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**BASIC PRINCIPLES OF CIVIL LAW REGULATION
OF A TRADEMARK (BRAND) IN UKRAINE**

**ОСНОВНІ ЗАСАДИ ЦИВІЛЬНО-ПРАВОВОГО РЕГУЛЮВАННЯ
ТОРГОВОЇ МАРКИ (БРЕНДУ) В УКРАЇНІ**

The relevance of the topic is that currently a lot of attention is paid to problems of intellectual property legal protection. Stimulation of intellectual property development and protection is gradually becoming one of the most important factors of political and economic relations along with economic safety within the country and in the structure of interstate relations. According to Ukrainian Constitution which guarantees every citizen freedom of artistic, scientific and technical activity performance our independent state consistently establishes its own mechanisms to protect intellectual property, copyright, moral and material interests arising in connection with different types of intellectual property.

In the context of market relations development and globalization of international trade space competition between the business entities selling its goods and services is getting more tense. Effective involvement of intellectual property rights prior to distribution stage allows the business entity to increase the cost of its assets and its investment attractiveness in the market. That is why proper exercise of intellectual property rights for trademarks is considered by the global community to be an integral element of economy successful development, important factor of product competitiveness increasing, minimization of unfair competition, therefore elimination of deficiencies in legal regulation of trademark use in commercial stream is one of the tasks of legislators specializing in trademark legal protection. Article presents analysis and study of problems arising in the course of trademark legal regulation in Ukraine.

Authors analyze regulatory framework of intellectual property institute. Peculiar aspects of legal protection of trademark owner's rights are revealed along with identification of means to assess the situation and formulate efficient ways and mechanisms of protection. It is concluded that recently trademark has become one of the most important factors shaping the development of business environment in Ukraine and defining the level of product competitiveness.

Therefore reliable and efficient system of trademark protection must be presented. Applicable Ukrainian legislation establishes various means of trademark owner's rights protection – that is why it is very important to carry out correct the analysis of the situation properly and identify the most suitable and effective protection mechanisms. More attention must be paid to improvement of interaction between state bodies and business entities involved in intellectual activity and ensure proper implementation of international regulations in Ukrainian legislative framework.

Key words: *intellectual property, intellectual property objects, trademark, legal nature of trademark, legal protection of trademark.*

Актуальність статті полягає у тому, що нині велика увага приділяється проблемам правового захисту інтелектуальної власності. Стимулювання розвитку та захисту інтелектуальної власності поступово стають одними з найважливіших факторів політичних та економічних відносин поряд із економічною безпекою всередині країни та у структурі міждержавних відносин. Відповідно до Конституції України, яка гарантує кожному громадянину свободу здійснення мистецької, наукової та технічної діяльності, наша незалежна держава послідовно встановлює власні механізми захисту інтелектуальної власності, авторських прав, моральних та матеріальних інтересів, які виникають у зв'язку з різними видами інтелектуальної власності.

В умовах розвитку ринкових відносин і глобалізації міжнародного торгового простору конкуренція між суб'єктами господарювання, які продають товари та послуги, стає все більш напруженою. Ефективне залучення прав інтелектуальної власності до етапу розподілу дозволяє суб'єкту господарювання збільшити вартість своїх активів та власну інвестиційну привабливість на ринку. Ось чому належне здійснення прав інтелектуальної власності на товарні знаки вважається світовим співтовариством невід'ємним елементом успішного розвитку економіки, важливим фактором підвищення конкурентоспроможності товарів, мінімізацією недоброросівної конкуренції, тому усунення недоліків у правовому регулюванні використання торговельних марок у комерційний потік – одне із завдань законодавців, які спеціалізуються на правовій охороні товарних знаків.

У статті здійснено аналіз та досліджено проблеми, які виникають при правовому регулюванні торгівельної марки в Україні. Автором проаналізовано законодавчу базу Інституту інтелектуальної власності. Розкрито окремі аспекти правових способів захисту прав володільця торгівельної марки, а також визначено шляхи аналізу ситуації, найбільш оптимальні способи й дієві механізми захисту.

Зроблено висновок, що останнім часом торгова марка стала одним із найважливіших факторів, які формують розвиток ділового середовища в Україні та визначають рівень конкурентоспроможності товару. Тому повинна бути представлена надійна та ефективна система захисту товарних знаків. Застосовуване українське законодавство встановлює різні засоби захисту прав власника торгової марки, саме тому важливо правильно провести аналіз ситуації та визначити найбільш підходящі та ефективні механізми захисту. Потрібно приділити більше уваги вдосконаленню взаємодії між державними органами та суб'єктами підприємницької діяльності, які займаються інтелектуальною діяльністю, та забезпечити належне впровадження міжнародних норм в українську законодавчу базу.

Ключові слова: інтелектуальна власність, об'єкти інтелектуальної власності, торгівельна марка, правова природа торгівельної марки, правова охорона торгівельної марки.

Problem statement. Currently a lot of attention is paid to problems of intellectual property legal protection. Stimulation of intellectual property development and protection is gradually becoming one of the most important factors of political and economic relations along with economic safety within the country and in the structure of interstate relations. According to Ukrainian Constitution which guarantees every citizen freedom of artistic, scientific and technical activity performance our independent state consistently establishes its own mechanisms to protect intellectual property, copyright, moral and material interests arising in connection with different types of intellectual property. In the context of market relations development and globalization of international trade space competition between the business entities selling its goods and services is getting more tense.

Effective involvement of intellectual property rights prior to distribution stage allows the business entity to increase the cost of its assets and its investment attractiveness in the market. That is why proper exercise of intellectual property rights for trademarks is considered by the global community to be an integral element of economy successful development, important factor of product competitiveness increasing, minimization of unfair competition, therefore elimination of deficiencies in legal regulation of trademark use in commercial stream is one of the tasks of legislators specializing in trademark legal protection.

Current research state. Theoretical background of presented research includes publications by Y. Boshitsky, V. Butkevych, O. Dzera, A. Dmytriiev, O. Zadorozhny, N. Zelinska, O. Kokhanovska, O. Serheiev, I. Spasibo-Fatieieva, H. Shershnevych, O. Shtefan, O. Yuldashev, V. Yarotsky etc. Despite the substantial amount of publications related to the abovementioned problem, certain aspects require further study which is the aim of this article.

It is reasonable to start the research of legal regulation of intellectual property relations with the Civil Code of Ukraine – the majority of its norms concerning the mentioned issues is contained in Volume 4 “Intellectual property rights”. Volume IV of the Civil Code of Ukraine presents maximum approximation of system of intellectual property protection to the world standards with proper consideration of both Ukrainian and foreign law enforcement practices. This part contains general provisions, basic norms and standards of copyright, related rights, intellectual property rights (scientific discovery, invention, utility model, industrial prototype, efficiency proposal, integrated chip composition, plant variety, animal breed, trademark (goods and service logo), geographical indication and commercial secret).

Civil Code of Ukraine presents a list of intellectual property objects which is not exhaustive with new results of creative activity incorporated constantly. The abovementioned relations are regulated by the following laws: “On copyright and related rights”, “On protection of rights on trademarks (goods and services)”, “On protection of rights on industrial prototypes”, “On protection of rights on inventions and utility models”, “On protection of rights on goods’ origin indication”, “On protection of rights on plant varieties”, “On protection of rights on integrated chips topography”.

Norms on regulation of intellectual property relations are also contained in other laws, e.g. laws of Ukraine “On distribution of copies of audiovisual works, phonograms, videograms, software, databases”, “On specificity of state regulation of business entities’ activity related to manufacturing, export, import of discs for laser sensing systems”, “On livestock breeding”, “On scientific and technical data”, “On medicinal products” etc. Alongside this, in the course of intellectual property regulation relevant international agreements are applied in case if necessary (agreements recognized as binding by Verkhovna Rada of Ukraine). List of these agreements is presented Datasheet of the Higher Commercial Court of Ukraine dd. 20.02.2007 № v8_91600-07 “On statutory acts regulating issues related to protection of rights on intellectual property objects”. Despite the accomplishment of multiple tasks on formation of relevant legislative framework with consideration of global trends, current practical and theoretical achievements modern economy still requires constant updating of legislative mechanisms.

Aim of the article (task) stipulates analysis of theoretical and legislative background of intellectual property objects regulation namely the trademark (goods and services logo). We will emphasize the issues of legal protection of trademark use.

Basic material. Existence of modern internationally recognized system of intellectual property is a mandatory step on the way to sustainable economic and social development of any state. That is why protection of intellectual property promotes support of creative, talented inventors by maintaining the nation’s potential in the area of intellectual activity and attracting investment with guaranteed protection of rights of Ukrainian and foreign investors. Establishment of such system is of utmost importance for Ukraine as a state with considerable scientific and intellectual potential.

Figuratively intellectual property rights may be separated into four groups: the first one – copyrights and related rights – comprise literary and fictional works, software, databases, performances, videograms, programs of broadcasting companies. Second group – industrial property objects – inventions, utility models, industrial samples, integrated chips topography, efficiency proposals. All these are creative results and upon condition of full compliance with the legal requirements are recognized as intellectual property rights. Fourth group is presented by commercial names, trademarks (goods / service logo), geographical indications, commercial secrets. These objects are not precisely defined as performance results but also recognized as equal in legal context.

We will focus on legal regulation of trademark (goods and services logo). According to the provisions of the Civil Code of Ukraine and the Law of Ukraine “On protection of rights to goods and services logo”, trademark is defined as a symbol which is used to distinguish goods and services provided by one individual from others. It means that any sign or combination of signs may be recognized as a trademark if the former are suitable to distinguish goods (services) manufactured (provided) by an individual from goods (services) manufactured (provided) by other individuals. These signs may include in particular words, letters, numbers, images or colour combinations.

Acquisition of intellectual property right to a trademark must be verified by certificate where the scope of trademark legal protection is defined, in particular its image and list of services / goods. Exceptional are the cases regarding the acquisition of intellectual property right to a trademark which is a subject of international registration or recognized as a well-known according to established procedure.

Since the moment of acquisition of intellectual property right to a trademark its owner is given certain proprietary rights namely: right to use the trademark, exclusive right to allow or impede the illegal use of trademark. When the trademark gains certain value for certain target audience it becomes a brand. Brand is a comprehensive, unique and attractive image of trademark covering its goods or service. Its task is to stimulate generation of positive impressions related to goods' quality guarantee and manufacturer's "good repute" in consumer's consciousness.

Many manufacturers spend a lot of resources to develop their brands. It is not only about advertising but it also includes a whole set of measures aimed at improvement of goods / services features if compared with their competitors. In its turn, any illegal use of trademarks by third parties (piracy, imitation or dilution) may cause serious damage inflicted to the manufacturer's repute and decrease the brand value in general. That is why one of the most important issues is the protection of trademark. First stage starts from the moment of its "correct" registration. According to par. 1 of Article 494 of the Civil Code of Ukraine trademark legal protection scope is defined, in particular, by the list of goods / services, presented in certificate. According to requirements of par. 4 of Article 7 of the Law of Ukraine "On protection of rights to trademarks", any application for the certificate of trademark recognition must contain the abovementioned list of goods / services covered by the trademark which is subject to registration (grouped according to ICGS – International Classification of Goods and Services for Trademark Registration or the Nice Classification).

Taking the abovementioned into account, we state that trademark will be received protection only for those goods and services which were indicated during the registration and in accordance with the Nice Classification. In practice it will be possible to use, issue licenses and protect one's own trademark only regarding the registered groups of goods and services. Today business environment has become specifically diverse and in order to demarcate its areas a conditional gradation was established (unified by the Ministry of Economic Development and Trade and brought into force by ICGS (11-2018) in Ukrainian translation where key groups of goods and services are presented. When selecting the groups of goods and services relevant to your trademark which is subject to protection you must carefully analyze the ICGS categories and pick the most suitable ones. At a first glance it may look like the selection of required goods / services category in accordance with ICGS is simple but there are a lot of cases when lack of special knowledge and experience may lead to unsatisfactory results.

Pre-trial trademark protection. If you face a situation involving illegal use of your trademark, remember – owner of trademark has an exclusive right to impede the illegal use of trademark including prohibition of such use. According to Article 20 (2) of the Law of Ukraine "On protection of rights to trademarks" this violation must be ceased upon the owner's request and the perpetrator must reimburse the damage inflicted to the certificate owner. Owner of the certificate may also demand to remove the illegally placed trademark or symbol from the goods or its packaging if these images are similar to the extent that may lead to confusion or destroy the images of symbol or trademark similar to the extent that may lead to confusion.

Therefore, the primary task of the certificate owner is to send a written request (complaint) to perpetrator with demand to cease instantly the illegal use of owned trademark. You should also take into account that in practice it is almost impossible to get a compensation of damage by only submitting a written complaint, so other strategies must be considered in order to ensure the protection of violated rights.

Judicial protection of trademark. Article 21 (1) of the Law of Ukraine "On protection of rights to trademarks" indicates that rights to trademark are protected according to established procedures including the judicial process. Any encroachment on the rights of certificate (license) owner including commission of actions, requiring owner's consent, without his / her consent and preparation to commit these actions is a ground to initiate the judicial process. Among the common lawsuit claims presented by the plaintiff in similar disputes are: cease of actions violating the rights of trademark owner; removal of illegally used trademark from the goods or its packaging or destruction of manufactured images of symbol or sign similar to the extent that may lead to confusion; nullification of agreements related to trademark rights; reimbursement of damages. While considering the case the court must establish:

- 1) the fact of trademark being used by the defendant (in what format and for which goods or services);
- 2) is the sign used by defendant similar to the registered trademark to the extent that may lead to confusion and/or may it result in misleading regarding the manufacturer of goods (service provider);
- 3) the exact period of time when the trademark was used by the defendant; was the trademark used prior to the date of application submission or, if the priority was claimed, prior to the application priority date;
- 4) amount of damage inflicted (according to ownership requirements).

Also, upon request of the party concerned court may secure the claim before the lawsuit is filed in order to prevent the violations of trademark owner's rights. For example, prior to case consideration certain business entities may be prohibited from manufacturing and introduction of the product in commercial stream. Unfortunately, quite often courts refuse to satisfy such claims with reference to procedure demanding that courts, prior to any measures taken to secure the claim, must rely on the fact of illegal use of signs similar to plaintiff's registered trademarks which is deemed to be unjustified and untimely as the establishment of the mentioned fact is mostly a component of the fact in proof (must be proved in the course of case consideration).

Also it must be taken into account that many factors related to specific trademark are to be established which requires special knowledge – therefore, courts, depending upon the case circumstances, must commission the forensic examination. But we should note that courts are not entitled to involve forensic experts in cases when not the certain facts are subject to establishment, but certain rights are to be determined which arise from trademark as courts may not delegate its functions and powers to forensic experts.

Protection of trademark in criminal proceeding. Liability for illegal use of trademark is stipulated by Article 229 of the Criminal Code of Ukraine. Separately we may consider the reimbursement of damage under civil lawsuit within the criminal proceeding. Use of trademark is recognized as illegal and criminal proceeding is initiated only if this use inflicted material damage on a large and especially large scale to a business entity (to trademark owner and others).

Administrative means of trademark protection. Administrative means of trademark protection is presented mostly by the procedure of submitting the complaint to Antimonopoly Committee of Ukraine on violation of trademark owner's rights as an act of unfair competition. According to Article 23 of the Law of Ukraine "On the Antimonopoly Committee of Ukraine" any activity aimed at detection, prevention and termination of violations of legislation on protection against unfair competition is performed by the Antimonopoly Committee of Ukraine, its bodies and officials according to the procedure established by legislation on protection of economic competition.

According to Article of the Law of Ukraine "On protection from unfair competition" unfair competition is defined as any activity in the course of competition which contradicts the trade and other fair practices, in particular, activities listed in Article 2 of this Law: use of name, commercial name, trademark, advertising materials and periodicals packaging design, other signs and symbols without the consent of business entity which used these signs or symbols or similar images previously in commercial activity which resulted or may result in certain confusion of products manufactured by these business entities.

Conclusions. Recently trademark has become one of the most important factors shaping the development of business environment in Ukraine and defining the level of product competitiveness. Therefore reliable and efficient system of trademark protection must be presented. Applicable Ukrainian legislation establishes various means of trademark owner's rights protection – that is why it is very important to carry out correct the analysis of the situation properly and identify the most suitable and effective protection mechanisms. More attention must be paid to improvement of interaction between state bodies and business entities involved in intellectual activity and ensure proper implementation of international regulations in Ukrainian legislative framework.

References:

1. The Constitution of Ukraine (30.09.2016) // *Official website of Verkhovna Rada of Ukraine. Laws of Ukraine.* Access mode: <http://zakon.rada.gov.ua/laws/show/254>.
2. Civil Code of Ukraine (02.03.2018) // *Official website of Verkhovna Rada of Ukraine. Laws of Ukraine.* Access mode: <http://zakon3.rada.gov.ua/laws/show/435-15>.
3. Commercial Code of Ukraine (17.06.2018) // *Official website of Verkhovna Rada of Ukraine. Laws of Ukraine.* Access mode: <http://zakon3.rada.gov.ua/laws/show/436-15>.
4. On protection of trademarks (goods and services): Law of Ukraine (21.05.2015) // *Official website of Verkhovna Rada of Ukraine. Laws of Ukraine.* Access mode: <http://zakon2.rada.gov.ua/laws/show/3689-12>.
5. On protection of economic competition: Law of Ukraine (07.03.2018) // *Official website of Verkhovna Rada of Ukraine. Laws of Ukraine.* Access mode: <http://zakon0.rada.gov.ua/laws/show/2210-14>.
6. On protection from unfair competition: Law of Ukraine (03.03.2016) // *Official website of Verkhovna Rada of Ukraine. Laws of Ukraine.* Access mode: <http://zakon0.rada.gov.ua/laws/show/236-96>.

7. Paris Convention of the Protection of Industrial Property (20.03.1883). Kyiv : Parliamentary Publishing House, 2006. 27 p.

8. uipv.org/ua/signs.html.

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ПРАВО ВОЛОДІННЯ ЯК ПЕРЕДУМОВА НАБУТТЯ ПРАВА ВЛАСНОСТІ ЗА НАБУВАЛЬНОЮ ДАВНІСТЮ

THE RIGHT OF OWNERSHIP AS A PREREQUISITE FOR THE ACQUISITION OF PROPERTY RIGHTS BY ACQUISITIVE PRESCRIPTION

У статті досліджуються умови та порядок набуття права власності на майно за набувальною давністю. На підставі аналізу норм чинного законодавства та практики його застосування проаналізовано проблеми встановлення фактів добросовісного, відкритого та безперервного володіння майном як умов набуття права власності, співвідношення набувальної та позовної давності. Проведено порівняння норм цивільного права та норм земельного права щодо регулювання речових прав як підстави набуття права власності на земельну ділянку, адже у згаданих вище нормах задекларовані різні підходи до регулювання зазначених підстав.

Право власності на нерухоме майно, яке підлягає державній реєстрації, виникає за набувальною давністю з моменту державної реєстрації. Набуття за набувальною давністю права власності на чужу земельну ділянку, яка перебуває у приватній власності, здійснюється за рішенням суду. Надання таких земельних ділянок у власність або у користування за рішеннями органу державної влади, Ради Міністрів Автономної Республіки Крим або органу місцевого самоврядування порушуватиме права власників цих земельних ділянок.

Об'єктивну основу виникнення права власності за набувальною давністю складають описані в цивільному законодавстві вимоги до володільця. Автором також висвітлюється позиція, що особа, яка без законного титулу здійснює речове право володіння, повинна його реалізувати відповідно до визначених у законодавстві вимог, які є передумовами для набуття суб'єктивного права власності в особи, яка здійснювала речове право володіння. Перехід речових прав за набувальною давністю слід розглядати крізь призму пасивної поведінки власника щодо свого майна, яке перебуває у фактичному володінні іншої особи, яка ставиться до нього як до своєї власності. Володіння і користування чужою річчю протягом тривалого часу слід розглядати як речове право, яке виникло та існує без правомірного юридичного факту.

Ключові слова: набувальна давність, право власності, право володіння, речові права, земельна ділянка.

The conditions and procedure for acquiring ownership of property under the acquisitive prescription are investigated in the article. Based on the analysis of the current legislation and the practice of its application, the problems of establishing the facts of bona fide, open and continuous ownership of property as conditions for the acquisition of property rights, the ratio of acquisitive and statute of limitations are analyzed. Was made a comparison of civil law and land law on the regulation of property rights as a basis for