

Newsletter

New system for registration of EAEU trademarks and appellations of origin

March 13, 2020

Dear Ladies and Gentlemen,

We would like to inform you that on February 3, 2020, the Agreement on trademarks, service marks and appellations of origin of the Eurasian Economic Union ("**Agreement**") was signed in Moscow. The Agreement was signed by all Eurasian Economic Union ("**EAEU**") member states: Armenia, Belarus, Kazakhstan, Kyrgyzstan, Russia.

The Agreement introduces a new system for the registration of EAEU trademarks ("**Trademark of the Union**") and EAEU appellations of origin ("**AO of the Union**"). Instead of registering a Trademark and AO separately in each EAEU member state, the Agreement provides an opportunity to register means of individualization in any of the EAEU member states and receive a unified protection certificate.

The entry into force of the Agreement is made dependent on all the EAEU member states bringing the established registration procedures and fees in accordance with the Agreement. The new registration system is expected to be operational by the end of 2020.

Key provisions

- **Trademark registration procedure**

To register the Trademark of the Union, it is required to submit **one application** to **any** of the EAEU member states' intellectual property office. At the same time, the applicant does not select the list of EAEU member states in which legal protection is sought, since the application for the Trademark of the Union is considered by all national intellectual property offices at the same time.

It is possible to **convert** a national trademark application into an application for the Trademark of the Union, and vice versa, if the requirements for convention priority are met.

At the request of the right holder, it is possible to **replace** the trademark registration in each EAEU member state with the Trademark of the Union.

The registration period for Trademark of the Union will be from **8 months** and can be extended, depending on the intellectual property offices' need to request additional documents and information.

- **Requirements for the designation to be registered**

Only designations that can be represented in **graphical** form can be registered as a Trademark of the Union.

The designation must meet the eligibility criteria in **each** of the EAEU member states. If the designation cannot be registered as a trademark in one of the member states, the designation is not subject to registration as Trademark of the Union.

- **Disposal of the exclusive rights to the Trademark of the Union**

The right holder of the Trademark of the Union has the right to dispose of exclusive rights in accordance with the laws of the member states, which includes alienation, licensing rights to use, conclusion of franchising agreement or pledge of the exclusive rights to the Trademark of the Union. Such disposal of rights is subject to **mandatory registration with the filing intellectual property office**.

- **Challenging registration and early termination of the Trademark of the Union**

Any interested parties have the right to submit a **request about the existence of grounds for refusing registration** within 3 months from the date of publication of the application.

It is possible to challenge the legal protection of an already registered Trademark of the Union by

submitting an objection to the national intellectual property office of any member state of the EAEU.

Early termination of the Trademark of the Union is possible if the right holder does not use it for 3 years in all member states of the EAEU.

- **Registration of the Trademark of the Union**

Prior to the entry into force of the Agreement, the EAEU member states will exchange lists of AOs registered in each EAEU member state.

Applicants from EAEU member states apply to the national intellectual property office for registration of AO, while applicants from non-EAEU member states are entitled to apply to any office.

- **Amount of fees**

The amount of fees will be fixed for all EAEU member states and established by the decision of the Council of the Eurasian Economic Commission (EEC).

- **Term of the rights to Trademark and AO of the Union**

The term of the rights to the Trademark of the Union is 10 years from the date of filing an application with the right of extension for an unlimited number of times.

The term of the rights to the AO of the Union is also 10 years from the date of filing an application with the possibility of extension, if the conditions for the protection of the AO are preserved.

Findings and recommendations

- Registration of the Trademark and AO of the Union may be a priority for companies doing their business in all or the most of the EAEU member countries, as well as for interested right holders who are faced with the problem of counterfeit and parallel import.
- The registration system of trademark and AO in the EAEU corresponds to the provisions on the unified customs register of intellectual property in the EAEU and will simplify the procedure for including company trademarks in the EAEU unified customs register.
- Registration of the Trademark and the AO of the Union will protect the rights to intellectual property in the EAEU, both in national law enforcement bodies and in the Eurasian Economic Commission (e.g., if there are signs of unfair competition).

We hope that the information provided herein will be useful for you. If any of your colleagues would also like to receive our newsletters, please let us know by sending us his/her email address in response to this message. If you would like to learn more about our **Intellectual Property Practice**, please let us know in reply to this email. We will be glad to provide you with our materials.

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If you have any questions, please, do not hesitate to contact ALRUD partner



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Sincerely,
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