



## **METHODS OF PROTECTING INTELLECTUAL PROPERTY IN UZBEKISTAN: TRADEMARK AND LEGAL BASIS FOR ITS USE**

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<b>A B S T R A C T</b>	<b>KEY WORDS</b>
This article analyzes the methods of protecting intellectual property in Uzbekistan. In particular, it provides information on the registration and protection of trademarks in Uzbekistan, an analysis of regulatory legal acts regulating the field of intellectual property, and the existing practice. Specific features and terms of trademark registration are one of the most pressing issues discussed in this article. It also describes the legislative problems related to the topic under discussion and the author's proposals for solutions to these problems.	Trademark, intellectual property rights, patent, WIPO, Madrid system, bad faith.

### **Introduction**

Trademarks help identify new product variations. They can become linked to positive public recognition and perception, which maintains the benefits of a distinct market position. Positive public perception is especially crucial for companies in service industries, where production tends to have more experiential qualities compared to manufacturing, and for companies that innovate with products that are differentiated by quality. The product-differentiating impact of trademarks in services applies to companies with new-to-market innovations, but not to those without product innovation. This indicates that trademarks help capture the financial benefits from product innovation in services. For service sector companies with imitative innovations, trademarks (also known as servicemarks) also have a service-differentiating effect, likely due to the variety of service options. Also, for firms in manufacturing industries, trademarks do have a clear impact on product differentiation.

Over 4,000 years have passed since the invention of trademarks. Originally, they were meant to identify the artisans who created a piece in the Middle Ages, holding them accountable for any flaws discovered. Scholars have discovered numerous ways that consumers and manufacturers have utilized these markings over time. Fundamentally, they were used by merchants to indicate ownership of commodities, much way ranchers use branding to identify ownership of cattle. These markings helped owners claim objects that might be lost during transit, which was especially helpful. When products

were recovered from the sea, for example, producers used these marks to demonstrate ownership.<sup>1</sup> *Southern v. How*<sup>2</sup> (1618) is considered as the first reported trademark case in the common law system. The Law of the Republic of Uzbekistan on Trademarks, Service Marks, and Appellations of Origin states that officially registered signs that distinguish one person's or business's goods and services from another are known as trademarks and service marks.

Both individual and collective trademarks are possible. A single person or business owns an individual trademark. Conversely, a collective trademark is used to identify products manufactured or marketed by a collection of companies or persons who all have comparable features.

Images, words, shapes, and other kinds of signals are only a few examples of trademarks. Any combination of colors and scent can also be used to register these.

Once a trademark is registered in accordance with this law's regulations and the international agreements of which Uzbekistan is a party, it is legally protected. An application must be submitted for just one trademark or appellation of origin at a time in order to register a trademark or get the right to use an appellation of origin.

The application should include the following:

1. A request to register a sign, an appellation of origin, or the right to use an appellation of origin as a trademark.
2. A detailed description of the sign you want to register.
3. A list of the goods you want to register the trademark for, organized according to the International Classification of Goods and Services.
4. A description of the goods for which you're seeking an appellation of origin or the right to use it, including where the goods are made and what makes them special.

Along with the application, the following documents must be included:

- A receipt confirming the payment of the patent fee for filing the application.
- A power of attorney from the applicant if the application is being submitted through a patent attorney.
- Documents proving that the applicant is based in the specified geographical area and produces goods whose unique characteristics are linked to the natural conditions or other factors of that area, or a combination of both for an appellation of origin.
- A document confirming the foreign applicant's right to use the appellation of origin for the goods listed in the application in the country where the goods originate.

Guidelines for the documentation needed to register a trademark, an appellation of origin, or the right to use an appellation of origin are established by the Department of Intellectual Property, which is part of the Ministry of Justice of the Republic of Uzbekistan.

This law also outlines the types of trademarks that cannot be registered, including:

1. Signs that feature state emblems, flags, or state awards.
2. Official names of countries, or the full or abbreviated names of international or intergovernmental organizations.
3. Official marks of control, guarantees, or sample stamps and seals.

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<sup>1</sup> Owners also carved identifying marks into the beaks of swans they were allowed to own by royal privilege. See FRANK I. SCHECHTER, *THE HISTORICAL FOUNDATIONS OF THE LAW RELATING TO TRADE-MARKS* 35-37 pages (1925)

<sup>2</sup> Theoretical grounds for the provision of trademark protection, Mohammad Alfaouri and Fahed Wahdani, *SEA – Practical application of science* Volume VIII, Issue 22, 77 p (1/2020)

4. Images of official distinguishing signs used by state services in Uzbekistan.
5. Signs that lack distinctiveness.
6. Signs commonly used to represent certain types of goods.
7. Widely recognized symbols or terms.
8. Signs that simply describe the goods, such as their type, quality, quantity, features, intended use, value, or their place and time of production or transfer.
9. Signs that are misleading or false, which could confuse consumers about the goods or their manufacturer.
10. Signs that falsely suggest goods come from a different place than they actually do, even if they are meant to indicate the true place of origin.
11. Geographical names that refer to the origin of certain products like mineral waters, wines, or spirits, or that are used for goods not made in that location, including those with added terms like "in appearance," "in style," or similar expressions.
12. Signs that go against societal interests, humanity, or moral standards.
- 13) the following signs:

The law also prohibits the registration of trademarks that are:

identical or strikingly similar to trademarks that have already been applied for or registered by another party in Uzbekistan. This also includes trademarks that have an earlier precedence for comparable goods or those protected by international treaties of which Uzbekistan is a party;

comparable or identical to well-known trademarks accepted by the established process, with regard to any products;

identical or strikingly similar to trademarks that are legally protected geographical indications or designations of origin, unless such signs are a component of a trademark that has been registered by a person with the authority to use those indications or designations for goods;

identical to certification marks that have been correctly registered in accordance with the authorized procedure, or confusingly similar;

14) the following marks:

The law also prohibits the registration of trademarks that:

- reproduce company names (or parts of them) that are well-known in Uzbekistan, if the right to that name was acquired before the trademark application for a similar type of goods;
- reproduce industrial designs that are already owned by someone else in Uzbekistan;
- reproduce the names of scientific, literary, or artistic works, their characters or phrases, works of art, or their images that are popular in Uzbekistan, without the consent of the copyright holder or their legal heirs;
- signs that reproduce the surnames, names, pseudonyms and words derived from them, portraits and signatures of such people, provided that these are historical and cultural assets of the Republic of Uzbekistan, without the consent of these people, their heirs or a state body<sup>3</sup>.

The World Intellectual Property Organization, or WIPO, is essential to the regulation and defense of intellectual property worldwide. A uniform framework for protecting intellectual property worldwide is created when WIPO agreements are incorporated into national laws.

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<sup>3</sup> Law of the Republic of Uzbekistan "On Trademarks, Service Marks and Appellations of Origin", August 30, 2001, No. 267-II

The Madrid System is one of the primary resources provided by WIPO that facilitates trademark protection on a global scale. Through this approach, people and companies can submit a single trademark application and utilize it to apply for protection in several participating nations.

The Madrid Protocol of 1989 and the Madrid Agreement of 1891 serve as the foundation for the Madrid System. It simplifies the process of registering and maintaining trademarks in up to 130 countries, with one application and one set of fees. It also makes it easier to update, renew, or expand trademark protection internationally. However, applicants must first register their trademark with the intellectual property office of a Madrid System member country before applying for international protection.

The Madrid System is important for several reasons:

➤ **Global Reach:** It allows businesses to protect their trademarks in multiple countries by filing a single application;

➤ **Cost-Effective:** Instead of filing individual trademark applications in each country, the Madrid System enables applicants to file one international application, reducing costs and administrative burdens;

➤ **Centralized Management:** The system provides a single point of contact for managing trademarks globally. Applicants can make changes, renew registrations, or expand protection across different countries through one centralized system;

➤ **Efficiency and Simplicity:** The Madrid System streamlines the process of trademark registration by eliminating the need to navigate different legal requirements and languages in each country. This makes it easier for businesses to manage their global trademark portfolio;

➤ **Legal Protection:** It offers a straightforward way to secure legal protection in multiple markets, which is crucial for businesses that operate in multiple countries and want to safeguard their brands from unauthorized use or infringement;

➤ **Flexibility:** The system allows businesses to expand their trademark protection as they enter new markets or modify their existing trademark rights as their business evolves.

Overall, the Madrid System simplifies the global trademark registration process, making it easier for businesses to protect their intellectual property worldwide.

Uzbekistan, as a member state of this system, has also created national programs for the protection of intellectual property, in particular trademarks. Ministry of Justice of the Republic of Uzbekistan organize the registration, protection and legal use of trademarks. There are also several regulatory legal acts regulating this area, including the Law on trademarks, service marks and appellations of origin, the Civil Code, the Administrative Regulations for the Provision of State Services for the Registration of Trademarks and Service Marks, approved by the Cabinet of Ministers, and the Presidential Decree on Additional Measures for the Further Development of the Intellectual Property Sector.

A trademark must be registered with the appropriate authorized state entity in order to be legally protected. Individuals or business entities may apply for trademark registration in person, through a

patent attorney registered with the Ministry of Justice of the Republic of Uzbekistan (for foreign entities), or both. Generally speaking, a trademark's priority is established by the day that the Ministry of Justice receives a properly filed application. Based on the findings of the stipulated examination of the application and the sign included in the application, a decision about the trademark's registration or rejection is taken.

In accordance with trademark registration requirements, trademarks must be registered in the Republic of Uzbekistan. The picture of the trademark, the owner's details, the priority date, the registration date, and the list of items the trademark is applicable to are all included in the registration certificate. Official bulletin then publishes this information.

Once a trademark is registered, it becomes legally protected, and a registration certificate attests to the brand's ownership. Both individuals and business entities may register trademarks under their names. It's crucial to remember that each application for the registration of a trademark, appellation of origin, or the authorization to use an appellation of origin must only be for one of these items.

In Uzbekistan, a trademark's use rights may be transferred to another party if it is not used for three years following registration. Furthermore, if a third party applies for a trademark and wishes to utilize it, the trademark certificate may be withdrawn. A court ruling may also result in the early cancellation of a trademark certificate, either in full or in part. This may occur if a collective mark agreement has been broken or if the trademark has not been utilized consistently for the previous three years.

The use of a trademark on goods it's registered for, or on their packaging and containers, by the trademark owner or someone authorized through a licensing agreement, counts as valid use of the trademark.

Advertising, printed materials, official forms, brochures, displays at exhibitions and fairs, labels, packaging of goods being made, marketed, or distributed, and even the transportation or importation of goods into Uzbekistan are all examples of trademark use under Uzbek law. Any paperwork pertaining to the market distribution of goods is also included. It may also be considered legitimate trademark usage to utilize the trademark in a domain name.

For 10 years following the date of application filing, a trademark certificate or a certificate of right to use an appellation of origin will be valid. The owner of a trademark certificate or a certificate granting the right to use an appellation of origin may request an extension of the certificate's validity for an additional 10 years during the final year of the certificate's validity.

Also, by a special decree of the President of the Republic of Uzbekistan, trademarks belonging to famous foreign brands were canceled from the state register, and in case of "bad faith" use, the practice of withdrawing the right to the trademark from them was introduced.

There are several issues related to trademarks in Uzbekistan. These include the following:

- **Unauthorized use of trademarks:** In some cases, companies or individuals use the trademarks of other businesses or brands without permission. This can lead to brand infringement, false advertising, and consumer deception.
- **Trademark registration process:** There are some issues with the trademark registration process, as it is often complex and time-consuming. This can have a negative impact on small and medium-sized businesses.

• **Trademark protection:** Some companies in Uzbekistan face difficulties in protecting their trademarks because the legal framework in this area lacks clear and prompt procedures. There are problems preventing the unauthorized use or copying of trademarks.

• **International trademark protection:** Issues have arisen regarding the protection of trademarks at the international level, as Uzbekistan is not fully integrated into international systems or certain laws in this area have not been developed.

• **Lack of legal knowledge regarding trademarks:** Many businesses and entrepreneurs may lack knowledge of legal documents and regulations related to trademarks, which can expose them to unknown risks.

All of these factors make the effective use and protection of trademarks more challenging.

To improve the trademark registration system in Uzbekistan, the following measures can be taken:

**Simplifying the registration process:** The trademark registration process needs to be expedited and simplified. This could involve digitizing and automating the preparation of documents, reviewing applications, and the approval process.

**Ensuring transparency of the system:** It is important to increase transparency in the trademark registration process. All stages of the process should be open and understandable, which will help entrepreneurs better understand their rights and obligations.

**Improving legislation:** The legislation related to trademarks should be modernized and aligned with international practices. Clear and consistent rules for trademarks, their protection, and the registration process need to be developed.

**Providing training and seminars for entrepreneurs and legal professionals:** Special training programs, seminars, and courses should be held to increase legal knowledge about trademarks for entrepreneurs, lawyers, and legal experts. This will help them understand the laws and legal standards and also learn more about the advantages of trademark registration.

**Strengthening international cooperation:** Uzbekistan should join international systems and facilitate the recognition of trademarks with other countries. It is necessary to strengthen cooperation with relevant organizations to develop international law and ensure global trademark protection.

**Speeding up the examination of trademark applications:** The process of reviewing and registering trademarks should be accelerated, which would save entrepreneurs' time and support their business activities.

Implementing these measures will improve the trademark registration system in Uzbekistan, reduce legal issues, and support economic activity.



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