

Peculiarities of Early Termination of the International Registration of a Trademark in the Territory of the Republic of Uzbekistan

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ANNOTATION

This article discusses the problems associated with early termination of the international registration of a trademark in the territory of the Republic of Uzbekistan, namely reveals the mechanism of proving and defending the position in the courts of the Republic of Uzbekistan. Shows judicial practice on early termination of international registration of a trademark.

KEYWORDS: trademark, early termination, methods of protection of rights, judicial practice, liability.

Today, in conditions of development of the market of commodity products one of the important tasks is to ensure legal protection of business entities for trademarks and service marks.

The need to protect the rights to a trademark is due to the increasing number of cases of its illegal use, the growth of counterfeit products, as well as the abuse of the exclusive right to a trademark.

In accordance with the legislation of the Republic of Uzbekistan, a trademark is a designation registered in the prescribed manner, which serves to distinguish goods and services of certain legal entities and individuals from similar goods of other legal entities and individuals.

There are different forms of trademarks, namely:

- verbal designation;
- graphic designation;
- combined designation;
- volumetric designation;
- Sound designation.

According to Article 1032 of the Civil Code of the Republic of Uzbekistan, legal protection of intellectual property begins from the moment of its creation, or from the moment of state registration in the manner prescribed by law.

In accordance with Article 4 of the Law of the Republic of Uzbekistan "On Trademarks, Service Marks and Appellations of Origin of Goods" dated 30.08.2001 №267-II, legal protection of the trademark is granted on the basis of its registration, as well as by virtue of international treaties of the Republic of Uzbekistan.

In this regard, the registration of a trademark is an indispensable way to protect it. By neglecting this procedure, legal entities and individual entrepreneurs can not take advantage

of the measures provided by law against unscrupulous persons who have registered their trademark in their name.

Thus the registration of trademarks is based on the International Classification of Goods and Services (ICSG). That is, identical or confusingly similar designations in different classes of the Nice Classification of Goods and Services can be registered completely without any competitive activity.

Article 1034 of the Civil Code of the Republic of Uzbekistan provides that the exclusive right to a trademark arises from the moment of its state registration by the authorized body in the field of intellectual property, namely, the Department of Intellectual Property under the Ministry of Justice of the Republic of Uzbekistan.

The term of validity of the certificate is 10 years from the date of registration of the trademark, upon the expiration of this term; the certificate may be renewed for every 10 years.

However, a sustained failure to use a trademark continuously for any three years may result in termination of protection of such mark. However, it is worth noting that the right to use a trademark is not at the same time an obligation. The fear of loss of protection of a mark is an incentive to exercise trademark rights and a measure to increase the effectiveness of the function performed by marks in order to minimize the number of "dead" or "dormant" trademarks for a clearer product orientation of the consumer.

In this regard, unfortunately, there are abuses of the exclusive right to a trademark, namely, by registering a trademark in a certain class of the Nice Classification and its non-use in a particular country. This, in turn, is an obstacle for other business entities to register a trademark similar to the degree of confusion with the trademark of the offender.

Legislation provides that, in the case of non-use of a trademark for more than three consecutive years, the rights to it may pass to other legal entities or individual entrepreneurs on an application for termination of the trademark certificate (Article 25 of the Law of the Republic of Uzbekistan "On Trademarks, Service Marks and Appellations of Origin of Goods"). The applicant in this case can be any interested person.

In accordance with Article 27 of the Law of the Republic of Uzbekistan "On Trademarks, Service Marks and Appellations of Origin of Goods" the use of a trademark is its application on goods for which the trademark is registered and (or) their packaging by the owner of the trademark or a person to whom such right is granted on the basis of a license agreement.

The use of a trademark may also be recognized as use:

1. in advertising, printed publications, on official letterheads, signboards, when displaying exhibits at exhibitions and fairs, on labels, packages of goods which are manufactured, offered for sale, sold or otherwise introduced into civil turnover or stored and (or) transported for this purpose, or imported into the territory of the Republic of Uzbekistan;
2. on documentation related to introduction of goods into civil turnover;
3. In the domain name.

However, the legislation does not provide for the effect of the presumption of guilt of the right holder. Thus, each person involved in the case must prove the circumstances that he

refers to as the basis for his claims and objections. That is, each party must prove either the use or non-use of the trademark.

Due to the lack of a certain mechanism for proving the non-use or use of a trademark for more than three years, creates a lot of judicial precedents.

For example, "WTM ESTABLISHMENT" Company is the owner of the exclusive right to the trademark "ROMANOV" (international registration date - 27.11.2013, registration number - 1193611)

In order to register this trademark on the territory of the Republic of Uzbekistan, "WTM ESTABLISHMENT" Company applied to the authorized body, Department of Intellectual Property under the Ministry of Justice of the Republic of Uzbekistan, with an application for registration of the trademark "ROMANOV" in the 33d class of the International Classification of Goods and Services (ICGS).

However, the Department of Intellectual Property under the Ministry of Justice of the Republic of Uzbekistan refused to register the trademark "ROMANOV" in the 33d class of the Nice Classification, because the trademark is phonetically similar to the trademark "ROMANOFF" (registration number № 1188271) owned by "F.LLI GANCIA & C.S.p.A." Company.

As a basis for refusal to register a trademark, paragraph 13 of Article 10 of the Law of the Republic of Uzbekistan "On Trademarks, Service Marks and Appellations of Origin of Goods" is indicated, according to which designations identical or similar to the extent of their confusion with trademarks previously registered or applied for registration in Uzbekistan are not registered as trademarks. To the Republic of Uzbekistan in the name of another person, as well as protected without registration by virtue of international treaties of the Republic of Uzbekistan or having an earlier priority in respect of homogeneous goods.

In this regard, on November 19, 2021, the "WTM ESTABLISHMENT" Company appealed to the Judicial Board for Economic Affairs of the Tashkent City Court with a claim for early termination of the international registration of the trademark "ROMANOFF" № 1188271 on the territory of the Republic of Uzbekistan.

As mentioned earlier, if a trademark is not used on the territory of the Republic of Uzbekistan without a valid reason continuously for the last three years, its registration may be canceled on the basis of a court decision at the request of any interested person.

Thus, the "WTM ESTABLISHMENT" Company was faced with the task of proving the non-use of the trademark belonging to the "F.LLI GANCIA & C.S.p.A" Company continuously for three years.

Due to the lack of a mechanism for proving the use or non-use of a trademark, using Article 27 of the Law of the Republic of Uzbekistan "On Trademarks, Service Marks and Appellations of Origin of Goods", the relevant requests were sent by the "WTM ESTABLISHMENT" Company to leading advertising organizations, the Customs Committee of the Republic of Uzbekistan, the Department of Intellectual Property of the Republic of Uzbekistan, as well as the Agency "Uzstandart" in order to obtain information about the use by the "F.LLI GANCIA & C.S.p.A." Company of the registered trademark.

According to the results of the analysis and receipt of appropriate responses to requests from

various organizations of the Republic of Uzbekistan, it became obvious that the company "F.LLI GANCIA & C.S.p.A" has not used a registered trademark for the past three years.

The court, having studied the evidence presented, as well as having listened to the opinion of the authorized body in the field of intellectual property, decided to satisfy the claims of the "WTM ESTABLISHMENT" Company, as well as the early termination of the international registration of the trademark "ROMANOFF" (No. 1188271) on the territory of the Republic of Uzbekistan in the 33rd class of the Nice Classification.

In addition, on June 20, 2019, the Appeal Board of the Ministry of Justice of the Republic of Uzbekistan considered the appeal of the Colgate-Palmolive Company on invalidation of certificate № MGU 16807 for the trademark "DentaGum Fresh Mint Whitening" in the 3d class of the Nice Classification registered in the name of the Private Enterprise "Dentafill Plyus".

The Colgate-Palmolive Company, which filed an appeal, claimed that certificate № MGU 16807 for the trademark "DentaGum Fresh Mint Whitening" was issued in violation of legal requirements, since the disputed trademark is false and capable of misleading the consumer about the product or its manufacturer.

The disputed trademark "DentaGum Fresh Mint Whitening" and the trademark of the Colgate-Palmolive Company opposed to it have a number of similar visual elements to the degree of confusion, such as the color scheme, visual elements (red chevron with irregular shape and thin horizontal lines), their location and style of writing.

The Appeals Board, having listened to the representatives of the persons who participated in the meeting of the Appeals Board, and having studied the case materials, determined to satisfy the applicant's claims on the following grounds.

As mentioned earlier, the legal framework for a trademark includes the Law of the Republic of Uzbekistan "On Trademarks, Service Marks and Appellations of Origin of Goods" and the Rules for Drafting, Filing and Reviewing an application for Registration of a trademark and Service Mark (Registration № 1988 dated 29.07.2009)

The Colgate-Palmolive Company is engaged in the production and distribution of cosmetic care products, personal hygiene and household chemicals under world-famous brands. The company has a number of national trademark registrations for "Colgate" products, including those involving the appearance of toothpaste packaging. Trademarks for "Colgate" products have been registered in the Republic of Uzbekistan since 1994 (registration number 488).

The corporate identity of the appearance of the packaging of Colgate products consists of a composition of a red chevron (substrate), the Colgate name (with white letters), occupying up to 2/3 of the front part of the package. The rest of the appearance of the package is made in various colors and contains the name of the toothpaste variant using various visual and verbal elements. These elements are similar to the disputed trademark "DentaGum Fresh Bleaching Mint" according to certificate № MGU 16807 registered in the State Register of Trademarks on 25.06.2008 with priority from 16.08.2007 in the name of the Private Enterprise "Dentafill Plyus" in the 3d class of the Nice Classification.

According to paragraph 9 of the first part of Article 10 of the Law of the Republic of Uzbekistan "On Trademarks, Service Marks and Appellations of origin of goods", false designations or designations capable of misleading the consumer regarding the goods or their

manufacturer are not registered as trademarks.

A graphical analysis of the compared trademarks showed that the disputed trademark "DentaGum Fresh Mint Whitening" bears similar elements such as a red background (chevron), the presence and location of the verbal designation "DentaGum" in white, bold in a tilt, the location of verbal and pictorial elements.

In accordance with paragraph 108 of the Rules for Drawing up, Filing and Reviewing an Application for Registration of a Trademark and Service Mark, graphic similarity is determined on the basis of the following features:

- general visual impression;
- type of font;
- graphic spelling taking into account the nature of letters (printed or written, uppercase or lowercase);
- the location of letters relative to each other;
- alphabet, the letters of which the word is written;
- Color or color combination.

In accordance with paragraph 4 of the Rules, designations that are false or capable of misleading the consumer about the product or its manufacturer are not registered as trademarks. Such designations include, in particular, designations that generate in the consumer's mind an idea about a certain quality of the product, its manufacturer or place of origin, which does not correspond to reality. A trademark is recognized as false or misleading if at least one of its elements is false or misleading.

Based on the graphical analysis of trademarks, the Appeals Board came to the conclusion that the trademark "DentaGum Fresh Mint Whitening" was registered in violation of the requirements of the law.

Based on the above, it is obvious that there is no clear mechanism in the legislation of the Republic of Uzbekistan for the early termination of the international registration of a trademark on the territory of the Republic of Uzbekistan or the recognition of a trademark as invalid. In this regard, each party is obliged to provide evidence of non-use or use of a trademark by contacting the state bodies of the Republic of Uzbekistan, or to make an appropriate examination on the basis of which, the court makes a decision to satisfy or refuse to satisfy the applicant's claims.

LIST OF USED LITERATURE

(guidance literature, regulatory materials, basic textbooks and teaching aids, electronic educational resources)

1. Regulatory materials:

- 1.1. Constitution of the Republic of Uzbekistan: Official edition. Ministry of Justice of the Republic of Uzbekistan. – T: «Adolat», 2017;
- 1.2. Civil Code of the Republic of Uzbekistan: Official edition. Ministry of Justice of the Republic of Uzbekistan. – T.: «Adolat», 2018;

- 1.3. Law of the Republic of Uzbekistan "On Trademarks, Service Marks and Appellations of Origin of Goods" dated 30.08.2001 № 267-II.;
- 1.4. Rules for compiling, filing and examining applications for registration of trademarks and service marks of July 29, 2009, Reg. № 1988.

2. Special literature

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3. Electronic educational resources

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- 3.3. <http://www.mktu.info/>
- 3.4. https://modern_law.academic.ru