entities shall enjoy those rights granted by this Law on a par with individuals and legal entities of the Republic of Tajikistan by virtue of international treaties to which the Republic of Tajikistan is a party or on the basis of reciprocity.

Article 42. International treaties

Where an international treaty to which the Republic of Tajikistan is a party stipulates rules that differ from those set out in this Law, the rules of such international treaty shall apply.

Article 43. Procedure for entry into force of this Law

This Law shall enter into force on the day of its official publication.

**Статья 44. "On Recognition of the Law of the Republic of Tajikistan
"On trademarks and service marks" to have lost validity**

The Law of the Republic of Tajikistan № 456 of 23 December 1991 "On trademarks and service marks" shall be recognized to have lost the validity