

THE LAW OF UKRAINE

On Amendments to Certain Legislative Acts of Ukraine on Enhancing the Protection of Intellectual Property Rights

The Verkhovna Rada of Ukraine hereby resolves:

The following legislative acts of Ukraine shall be amended:

1) in part two of Article 432 of the Civil Code of Ukraine (Journal of the Verkhovna Rada of Ukraine, 2003, No. 40-44, p. 356):

para 3 and 4 shall be amended as follows:

“3) withdrawal from civil circulation of goods manufactured or introduced into civil circulation in violation of intellectual property rights, and destruction of such goods at the expense of the person who committed the violation;

4) seizure from civil circulation of materials and tools that were used mainly for the manufacture of goods in violation of intellectual property rights, or seizure and destruction of such materials and tools at the expense of the person who committed the violation;”

para 4¹ shall be amended to read as follows:

“4¹) application of one-time monetary payment instead of application of methods of protection of the intellectual property rights established by para 3 and/or 4 of this part. The application of a one-time monetary payment shall be carried out at the request of the respondent, provided that the intellectual property right has been violated by the respondent unintentionally and without negligence, and that the application of the remedies established by para 3 and 4 of this part is disproportionate to the damage caused to the claimant. The amount of a one-time monetary payment shall be determined by the court as the amount of remuneration that would have been paid for granting the claimant the permission to use the intellectual property right in respect of which the dispute arose, and which reasonably satisfies the claimant;”

in para 5, the words “one-time monetary charge” and “charge” shall be replaced by the word “compensations”;

para 6 shall read as follows:

“6) the publication in the media, at the request of the claimant, or bringing to the public attention by another designated court of the information about the violation of intellectual property rights and the content of the court decision on such violation at the expense of the person who committed the offense;

2) in the Commercial Procedural Code of Ukraine (Journal of the Verkhovna Rada of Ukraine, 2017, No. 48, p. 436):

to amend Article 81¹ with the following content:

“Article 81¹. Demand for separate evidence in cases of violation of intellectual property rights

1. At the motivated request of a party to the case, the court may decide to demand evidence in the form of information about the origin and distribution networks of goods or services that violate intellectual property rights or in respect of which there are reasonable grounds to believe that the distribution of such goods or the provision of such services violates intellectual property rights:

1) from a person in respect of whom there are reasonable grounds to believe that such person is violating an intellectual property right; and/or

2) from any other person with respect to whom there are reasonable grounds to believe that such person has offered, received, owned and/or used goods or services violating intellectual property rights for a commercial purpose; or

3) from any other person who has been designated by the person named in para 2 of this part as being involved in the production, manufacture or distribution of goods or services that violate intellectual property rights.

2. A demand for evidence submitted on the basis of part 1 of this Article shall relate exclusively to information that is necessary to establish the origin and distribution network of goods or services that violate intellectual property rights or in respect of which there are sufficient grounds to believe that the distribution of such goods or provision of such services violates intellectual property rights.

The information shall contain:

1) full name (for legal entities) or first name (surname, first name, patronymic – for individuals) and address of persons in respect of whom there are sufficient grounds to believe that they are producers, distributors, or other previous owners of such goods or providers of such services, including persons engaged in wholesale or retail trade in such goods or providing such services;

2) information on the quantity and value of goods or services produced, shipped, delivered, received, or ordered.

3. The court may also demand evidence before filing a claim as a measure to secure evidence in the manner prescribed by Articles 110-112 of this Code, taking into account the peculiarities specified in parts one and two of this Article;”

part four of Article 143, after the words “claim for recovery of a sum of money,” add the words “or a pecuniary claim for violation of intellectual property rights;”

3) in the Civil Procedural Code of Ukraine (Journal of the Verkhovna Rada of Ukraine, 2017, No. 48, p. 436):

add Article 84¹ with the following content:

“Article 84¹. Demand for separate evidence in cases of violation of intellectual property rights

1. Upon the motivated request of the party to the case, the court may order the demand of evidence in the form of information about the origin and distribution networks of goods or services that violate intellectual property rights or in respect of which there are sufficient grounds to believe that the distribution of such goods or provision of such services violates intellectual property rights:

1) from a person in respect of whom there are reasonable grounds to believe that such person is violating an intellectual property right; and/or

2) from any other person with respect to whom there are reasonable grounds to believe that such person has offered, received, owned and/or used goods or services violating intellectual property rights for a commercial purpose; or

from any other person who has been designated by the person stipulated in para 2 of this part as being involved in the production, manufacture or distribution of goods or services that violate intellectual property rights.

2. A motion for evidence submitted on the basis of part 1 of this Article shall relate exclusively to information that is necessary to establish the origin and distribution network of goods or services that violate intellectual property rights or in respect of which there are sufficient grounds to believe that the distribution of such goods or provision of such services violates intellectual property rights.

The information shall contain:

1) full name (for legal entities) or first name (surname, first name, patronymic – for individuals) and address of persons in respect of whom there are sufficient grounds to believe that they are producers, distributors, or other previous owners of such goods or providers of such services, including persons engaged in wholesale or retail trade in such goods or providing such services;

2) information on the quantity and value of goods or services produced, shipped, delivered, received, or ordered.

3. The court may also demand evidence before filing a claim as a measure to secure evidence in the manner prescribed by Articles 116-118 of this Code, taking into account the peculiarities specified in parts one and two of this Article;"

part four of Article 156, following the words “a claim for the recovery of a sum of money,” add the words “or pecuniary claim regarding the violation of intellectual property rights”;

4) in the Law of Ukraine “On Protection of Rights to Industrial Designs” (Journal of the Verkhovna Rada of Ukraine, 1994, No. 7, p.34; 2003, No. 35, p.271; 2020, No. 45, p.387, No. 51, p. 481

in Article 21:

in paragraph 7:

in the second paragraph, the words “fluent in the national language” shall be replaced by the words “fluent in the national language in accordance with the level determined by the National Commission for National Language Standards”;

in the fifth paragraph, the word “two” shall be replaced by the word “five”;

paragraph two of clause 8 shall be worded as follows:

“one representative of the National Academy of Legal Sciences of Ukraine”;

in paragraph 5 of Article 25, the words “losses to the person who incurred losses” shall be replaced by the words “damages to the person who incurred damages”;

in paragraph 2 of Article 26:

paragraph one to be worded as follows:

“2. At the request of the holder of a registered or unregistered industrial design, such violation shall be terminated, and the infringer shall be obliged to compensate the holder of the registered or unregistered industrial design for the property damage caused by reimbursement of damages or compensation and/or non-pecuniary (moral) damage caused”;

after the first paragraph, add three new paragraphs with the following content:

“The amount of damages shall be determined by the court taking into account the lost profit or income received by the infringer as a result of violation of the rights of the holder of the registered or unregistered industrial design.

The amount of compensation shall be determined by the court on the basis of the scope of violation, the fault of the offender and other circumstances of significant importance. In this case, the amount of compensation may not be less than the amount of remuneration that would have been paid for granting permission to use the rights to a registered or unregistered industrial design in respect of which a dispute arose. If the infringement of the rights to a registered or unregistered industrial design occurred unintentionally and without negligence, the amount of compensation shall be equal to the amount of remuneration that would have been paid for granting such permission.

The recovery of compensation shall be applied by the court instead of reimbursement of damages at the discretion of the holder of the registered industrial design.”

In this regard, paragraph two shall be considered paragraph five;

5) in the Law of Ukraine “On Protection of Rights to Marks for Goods and Services” (Journal of the Verkhovna Rada of Ukraine, 1994, No. 7, p. 36; 2001, No. 8, p. 37; 2003, No. 35, p. 271; 2020, No. 45, p. 387, No. 51, p. 481) in Article 21:

in paragraph 7:

in the second paragraph, the words “fluent in the national language” shall be replaced by the words “fluent in the national language in accordance with the level determined by the National Commission for National Language Standards”;

in the fifth paragraph, the word “two” shall be replaced by the word “five”;

Paragraph six of clause 8 should be worded as follows:

“one representative of the National Academy of Legal Sciences of Ukraine”;

the second sentence of the paragraph seven, clause 1 of Article 6 shall be worded as follows: “The competent authority for granting permission for the use in the trademark of the official name and the international letter code of the State of Ukraine and/or for the inclusion in the image of the trademark of the imitation of the small State Emblem of Ukraine shall be a collegial body established by the NIPA”;

in paragraph 5 of Article 19, the words “losses to the person who incurred losses” shall be replaced by the words “damages to the person who incurred damages”;

in paragraph 2 of Article 20:

paragraph one shall be worded as follows:

“2. At the request of the holder of the certificate, such violation shall be terminated, and the violator shall be obliged to compensate the certificate holder for the property damage caused by reimbursement for damages or payment of compensation and/or non-pecuniary (moral) damage caused”;

after the first paragraph, add three new paragraphs of the following content:

“The amount of damages shall be determined by the court taking into account the lost profit or income received by the infringer as a result of violation of the rights of the certificate holder.

The amount of compensation shall be determined by the court on the basis of the amount of the violation, the fault of the infringer and other circumstances of significant importance. In this case, the amount of compensation may not be less than the amount of remuneration that would have been paid for granting permission to use the rights to the trademark in respect of which the dispute arose. If the violation of the rights of the certificate holder occurred unintentionally and without negligence, the amount of compensation shall be equal to the amount of remuneration that would have been paid for granting such permission.

The recovery of compensation shall be applied by the court instead of reimbursement of damages at the discretion of the certificate holder.”

In this regard, paragraphs two and three shall be considered as paragraphs five and six, respectively;

6) in the Law of Ukraine “On Protection of Rights to Layout Designs of Semiconductor Products” (Journal of the Verkhovna Rada of Ukraine, 1998, No. 8, p. 28, as subsequently amended):

in Article 2²:

in paragraph 7:

in the second paragraph, the words “fluent in the national language” shall be replaced by the words “fluent in the national language in accordance with the level determined by the National Commission for National Language Standards”;

in the fifth paragraph, the word “two” shall be replaced by the word “five”;

Paragraph six of clause 8 shall be worded as follows:

“one representative of the National Academy of Legal Sciences of Ukraine”;

in paragraph 2 of Article 21:

paragraph one shall be worded as follows:

“2. At the request of the rights holder to the registered layout, such violation shall be terminated, and the violator shall be obliged to compensate the rights holder for the property damage caused by reimbursement for damages or compensation and/or non-pecuniary (moral) damage caused”;

after the first paragraph, add three new paragraphs with the following content:

“The amount of compensation for losses shall be determined by the court taking into account the lost profit or income received by the infringer as a result of violation of the rights of the holder of the registered layout.

The amount of compensation shall be determined by the court on the basis of the amount of the violation, the fault of the infringer and other circumstances of significant importance. In this case, the amount of compensation may not be less than the amount of remuneration that would have been paid for granting permission to use the rights to the certificate in respect of which the dispute arose. If the violation of the rights to the registered layout occurred unintentionally and without negligence, the amount of compensation shall be equal to the amount of remuneration that would have been paid for granting such permission.

The recovery of compensation shall be applied by the court instead of reimbursing losses at the discretion of the rights holder to the registered layout.”

In this regard, paragraph two shall be considered paragraph five;

7) in Article 3¹ of the Law of Ukraine “On Legal Protection of Geographical Indications” (Journal of the Verkhovna Rada of Ukraine, 1999, No. 32, p. 267, as subsequently amended):

in part seven:

in the second paragraph, the words “fluent in the national language” shall be replaced by the words “fluent in the national language in accordance with the level determined by the National Commission for National Language Standards”;

in the fifth paragraph, the word “two” shall be replaced by the word “five”;

paragraph six of clause eight shall read as follows:

“one representative of the National Academy of Legal Sciences of Ukraine”;

8) in the Law of Ukraine “On Protection of Rights to Inventions and Utility Models” (Journal of the Verkhovna Rada of Ukraine, 2000, No. 37, p. 307; 2003, No. 35, p. 271; 2020, No. 45, p. 387

in Article 3¹:

in part seven:

in the second paragraph, the words “fluent in the national language” shall be replaced by the words “fluent in the national language in accordance with the level determined by the National Commission for National Language Standards”;

in the fifth paragraph, the word “two” shall be replaced by the word “five”;

paragraph six of clause eight shall read as follows:

“one representative of the National Academy of Legal Sciences of Ukraine”;

in part two of Article 34:

paragraph one shall read as follows:

“2. At the request of the patent owner, such violation shall be terminated, and the infringer shall be obliged to compensate the patent owner for the property damage caused by compensation for losses or payment of compensation and/or non-property (moral) damage caused”;

after the first paragraph, add three new paragraphs of the following content:

“The amount of damages shall be determined by the court taking into account the lost profit or income received by the infringer as a result of violation of the rights of the patent owner.

The amount of compensation shall be determined by the court on the basis of the amount of the violation, the fault of the infringer and other circumstances of significant importance. In this case, the amount of compensation may not be less than the amount of remuneration that would have been paid for granting permission to use the rights to the patent in respect of which the dispute arose. If the infringement of the rights of the patent owner occurred unintentionally and without negligence, the amount of compensation shall be equal to the amount of remuneration that would have been paid for granting such permission.

The recovery of compensation shall be applied by the court instead of reimbursement of damages at the discretion of the patent owner.”

In this regard, paragraph two shall be considered paragraph five;

9) in subparagraph 4 of paragraph 3⁴ of section VI “Final and transitional

provisions” of the Law of Ukraine “On the effective management of property rights of rights holders in the field of copyright and (or) related rights” (Journal of the Verkhovna Rada of Ukraine, 2018, No. 32, p. 242, with subsequent amendments) the words and the number “to this subparagraph 3” shall be replaced by the words “to this subparagraph,” and the words and the number “defined by this subparagraph 3” – with the words “defined by this subparagraph”;

10) in the Law of Ukraine “On Copyright and Related Rights” dated December 1, 2022 No.

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in part one of Article 1:

in paragraph 19, after the words “public performance,” add the words “(except for the presentation of works and/or live performances)”, and the words “cable retransmission” shall be replaced by the words “retransmission, cable retransmission”

in paragraph 50, after the words “the first alienation” add the words “of original copies or others”;

in the fifth paragraph of part eight of article 4, the word “two” shall be replaced by the word “five”;

in part two of Article 15, the words “in favor of the customer” shall be replaced by the words “to the customer from the moment the work is created in full”;

in part seven of Article 21:

in the first paragraph, the words and numbers “expire after 15 years on the last day of the calendar year in which the database was created” shall be replaced by words and numbers “shall expire after 15 years counted from January 1 of the year following the year of the database creation”;

in the second paragraph, the words “on the last day of the calendar year in which the database was first published” shall be replaced by the words and the number “counted from January 1 of the year following the year of such publication of the database”;

in Article 22:

clause 10 of part two shall be amended as follows:

“10) creation of images of works of architecture and fine arts permanently located in places accessible to the public, and further use of such objects, provided that such actions have no independent economic significance”;

in part five, the word and number “paragraph 4” shall be replaced by the word and number “paragraph 3”;

in Article 33:

in the second part, the words “shall be persons” should be replaced by the words “may be persons”, and the word “other” shall be excluded;

part six shall read as follows:

“6. The period of validity of the sui generis right to a non-original object generated by a computer program shall expire after 25 years, calculated from January 1 of the year following the year in which the non-original object was generated.

in part ten, the word and numbers “articles 22-29” shall be replaced by the word and numbers “articles 22-28”;

in Article 36:

in part six:

in the first sentence, the words “performance related to professional duties arise” shall be replaced by the words “performance related to professional duties, phonogram related to professional duties, videogram related to professional duties arise”;

in the second sentence, replace the words “use of performance related to professional duties” with the words “use of performance related to professional duties, phonogram related to professional duties, videogram related to professional duties”;

in part seven, the words “upon order, arise” shall be replaced by the words “upon order, as well as property rights to a phonogram or videogram produced upon order, arise”;

in part eight:

paragraph two shall read as follows:

“Persons through joint activities of whom it was performed, persons who have jointly produced a phonogram or a videogram, shall exercise their rights to the corresponding performance, phonogram, videogram, under the conditions and in the manner provided for in Article 13 of this Law”;

in paragraph three, the word “performance” shall be replaced by the words “performance, phonogram, videogram”;

in Article 38:

in paragraph one of the part one, after the word “prohibit,” add the word “the usage”;

sentence two of paragraph three, of clause two shall be deleted;

part three shall read as follows:

“3. Regardless of the alienation of the property rights to performance specified in part one of this article, the performer shall have the right to a fair remuneration for the appropriate methods of using the performance, determined by this Law and the Law of Ukraine “On Effective Management of Property Rights of Copyright Holders and (or) Related Rights.”

Without the permission of the subject of property related rights to perform, but with the payment of a fair remuneration to performers, the following use of phonograms, videograms containing the corresponding performance may be possible:

- 1) public performance of the phonogram;
- 2) public notification of the phonogram;
- 3) public demonstration of the videogram;
- 4) public notification of the videogram.

The right to a fair remuneration shall belong only to the performer, it shall only pass to the heirs of the performer and cannot be transferred (alienated) to other persons.

The fair remuneration of the performer shall be 50 % of the income from the rights relating to the use of the corresponding phonogram or videogram and shall be determined in accordance with the Law of Ukraine "On the effective management of property rights of the holders of copyright and (or) related rights." The remaining 50 % of the said income from rights shall belong to the phonogram producer or to the producer of the videogram containing the corresponding performance."

in Article 39:

the second sentence of the paragraph of the third part of the second shall be deleted;

part three shall be amended as follows:

"3. Regardless of the alienation of the property rights to the phonogram specified in part one of this article, the phonogram producer shall be entitled to a fair remuneration for the appropriate methods of using the phonogram, determined by this Law and the Law of Ukraine "On Effective Management of Property Rights of Copyright Holders in the Sphere of Copyright and (or) Related Rights."

Without the permission of the subject of property related rights to the phonogram, but with the payment of a fair remuneration to the phonogram producer, the following use of phonograms shall be possible:

- 1) public performance of the phonogram;
- 2) public notification of the phonogram.

The right to this fair remuneration belongs to the phonogram producer, and it shall only pass to the heirs or successors of the phonogram producer, and cannot be transferred (alienated) to other persons.

The share of the fair remuneration of the phonogram producer shall be determined in accordance with the fourth paragraph of the third article 38 of this Law. ";

in Article 40:

paragraph four of part two shall be deleted; part three shall be amended to read as follows:

"3. Regardless of the alienation of the property rights to the videogram specified in part one of this article, the producer of the videogram shall have the right to a fair remuneration for the appropriate methods of using the videogram determined by this Law and the Law of

Ukraine “On Effective Management of Property Rights of Copyright Holders in the Sphere of Copyright and (or) Related Rights.”

Without the permission of the subject of property related rights to the videogram, but with the payment of a fair remuneration to the videogram producer, the following use of the videogram shall be possible:

- 1) public demonstration of the videogram;
- 2) public notification of the videogram.

The right to this fair remuneration shall belong to the videogram producer, it shall only pass to the heirs or successors of the videogram producer, and cannot be transferred (alienated) to other persons.

The share of the fair remuneration of the videogram producer shall be determined in accordance with the paragraph four of the clause three of Article 38 of this Law”;

in part one of Article 47, the words “independently, through a representative” shall be replaced by the words “personally, through a representative or other authorized person”;

in paragraph two of part one of Article 50, the words “in particular the collective management organization” shall be deleted;

in the paragraph five of part three of Article 53, the words “the produced copy” shall be replaced by the words “the produced copies,” and the words “protection – copies” – by the word “protection”;

in paragraph two of Article 57, the word and numbers “Article 55” shall be replaced by the word and numbers “Article 56”.

This Law shall enter into force on the day following the day of its publication.

President of Ukraine 2974-IX	VOLODYMYR ZELENSKYY
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