

ANNEX IX

REPUBLIC OF TAJIKISTAN

LAW

ON TRADE AND SERVICE MARKS

CHAPTER 1
TRADEMARK AND SERVICE MARK, THEIR
LEGAL PROTECTION

ARTICLE 1
TRADEMARK AND SERVICE MARK

A trademark and a service mark (hereinafter referred to as "trademark") shall be designations, registered in accordance with the established procedure, capable of distinguishing the goods and services of some legal entities or natural persons from the similar goods and services (hereinafter referred to as "goods") of other legal entities or natural persons.

ARTICLE 2
LEGAL PROTECTION OF A TRADEMARK

1. Legal protection of a trademark in the Republic of Tajikistan shall be effected on the basis of its registration in accordance with 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 the State.
3. A trademark may be registered in the name of a legal entity, as well as of a natural person engaged in entrepreneurship.

ARTICLE 3
CERTIFICATE FOR A TRADEMARK

1. A certificate shall be granted for a registered trademark.
2. A certificate shall attest the fact of the registration of a trademark, its priority, the exclusive right of the owner of a trademark in respect of the goods specified in the certificate, and shall contain a reproduction of the trademark.

ARTICLE 4

EXCLUSIVE RIGHT IN A TRADEMARK

1. The owner of a trademark shall have the exclusive right to use the trademark and dispose of it, as well as the right to forbid using the trademark by other persons. No person may use a trademark protected in the Republic of Tajikistan without authorization from its owner.
2. Any unsanctioned action referred to in Article 24 (1) of this Law , as well as importation, offering for sale and other introduction into the market of the goods designated by a trademark protected in the Republic of Tajikistan, shall be recognized as infringement of the right of the trademark owner.

ARTICLE 5

KINDS 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 6

ABSOLUTE GROUNDS FOR REFUSAL OF REGISTRATION

1. No registration shall be allowed for the trademarks consisting only of designations:
 - that are devoid of distinctive features or have descriptive character;
 - that represent armorial bearings, flags and emblems; official names of states; emblems, denominations or abbreviations of denominations of international intergovernmental organizations; official signs and hallmarks of control and warranty; seals and stamps; decorations; religious and other distinguishing signs. Such designations may be included as unprotected elements in the trademark provided the consent of the appropriate competent authority or that of the trademark owner has been obtained;

- that have become customary as designations of the goods of a certain kind;
- that constitute generally accepted symbols and terms;
- that designate the kind, quality, quantity, intended purpose, value, as well as the place and time of their production or sale.

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

- containing false or misleading information about the manufacturer or its goods;
- being, by their content, contrary to public interests, principles of humanity and morality.

ARTICLE 7

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 earlier registered or applied for registration in the Republic of Tajikistan in the name of another person in respect of similar goods;
- trademarks of other persons protected without registration by virtue of international treaties of which Tajikistan is a member;
- trade names (or part thereof) owned by other persons who have been granted the rights in these names on the basis of earlier filed applications for trademarks in respect of similar goods;
- appellations of origin protected in the Republic of Tajikistan, except for the cases where they are incorporated as a non-protected element in a trademark being registered in the name of a person entitled to use such appellation.

2. The following designations shall not be registered if they reproduce:

- industrial designs the rights in which belong to other persons in the Republic of Tajikistan;

- 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, without the consent of the copyright owner or that of the appropriate competent authority;
- family names, given names, pseudonyms and their derivatives, portrays and facsimiles of famous persons, without the consent of such persons, their heirs or a appropriate competent authority.

ARTICLE 8

**STATE SERVICE FOR PROTECTION OF INVENTIONS AND
REGISTRATION OF TRADEMARKS AND SERVICE MARKS OF
THE REPUBLIC OF TAJIKISTAN**

The State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trademarks and Service Marks shall accept for consideration applications for registration of trademarks, conduct their examination, issue certificates for trademarks valid in all the territory of the Republic of Tajikistan, keep the State Register on trademarks and service marks of the Republic of Tajikistan, exert control over the observation of the trademark legislation, generalize the practice of its implementation, interpret the provisions of this Law, offer professional help and services with regard to these issues, carry out informational work on trademarks, and perform activities relating to the international registration of trademarks.

CHAPTER 2

REGISTRATION OF A TRADEMARK

ARTICLE 9

APPLICATION FOR REGISTRATION OF A TRADEMARK

1. An application for registration of a trademark (hereinafter referred to as "application") shall be filed with the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trademarks and Service Marks by a legal entity or a natural person engaged in manufacturing or commercial activity.

An 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 Trademarks and Service Marks.

2. Foreign legal entities who are domiciled in foreign countries, citizens or stateless persons domiciled outside the Republic of Tajikistan (or their patent attorneys) shall conduct business in the Republic of Tajikistan connected with registration of trademarks and their renewal through their patent attorneys in the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trademarks and Service Marks.

3. The application must be related to one trademark only.

4. The application must contain:

- a request for registration of a designation as a trademark with the indication of the applicant, as well as of his domicile or place of residence;
- the designation claimed and the description thereof;
- a list of goods and services in respect of which the registration is requested, grouped 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. The following must be attached to the application:

- a document confirming the payment of the prescribed fee or exemption from payment of the fee, or evidence of the grounds for reduction of its amount;
- a document attesting the power of the patent attorney if the application is filed through a patent attorney;
- a Charter of a collective mark if the application is filed for a collective mark in accordance with Article 24 of this Law.

The documents attached to 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 may be presented 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 Trademarks and Service Marks.

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

ARTICLE 10

PRIORITY OF A TRADEMARK

1. The priority of a trademark shall be determined on the date on which the trademark application was filed with the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trademarks and Service Marks, provided that the application meets the requirements provided for in Article 9 (4) of this Law.

2. The priority of a trademark may be determined on the filing date of the first application for the trademark 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 the said date.

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

3. The priority of a trademark placed on exhibits at officially recognized international exhibitions organized in the territory of one of the countries-members of the Paris Convention for the Protection of Industrial Property (exhibit priority) may be determined on the date of the beginning of the open display of the exhibits at the exhibition, provided the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trademarks and Service Marks received the application for a trademark within six months from the said date.

4. An applicant wishing to exploit the right to convention or exhibition priority must state so while filing the application for a trademark or within two months following receipt of the application by the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trademarks and Service Marks, 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 State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trademarks and Service Marks.

5. The priority of a trademark may be determined on the date of the international registration of the trademark in accordance with the international agreements of the Republic of Tajikistan.

ARTICLE 11

EXAMINATION OF AN APPLICATION FOR A TRADEMARK

1. The Examination of an application shall be conducted by the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trademarks and Service

Marks; and it shall include a preliminary examination and an examination of the claimed designation, being conducted in accordance with this Law and the regulations established by the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trademarks and Service Marks on its basis.

The applicant shall have the right, on his own initiative or at the invitation of the State examiner, personally or through a patent attorney, to participate in the consideration of the issues arising in the course of a preliminary examination and an examination of the claimed designation.

2. Within two months from the filing date the applicant shall be entitled to supplement, specify or amend the materials of the application.

If the additional materials substantially change the claimed designation, or include in the list of goods, specified in the application, the goods not similar to them, these materials shall not be accepted for consideration and may be arranged by the applicant as a separate application.

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

Additional materials at the examiner's request must be submitted within two months of the date of receipt of said request. At the applicant's request this period may be extended provided that the request has been submitted prior to the expiration of this period. If the applicant failed to timely respond or neglected to respond to the examiner's request, the application shall be deemed to have been withdrawn, of which the applicant shall be notified.

4. The application may be withdrawn at the request of the applicant at any stage of examination.

ARTICLE 12

PRELIMINARY EXAMINATION

1. A preliminary examination of an application shall be conducted within one month from the date of filing with the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trademarks and Service Marks.

2. During the course of a preliminary examination, the content of the application and availability of accompanying documents, as well as their compliance with the established requirements shall be examined. According to the results of the preliminary examination the applicant shall be notified of the acceptance of the application for consideration or of the refusal of its acceptance for consideration.

3. In the case of acceptance of the application for examination the applicant shall be notified about the determination of priority of the trademark, except for the cases where he asks for convention or exhibition priority but, at the moment of acceptance of the application for consideration, failed to submit the necessary documents confirming the legality of this request.

4. In the case of disagreement with the decision of the preliminary examination the applicant within two months of the date of receipt of such a decision shall have the right to file an opposition with the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trademarks and Service Marks. The decision on the opposition shall be made within one month of the date of its receipt.

ARTICLE 13

EXAMINATION OF THE CLAIMED DESIGNATION

1. Examination of the claimed designation shall be conducted after completion of the preliminary examination.

In the course of the examination, the priority of the trademark shall be determined if it has not been determined during the preliminary examination; and the claimed designation shall

be examined for compliance with the requirements laid down in Articles 6 and 7 of this Law.

2. On the results of the examination a decision of registration of the trademark or of refusal of registration shall be made.

The applicant shall have the right to familiarize himself with the materials used in conducting the examination.

The copies of the materials opposed to the claimed designation may be requested within one month of the date of receipt of the decision on the application.

3. The decision of the examination on the registration of a trademark may be reconsidered in connection with the filing of an application having earlier priority in accordance with Article 10 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 State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trademark and Service Marks a request for re-examination.

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

ARTICLE 14

APPEAL AGAINST THE DECISION ON THE APPLICATION AND RESTORATION OF MISSED TERMS

1. In the event of disagreement with the decision of the re-examination, the applicant shall have the right, within three months of the date of receipt of the decision, to file a motivated appeal with the Appeal Board of the Examination Division under the State Service of the Republic of Tajikistan for Protection of inventions and Registration of Trademarks and Service Marks (hereinafter referred to as "Appeal Board"). The appeal must be considered within four months of the date of its receipt. The applicant shall have the right in person or through his representative to take part in the consideration of his appeal.

2. The decision of the Appeal Board may be appealed to Court by the applicant within six months from the date of its making.

3. The terms laid down in Articles 11 (2), 12 (4), 13 (4), 14 (1) of this Law missed by the applicant may be restored by the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trademark and Service Marks at the applicant's request filed not later than six months of their expiration, on confirmation of a valid reason and payment of the fee.

ARTICLE 15

STATE REGISTER OF TRADEMARKS AND SERVICE MARKS OF THE REPUBLIC OF TAJIKISTAN

The State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trademarks and Service Marks shall make the registration of trademarks in the State Register of Trademarks and Service Marks of the Republic of Tajikistan (hereinafter referred to as "Register"). A reproduction of the trademark, particulars of its owner, the date of priority of the trademark, the date of its registration, the list of goods and services in respect of which the trademark has been registered shall be entered in the Register.

Other information related to the registration of a trademark, renewal of a trademark and invalidation of the registration, and all subsequent changes in this information, shall also be entered in the Register.

At the request of an interested person the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trademarks and Service Marks may provide an extract from the Register.

Issuance of a certificate for a trademark shall be made by the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trademarks and Service Marks on the basis of the registration of the trademark in the Register within one month after receipt of the document acknowledging payment of the prescribed fee.

ARTICLE 16

DURATION OF REGISTRATION

1. A trademark registration shall have a validity of ten years counting from the date of filing of the application with the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trademarks and Service Marks.

2. The period of validity of a trademark registration may be renewed at the request of the owner filed within the final year of the period of validity, each time for another ten years.

Upon request of the owner for renewal of the registration of a trademark he may be granted a grace period of six months counted from the expiration date of the registration of the trademark, provided that the prescribed additional fee has been paid.

3. A record of renewal shall be entered in the Register and on the certificate of a trademark registration.

ARTICLE 17

RECORDAL OF CHANGES IN REGISTRATION

The owner of a trademark shall notify the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trademarks and Service Marks about any changes in the legal name, in his first or last name or patronymic, about supplement of the list of the goods, in respect of which the trademark has been registered, with similar goods or reduction of that list, about alteration of certain elements of the trademark that does not alter the substance of the trademark, about other changes concerning the registration of the trademark.

The record of a change shall be entered in the Register and on the certificate of registration.

ARTICLE 18

PUBLICATION OF INFORMATION ABOUT REGISTRATION

Information related to the registration of a trademark and 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 Trademarks and Service Marks in the Official Gazette within six months from the date of the registration of a trademark in the Register.

The publication of all subsequent changes in the information related to the registration of a trademark shall also be made.

ARTICLE 19

FEES

1. For filing of an application, conducting examination, registration and issuing of a certificate for a trademark, renewal of the registration and for all other activities of legal significance fees shall be charged. The list of actions for performance of which fees are charged, procedure, amounts and terms of payment, as well as the grounds for exemption from fees or for reduction of their amounts or refund of fees shall be established by the Cabinet of ministers of the Republic of Tajikistan.

2. The fees shall be paid by the applicant, owner of a trademark, or, in agreement with them, by another interested legal entity or natural person.

ARTICLE 20

CONDITIONS FOR RE-REGISTRATION

A trademark the duration of the registration of which has expired shall not be re-registered for three years from the date of termination of the registration of the trademark, in the name of a person other than the previous owner 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.

ARTICLE 21

REGISTRATION OF A TRADEMARK IN FOREIGN COUNTRIES

1. Legal entities, natural persons of the Republic of Tajikistan shall have the right, with the observance of the established procedure, to register a trademark in a foreign country or to obtain its international registration.

The application for international registration of a trademark shall be filed through the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trademarks and Service Marks.

2. The expenses relating to the registration of a trademark in a foreign country or to the international registration shall be born by the applicant or another interested legal entity or a natural person in agreement with the applicant.

CHAPTER 3
COLLECTIVE MARK

ARTICLE 22
RIGHT IN A COLLECTIVE MARK

1. A collective mark shall be a trademark of a union, association of manufacturers or traders, concern, or any other voluntary association of enterprises (hereinafter referred to as "association") intended to designate the goods, produced or distributed by them, possessing uniform qualitative or other common characteristics.
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 for a collective mark shall be accompanied by the Charter of the collective mark, which contains 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 the registration, a list of goods to be designated by the collective mark with description of their uniform qualitative or other common characteristics, conditions of its use, and the liability for violation of the Charter of the collective mark.
2. In the Register and on the certificate for a collective mark in addition to the information provided for in Article 15 of this Law there shall be entered the information about enterprises having the right to use the collective mark. This information and an extract from the Charter of the collective mark about uniform qualitative or other common characteristics of the goods in respect of which the collective mark has been registered shall be published by the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trademarks and Service Marks in the Official Gazette.

3. The owner of a collective mark shall notify the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trademarks and Service Marks about changes in the Charter of the collective mark.

4. In the case of use of a collective mark on the goods, not possessing uniform qualitative or other common characteristics, the registration of this mark may be invalidated prematurely in full or in part on the basis of the Court's decision made on request of an interested legal entity or natural person.

CHAPTER 4
USE OF A TRADEMARK

ARTICLE 24
USE OF A TRADEMARK AND CONSEQUENCES OF ITS NON-USE

1. By use of a trademark shall be considered its use on the goods in respect of which it has been registered or on packaging thereof by the owner of a trademark or a person to whom such right has been conferred under a license agreement in accordance with Article 27 of this Law.

By use may also be acknowledged the use of a trademark in advertising, printed publications, on signboards, on exhibits displayed at exhibitions and fairs organized in the Republic of Tajikistan, where there are valid reasons for non-use of the trademark on goods or packaging thereof.

2. Legal entities or natural persons engaged in commercial intermediation shall have the right to use their own trademarks along with that of the producer of goods or services, or instead of the trademark of the latter, on the basis of the agreement between them.

3. The registration of a trademark may be invalidated prematurely in whole or in part on the ground of the Court's decision made on a petition of an interested legal entity or natural person, in connection with non-use of the trademark for a continuous period of five years counted from the date of registration, or for a period of five years preceding the filing of such a petition.

On resolving the question of the premature invalidation of the registration of a trademark in connection with its non-use the proof presented by the owner of a trademark of the fact that the trademark was not used on the circumstances beyond his control may be taken into consideration.

ARTICLE 25

PREVENTIVE MARKING

The owner of a trademark can make, next to the trademark, a marking which indicates that the applied designation is a trademark registered in the Republic of Tajikistan.

CHAPTER 5

TRANSFER OF A TRADEMARK

ARTICLE 26

ASSIGNMENT OF A TRADEMARK

A trademark may be assigned by the owner of the trademark to a natural person or legal entity under an agreement in respect of all or part of the goods for which it has been registered.

Assignment of a trademark shall not be allowed if it can be a reason for deception of consumers in respect of the good or its manufacturer.

ARTICLE 27

GRANT OF A LICENSE FOR THE USE OF A TRADEMARK

The right to use a trademark may be granted by the owner of a trademark (the licensor) to another person (the licensee) under a license agreement.

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

ARTICLE 28

**REGISTRATION OF AN AGREEMENT ON THE ASSIGNMENT OF A
TRADEMARK AND LICENSING AGREEMENT**

An assignment agreement and a licensing agreement shall be registered in the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trademarks and Service Marks. Without this registration they shall be considered invalid.

CHAPTER 6
TERMINATION OF LEGAL PROTECTION
OF A TRADEMARK

ARTICLE 29
RECOGNITION OF THE REGISTRATION OF A TRADEMARK AS
INVALID

1. The registration of a trademark may be declared invalid in whole or in part at any time during the term of its duration if the trademark has been registered in violation of Articles 2 and 6 of this Law, or within five years of the date of publication of the information about the registration of a trademark in the Official Gazette on the grounds provided for in Article 7 of this Law.

Any legal entity or natural person may file, within the aforesaid period of time, an opposition against the registration of a trademark with the Appeal Board.

2. An opposition against a trademark registration shall be examined within six months from the date of its receipt. Both the person submitted the opposition and the owner of the trademark shall have the right to take part in its consideration.

3. The decision of the Appeal Board may be appealed juridically within six months of the date on which it has been made.

ARTICLE 30
CANCELLATION OF A TRADEMARK REGISTRATION

The registration of a trademark shall be cancelled by the State Service of the Republic of Tajikistan for Protection of Inventions and Registration of Trademarks and Service Marks:

- due to expiration of its term of validity as provided for in Article 16 of this Law;

- in the case of invalidation of the registration in accordance with Article 29 of this Law;
- on liquidation of the legal entity – the owner of the trade mark;
- on the decision of Court on its earlier cancellation on the ground of non-use of the trade mark in compliance with Article 24 of this Law;
- if the trademark owner abandons it.

CHAPTER 7
PROTECTION OF THE RIGHTS OF THE
OWNER OF A TRADEMARK

ARTICLE 31
BODIES CONSIDERING DISPUTES

Disputes connected with trademarks shall be considered by Court, except for the disputes attributed to the competence of the Appeal Board, in accordance with Articles 14 and 30 of this Law.

ARTICLE 32
RESPONSIBILITY FOR VIOLATION OF THE RIGHTS OF THE
OWNER OF A TRADEMARK

1. The use of a trade mark in violation of this Law, or the use of a designation similar to a trademark in respect to similar goods, or any other actions detrimental to its owner or to consumers shall entail civil responsibility in accordance with the current legislation.
2. A person illegally using a trademark, on demand of the owner of the trademark shall be obliged to stop its use and to compensate for the losses incurred.

CHAPTER 8
CONCLUDING PROVISIONS

ARTICLE 33
LEGISLATION OF THE REPUBLIC OF TAJIKISTAN ON
TRADEMARKS

The legislation on trademarks shall consist of this Law and other relevant legislative acts of the Republic of Tajikistan on questions related to its jurisdiction.

ARTICLE 34
RIGHTS OF FOREIGN LEGAL ENTITIES, FOREIGN CITIZENS AND
STATELESS PERSONS

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

ARTICLE 35
INTERNATIONAL AGREEMENTS

If international agreements of the Republic of Tajikistan establish rules different from those contained in this Law, the rules of the international agreement shall apply.

23.12.1991 г. № 456