

# WORLD TRADE ORGANIZATION

RESTRICTED

WT/ACC/UKR/41/Add.1

22 October 1997

(97-4628)

---

**Working Party on the  
Accession of Ukraine**

Original: English

## ACCESSION OF UKRAINE

### Additional Questions and Replies

#### Addendum

The Governmental Commission on Ukraine's Accession to the WTO has provided the following additional replies to the questions submitted by delegations following the Working Party meeting held on 5-6 May 1997.

---

## **OTHER POLICIES RELATED TO FOREIGN TRADE**

### **Copyright and Related Rights**

#### **Question 1.**

**Ukrainian legislation needs to be amended to grant full retroactive protection of works (presently limited to works which were released since 1 January 1973) and phonograms (no retroactive protection at all) as foreseen by the TRIPS Agreement (in Articles 9, 14.6 in conjunction with Article 18 of the Bern Convention.**

Answer:

See the answer to question 65 (WT/ACC/UKR/41).

#### **Question 2.**

**Furthermore, Ukraine needs to introduce the protection of foreign phonograms along the lines of Article 14 of the TRIPS Agreement which currently does not exist at all.**

Answer:

See the answer to question 65 and question 73 (WT/ACC/UKR/41).

### **Trademarks and Geographical Indications**

#### **Question 3.**

**Ukrainian legislation does not contain any provisions on the protection of geographical indications for goods in general including wines and spirits. Therefore, Ukraine should introduce such legislation in conformity with Article 22 to 24 of the TRIPS Agreement.**

Answer:

The draft Law of Ukraine "On Protection of Rights to Specify Geographical Origin of Goods (Services)", incorporating provisions of Articles 22-24 of the TRIPS Agreement, has been submitted to the Supreme Rada of Ukraine.

See also the reply to question 72 (WT/ACC/UKR/41).

## **Patents**

### **Question 4.**

**The protection of patents needs to be brought into line with Articles 2 and 27 to 34 of the TRIPS Agreement e.g.:**

- (a) in cases of "use without the authorization of the rightholder" most of the criteria as set out in Article 31 of the TRIPS Agreement is not incorporated into Ukrainian law (Articles 24 and 26 of the Law on the Protection of Rights for Inventions and Utility Models.)**
- (b) Article 26 of the Law on the Protection of Rights for Inventions and Utility Models needs to be amended to implement Article 2.1 of the TRIPS Agreement in conjunction with Article 5.4 of the Paris Convention which provides that a compulsory license on the ground of not (or insufficiently ) working of a patent may not be applies " ... before the expiration of a period of four years from the date of filing of the patent application of three years from the date of the grant of the patent, whichever period expires last; ... ". Article 26 of the said Ukrainian law speaks of a period of " ... three years starting from the date of information publication on patent's issue or from the date when use of invention was stopped ...".**

Answer:

In our opinion, the effective Law of Ukraine "On the Protection of Rights in Inventions and Useful Models" in general complies with provisions of the Paris Convention on Protection of Industrial Property and TRIPS Agreement provisions concerning the granting of rights in inventions.

Those requirements of the TRIPS Agreement which have not been covered in the above Law are incorporated into the draft Law of Ukraine "On the Introduction of Changes and Amendments to the Law of Ukraine "On the Protection of Rights in Inventions and Useful Modes".

In particular, it concerns the enforcement of Article 5.4 of the Paris Convention on the Protection of Industrial Property, and Article 2 (Clause 1) of the TRIPS Agreement which regulate the time upon expiration of which a license may be granted without the permission of the patent owner in case of his/her failure to use or sufficiently use the invention.

Please pay attention to the fact that the Resolution of the Cabinet of Ministers of Ukraine "On the Procedure of Granting Licenses for Use of Patented Inventions without the Permit of Patent Owners" is also effective in Ukraine. It is planned to introduce changes and amendments to the said Resolution with due regard to provisions of Article 31 of the TRIPS Agreement.

## **Lay-out Designs (Topographies) in Integrated Circuits**

### **Question 5.**

**Ukrainian legislation does not contain provisions which meet the requirements contained in Articles 35 to 38 of the TRIPS Agreement. The Ukrainian laws need to be changed accordingly.**

Answer:

The draft Law of Ukraine "On the Protection of Rights in Topologies of Integrated Chips" which incorporates provisions contained in Articles 35-38 of the TRIPS Agreement has been passed in the first reading by the Supreme Rada of Ukraine.

## **Undisclosed Information**

### **Question 6.**

**Ukrainian legislation show shortcomings with regard to the protection of undisclosed information (Article 39 of the TRIPS Agreement). The relevant laws need to be amended, e.g. with regard to:**

- (a) **the definition of (undisclosed information" (Article 39.2, paragraphs (a) to (c) of the TRIPS Agreement. Ukrainian law foresees a determination by the director of the enterprise concerned about the question of what is a secret);**
- (b) **the protection of test or other data submitted in the context of the marketing approval of pharmaceutical or agricultural chemical products (Article 39.3 of the TRIPS Agreement).**

Answer:

In 1998 Ukraine is planning to complete the elaboration of the draft Law of Ukraine concerning the protection of rights in information subject to non-disclosure. This draft Law will incorporate provisions contained in Article 38 of the TRIPS Agreement.

## **Enforcement**

### **Question 7.**

**The TRIPS Agreement sets out detailed criteria for the enforcement of intellectual property rights for civil and administrative procedures, provisional measures, as well as criminal procedures (Articles 41 to 50 and 61 of the TRIPS Agreement) and border enforcement (Articles 51 to 60 of the TRIPS Agreement). The Ukrainian legislation does not yet comply with all of these provisions, e.g. shortcomings exist with regard to the following rights and obligations:**

**Article 44 of the TRIPS Agreement, i.e. injunctions to order a party to desist from an infringement of an intellectual property right, *inter alia* to prevent the entry into the channels of commerce of imported goods immediately after customs clearance;**

**Article 46 of the TRIPS Agreement, remedies to create and effective deterrent to infringement (not only copyright and related rights as under Ukrainian law), such as to order that infringing goods (as well as related materials and implements) be, without compensation, disposed of outside the channels of commerce in such a manner as to avoid harm. Furthermore, such infringing goods may, under certain conditions, be destroyed;**

**Article 50.1(a) of the TRIPS Agreement, provisional measures to prevent infringements and the entry into the channels of commerce of goods, including imported goods immediately after customs clearance;**

**Article 50, paragraph 3 to 8 of the TRIPS Agreement which contains procedural details in the case of the adoption of provisional measures;**

**Articles 51 to 60 of the TRIPS Agreement which provide for the suspension of release into free circulation of counterfeit trademark or pirated copyright goods by the customs authorities;**

**Article 61 of the TRIPS Agreement which obliges members to provide for criminal procedures and penalties not only with regard to copyright piracy (the latter is provided by Ukrainian law), but also in cases of wilful trademark counterfeiting. Remedies available shall also include the seizure, forfeiture and destruction of the infringing goods and of any materials and implements related thereto.**

Answer:

At present in Ukraine a wide-scale work is done for the elaboration of drafts of the new Civil, Criminal, Administrative and Customs Codes, of which provisions should comply with rules and disciplines accepted in the world community, including in particular requirements to protection (enforcement) of intellectual property rights.

In this connection, the submission and gathering of proposals regarding contents of sections or articles of the above-mentioned codes, with due regard to requirements of Articles 41-61 of the TRIPS have been started.

Taking into consideration that the process of drafting and adoption of the above-mentioned Codes by the Supreme Rada of Ukraine is rather long, it has been decided to include into draft Laws of Ukraine "On the Introduction of Changes and Amendments to the Law of Ukraine On the Introduction of Changes and Amendments to the Law of Ukraine On the Protection of Rights in Industrial Samples" and "On the Introduction of Changes and Amendments to the Law of Ukraine On Protection of Signs for Goods and Services", articles which would provide for preliminary (provisional) measures aimed at immediate cessation of violation of rights in industrial objects in compliance with the requirements set forth in Article 50 of the TRIPS Agreement.

Provisions of this Article entitle a judge, before the case is considered in a court, to take independently a decision on the immediate cessation of a violation, and to authorize sequestration and withdrawal of goods which are suspected of having been manufactured with violation of intellectual or industrial or property owner's rights.

The above draft laws also contain articles concerning civil protection (enforcement), by a resolution of a court, of intellectual or industrial property owner's rights, in particular:

- reimbursement for damages, including profit not received;
- withdrawal of income received by offender;
- payment of compensation;
- confiscation of goods, as well as materials and equipment used for manufacture thereof, as well as other measures.

Criminal measures in the form of imposition of a fine or imprisonment in the case of deliberate infringement upon rights for commercial purposes.

Some procedural issues pertaining to the imposition of provisional measures described in Article 50 of the TRIPS Agreement may be covered by procedural legislation.

At present a normative act on special border measures applied to goods containing intellectual property objects is being drafted in compliance with requirements of Articles 51-60 of the TRIPS Agreement.