

Registration of Intellectual Property Rights in the Customs Register of Ukraine

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1. Weekly update of the register of IPR objects in Ukraine

On 16 November 2020, an updated register of intellectual property rights (hereinafter – IPR) was published on the Unified State Information Web Portal "Single Window for International Trade". The weekly update of the register was another step in the implementation of customs legislation reform in the field of intellectual property rights protection.

The reforms are intended to bring the provisions of Ukraine's customs legislation in line with EU standards and practices. They will help to increase the level of prevention of and counteraction to the goods' transfer that violates intellectual property rights across the customs border of Ukraine, and, as a consequence, to purify the domestic market from pirated and counterfeit products.

2. Submission of an application for registration of IPR

To register an IPR object in the customs register, the applicant submits a written application to the State Customs Service of Ukraine for registration of an IPR object in the customs register or sends its scanned copy by electronic means. An application can also be submitted in electronic form using information and telecommunication systems of the State Customs Service. It should be noted that, as of today, the application may include several objects of intellectual property rights at the same time.

The following documents shall be attached to the application for registration of an IPR object in the customs register:

- a copy of the copyright protection registration in Ukraine or international registration of IPR;

- power of attorney (or its duly certified copy) – if the application is submitted by an authorized representative of the right holder;
- description and photographic image of the IPR object;
- description of the identification method of the IPR object presence – in case the applicant submits an invention, industrial design, plant variety, or design of semiconductor products for registration in the customs register;
- photographic image of goods suspected of violating IPR, counterfeit, pirated goods, etc. (if available) or samples of such goods (optional);
- copies of documents based on which the producer of the goods uses an IPR object – if the right holder is a resident of Ukraine and the producer of the goods is a non-resident located outside Ukraine.

In case of submission of a written application for registration of an IPR object in the customs register of Ukraine, such an application shall be submitted in two copies (a copy for the customs authority and a copy for the right holder). It should be noted that correspondence received by the customs authorities of Ukraine in foreign languages is given for translation or annotation according to the register. Not later than in 3 days these documents, with the translation (annotation) attached, are returned to the clerical service for registration and further processing. After registration, a written application or its scanned copy sent by electronic means shall be submitted to the State Customs Service for processing no later than the next working day.

If the application is submitted in electronic form with electronic (scanned) copies of such applications and documents using information and telecommunication systems of the State Customs Service, the application and documents shall be certified by affixing an authorized electronic signature of the applicant. If an event of incorrect filling in the column of the application's electronic form is revealed, the applicant shall be automatically informed by a message about the error and the procedure for its correction. Once the electronic application has been registered, a notification is sent to the applicant with the registration date and number.

3. Processing of the application for registration of IPR objects

Processing of the application for registration of IPR objects provides for the following:

- verification of the applicant's legal authority for filing an application and the required scope of rights to the IPR object;
- checking the compliance with the procedure for filling in the application columns, availability of necessary documents;
- checking the availability of all application's copies, electronic (scanned) copies of such application and the documents attached thereto;
- verification of the information specified in the application and/or submitted document;
- checking the presence of characteristic (typical) features of goods that can be identified by the customs authorities of Ukraine;
- assessment of the possibility of identifying IPR object in the product.

While processing the application, the State Customs Service of Ukraine may send requests related to the submitted documents:

- to the body, enterprise, institution, organization that issued such a document – on its inspection or provision of additional information. In this case, the processing term of such application shall not be extended;
- to the applicant – indicating the documents and/or information that needs to be provided, corrected, or updated. The applicant shall respond to the request within ten working days from the date of its receipt (the receipt date is considered the day of sending the request by e-mail or e-message). In this case, the term for the application processing shall be extended for the period from the date of sending such a request to the applicant until the date of receipt of a response thereto.

The term for the application processing is 30 working days from the date of the application registration. During this term, the IPR object is either registered or rejected from registration in the customs register of Ukraine.

The State Customs Service of Ukraine shall notify the applicant of the IPR object registration in the customs register no later than the next working day from the date of completion of the IPR object registration in the customs register, indicating the date of the IPR object registration, its serial number in the customs register and the term of the IPR object registration.

The IPR object registration in the customs register of Ukraine is rejected in the following cases:

- the right holder does not have the legal authority and/or the necessary scope of rights to submit an application;
- non-compliance with the application form for an IPR object registration in the customs register;
- revealing of inaccurate and/or incomplete information in the application and attached documents;
- failure to provide the necessary documents and/or information, including in response to a request from the State Customs Service of Ukraine;
- impossibility to identify the IPR object presence in the goods by the methods proposed by the applicant;
- lack of characteristic (typical) features of original goods that can be identified;
- non-conformity of goods containing the trademark with the classes of goods according to the International Classification;
- existence of unreimbursed costs related to the storage of goods with delayed customs clearance.

In case of rejection, the State Customs Service of Ukraine notifies the applicant in writing (in paper or electronic document) with a reasoned justification of the cause for such rejection or registration of an incomplete list of IPR objects submitted in one application for IPR object registration in the customs register of Ukraine.

4. Taking actions to ensure the protection of IPR

After registration of the object of intellectual property rights in the customs register of IPR objects, the customs authorities of Ukraine shall

take actions to ensure the protection of IPR based on such register's data. In particular, in case of revealing the goods suspected of violating the IPR, the goods customs clearance is delayed based on the customs register. Delay of goods customs clearance (except for perishable goods) may also occur at the initiative of the customs authority of Ukraine.

The head of the customs authority or his/her deputy shall decide to delay goods customs clearance for a period of up to ten working days and, if necessary, to extend this period by no more than ten working days. The delay period for perishable goods is three working days without any extension. The right holder and the declarant are notified of the delay on the day of the relevant decision.

By responding to the notification, the right holder confirms or does not confirm the conclusion of the customs authority that the goods are charged with violating IPR, or reports that the goods are original, and notifies of his/her intention or lack of intention to take cooperation actions or gives consent to renewal of their customs clearance. Whereas, the declarant sends the objection or the consent of the goods' owner to the destruction of the goods (the absence of objections constitutes consent).

Based on the right holder's and the declarant's answers, destruction of goods with delayed customs clearance may be carried out on charges of violating the IPR. In case of agreement between the right holder and the owner of the goods, there is also a possibility of preterm release of goods with delayed customs clearance on charges of violating the IPR. It is allowed to change the identification marks or markings on the goods or their packaging in the process of customs clearance to eliminate the signs of violation of intellectual property rights, provided that such actions are agreed with the right holder or done at their request.

It should be emphasized that the reimbursement of costs associated with the storage, as well as the destruction of goods with delayed customs clearance on charges of violating the IPR, is carried out at the expense of the right holder.

It is worth noting that actions to ensure the protection of IPR do not apply to original goods. That means that violations arising from the so-called illegal concurrent trade and exceeding the stipulated production volumes are excluded from the scope of regulation of the Customs Code of Ukraine.