

Unofficial translation

## LAW OF MONGOLIA TRADEMARKS, TRADE NAMES

### CHAPTER 1 GENERAL

#### Article 1. Purpose of the Law

The purpose of this Law is to ensure legal guarantee for trademarks, trade names, to protect the rights, legal interests of their owners, to regulate relations with regard to ownership, exploitation, expenditure of trademarks, trade names.

#### Article 2. Trademark, trade name legislation

1. The legislation on trademarks, trade names shall consist of the Constitution of Mongolia, the Civil Code, this Law and other respective legislative acts.
2. Where an international treaty to which Mongolia is party, contains provisions differing from those specified in the legislation of Mongolia on trademarks, trade names, the provisions of the international treaty shall prevail.

#### Article 3. Definitions in the Law

In this Law:

- (i) "trademark" means a letter, numerals, figurative elements, or an image expression of their combination that have specific meaning used by a legal entity, or a person, who carry out production and service activities, for the purpose of distinguishing their trades and service from others';
- (ii) "collective mark" means a trademark used by Union members of a legal entity established according to the provisions and rules in the legislation for carrying out similar production and service activities, for goods and service of coherent characteristics, under the supervision of the Union;
- (iii) "name of origine" means a name of a country, a city, a village, a place which have peculiarities directly linked to geographical conditions, people's customs and where goods are produced;
- (iv) "trade name" means a nominal name used by a legal entity established according to relevant rules, for carrying out its activities;
- (v) "registered mark, name" mean a trademark, a trade name registered in the State record by the Intellectual Property Office and issued a certificate according to relevant rules;
- (vi) "owner of a trademark" means an author who has acquired the right to own, exploit, spend a registered mark, according to rules reflected in the law;

(vii) "application" means an application, or other documents reflected in the law, submitted to the Intellectual Property Office by a legal entity, a person willing to have a trademark, a trade name registered;

(viii) "examination" means checking carried out by an authorized officer of a related organisation, whether similar trademark, trade name have been previously registered and issued certificates;

(ix) "license" means a permission given by the owner of a trademark, a trade name to another person to exploit a trademark, a trade name, after registration by the Intellectual Property Office;

(x) "filing date" means the date on which an application of trade mark, trade name is received by the Intellectual Property Office, according to Article 7 of this Law;

(xi) "priority date" means the date on which a trade mark is received to be registered in any member State of the Paris Convention for the Protection of Industrial Property, or to have a priority date according to Article 4 of the Convention;

(xii) "International classification of trade marks" means Nice Agreement, of 1957 concerning the International Classification of Goods and Services for the Purpose of the registration of marks, and Vienna Agreement of 1973, establishing an International Classification of the Figurative Elements of Marks.

#### Article 4. Registrable trademarks, requirements for registration

1. Trademarks that have met the requirements reflected in Article 3 (1) of this Law shall be registered.

2. The following items shall not be considered a trademark:

(i) a word, a figurative element which describe a thing, a phenomenon;

(ii) a usual name, formula, figurative element, common geometrical element, numerical expression, undesipherable letter, mark;

(iii) a word, figurative elements which explain origine, quantity, weight, quality, purpose, price of a good, name of manufacturer, means and date of manufacture;

(iv) a thing which may lead to wrong way;

(v) a geographical name and abbreviation thereof or a map, a sign showing a location;

(vi) a undistinctive human name

(vii) common expression of a common undistinctive place.

3. The following marks shall not be registered:

- (i) trademarks, identical with, or similar to the national emblem, flag, a whole or an abbreviated name of mass and international organisations, official badges of Mongolia, or other foreign countries;
- (ii) whole and abbreviated name, portrait, picture, signature of a famous person used without his, or heir's authorisation;
- (iii) names, pseudonyms, portraits, pictures, or names of their imagination of historical persons of Mongolia used without authorisation of competent authority;
- (iv) a word, figurative elements protected by copyright, industrial design patent of Mongolia, used without authorisation of the author, or owner of the rights;
- (v) a trademark similar to a trademark used for goods, service, which is registered, or submitted for registration;
- (vi) a trademark similar to common trademarks of Mongolia;
- (vii) a trademark, the content of which is prejudicial to public order, morality;

4. Names of origine of goods shall be registered only by collective mark.

#### Article 5. Tradenames, requirements for registration

1. An economic entity shall have a nominal name and exclusive rights to use it.
2. A trade name shall enter into force after being registered in the state register and issued a certificate.
3. A trade name shall not obtain registration in the following cases;
  - (i) if it coincides with previously registered trade name;
  - (ii) if it expresses legal status of an economic entity
  - (iii) if an economic entity is not established and registered according to law;
  - (iv) if a trade name is expressed by number.
4. A trade name shall be brief and expressed in cyrrilic. An economic entitiy may register a trade name expressed in cyrrilic together with a trade name expressed in Latin if so wishes.
5. After a trade name, shall be written a type of structure of an economic entity.
6. A trade name expressed by two or more words shall be written in the following forms;
  - (i) if a trade name is expressed by two words and the second one starts with consonant, it shall be linked directly to the first one;

(ii) if a trade name is expressed by two words and the second one starts with a vowel, it shall be preceded by en dash (-), and starts with capital letter;

(iii) if a trade name is expressed by three words and the second one starts with a consonant, the first and second ones shall be directly linked, and the third one shall be written after one letter space, with small letter;

(iv) if a trade name is expressed by three words and the second one starts with a vowel, the second and third ones shall be written with one letter space between and start with small letters;

7. A trade name may not express certain meaning, or may express a brief meaning, or may consist of a single letter, or syllable and in this case all letters shall be written with capital. The letters shall be linked one after one and without a sign between them.

8. An economic entity may register its trade name in whole, or short form convenient for daily use, and may use the shorter form of the trade name as a trade mark. In this case, the trade name, as a trade mark, shall be registered according to law.

#### Article 6. Responsibility of the Intellectual Property Office with regard to trademarks, trade names

1. The Intellectual Property Office shall carry out the following functions with regard to registration of trademarks, trade names:

(i) to receive and solve the applications of trademarks, trade names;

(ii) to register trademarks, trade names and issue a certificate;

(iii) to issue references for dispute settlement concerning trademarks, trade names;

(iv) to solve the applications, grievances charged by law;

(v) to fix the design of trademarks, trade names certificate;

(vi) to keep a state unified register of trademarks, or related contracts, trade names, to establish a unified database, and to publish related information;

(vii) to annul trademarks, trade names according to justification, regulations reflected in Law;

(viii) the functions reflected in Article 5.1 (8),(10),(11),(13),(15) of the Patent Law, in Article 6.1 (11),(12) of the Copyright Law.

2. The Intellectual Property Office may, upon the request of the author, evaluate works related to trademarks, trade names.

## CHAPTER II

### REGISTRATION OF TRADEMARKS, TRADE NAMES ISSUANCE OF CERTIFICATES

## Article 7. Application of trademarks, trade names

1. A legal entity, a person willing trademarks, trade names to be registered, shall submit the application of trade marks, tradenames to the Intellectual Property Office.
2. The application of trademarks shall consist of an application, 10 copies of figurative element of trademark.
3. The application of trade name shall consist of an application, a magnified writing of the trade name, a copy of the state registration certificate of the economic entity.
4. In the application there should be indicated names, address, nationality of the applicant, or his attorney, date and number of application, kind of activities of the applicant, request for registration of trademarks, trade names, figurative elements of the trademarks, tradenames.
5. If the applicant wishes a sign, a collective mark of form of volume, or of color to be registered, he shall notify about this in the application, and enclose to the application a copy of the rule of utilisation of the mark.
6. If an applicant wishes the name of origin of goods to be registered, he shall notify in the application about it, and attach to the application the documents confirming the name of origin and his right to use it.
7. If trademarks, tradenames are expressed in other sign than in cyrillic, or latin, the sign shall be transformed into latin and sent together with the application.
8. The application of trademarks may be covered by one or more international classification of goods and service.
9. An applicant may, before state registration of tradename, ask whether the selected name coincides with a previously registered name.
10. If the selected tradename is different from the previously registered name of a legal entity by only marginal sign of type, number, letter, or word that show the form of the economic entity, the selected name is considered as coinciding and shall not obtain registration.
11. The provisions of Article 6 (6), (7), (8) of the Patent Law of Mongolia are also applicable.

## Article 8. Filing date of Application for trademarks, tradenames

1. The Intellectual Property Office, within 20 days after receiving the application for tradenames, shall examine the related materials of the application, and if the application meets the requirements reflected in Articles 4, 5, shall accord as the filing date the date of receipt of the application.
2. If the Intellectual Property Office considers that the application does not meet the requirements reflected in Articles 4, 5 of this Law, shall notify the applicant to make amendments, alteration during 2 months and send back to the applicant. If the applicant makes amendment, alteration during that period and submit to the Office, the Intellectual Property Office shall accord as the filing date the date of receipt of the application.

3. If the due amendment, corrections are not made and submitted to the Office during the period indicated in paragraph 2 of this Article, the Intellectual Property Office shall deny the receipt of the application.

4. If a person, or a legal entity have requested trademarks be registered, and have made application within 6 months from the date of exposing the goods in the following exhibitions, the filing date shall be accorded to the date of exposure of goods at the exhibitions:

(i) an exhibition organized by central, or local competent administration;

(ii) an exhibition organized with permission given by central, or local competent administration;

(iii) an exhibition organized in foreign countries;

(iv) an exhibition organized in the territory of a member country of the Paris Convention by, or with permission of the Government of that country.

#### Article 9. Examination of application for trademarks, tradenames

1. If the Intellectual Property Office considers that the application does meet the necessary requirements, shall examine whether the sign may, according to this Law, be trademarks, or be registered, or tradenames be registered.

2. An applicant may, during the examination, make in the application other changes than changing trademarks, tradenames, or amendment in the list of names of goods, or service. For changes in the list of names of goods, service, a new application shall be made.

3. An applicant may, during the examination, make a separate application belonging to more than one classification of goods, service.

4. An applicant may, during the examination, withdraw the application. In that case, the applicant loses the right to make again application for trademarks, tradenames he made.

5. If the last decision on cancellation, or objection to register the application, is made by an expert, or court, the previous application is not considered.

6. The Intellectual Property Office, within 6 months from the filing date of application, and basing on the conclusion of examination, makes a decision on whether to register trademarks, tradenames. If necessary, the Intellectual Property Office may extend the term up to 6 months.

#### Article 10. Registration of trademarks, tradenames and issuance of certificate

1. If the Intellectual Property Office makes a decision to register trademarks, tradenames, these trademarks, tradenames shall be registered in the State record, and issued a certificate of trademarks, tradenames, and the application be stored in the state fund of trademarks, tradenames. The application for trademarks, tradenames registered by the Intellectual Property Office shall be stored for the period of 10 years from the expiry date of certificate.

2. In the certificate of trademarks, name, address, type of activity of the owner of trademarks, main characteristics of trademarks, No and date of decision to issue a certificate, the filing date of application, term of validity of certificate shall be indicated and a member of the Government competent to the matters shall sign and put stamp.

3. In the certificate of tradenames, name of the economic entity, peculiarity of activity, decision of the issuing authority of certificate, filing date, term of validity of the certificate shall be indicated and a member of the Government competent to the matters shall sign and put stamp.

4. If the Intellectual Property Office makes a decision objecting registration of trademarks, tradenames, a copy of the conclusion of the examination shall be sent within 30 days from the date of decision made, to the applicant. In case if the applicant does not agree with the decision made, he may, within 30 days from the date of receipt of the decision objecting registration, apply to the court.

5. The Intellectual Property Office publishes in the press the bibliography, drawings of the trademarks, and tradenames registered.

#### Article 11. Term of validity of the certificate of trademarks, tradenames, its extension

1. The certificate of trademarks, tradenames shall be valid during the period of 10 years from the date of issue.

2. The term of validity of certificate of trademarks, tradenames may be extended basing on the owner's application for 10 years.

3. The application for extension of the term of validity of the certificate shall be submitted to the Intellectual Property Office within the last year of validity of the certificate. The application may, unless submitted before the expiry of the term, be submitted during the period of 6 months from the expiry date.

4. For the extension of the term of validity of the certificate, the list of trademarks, tradenames, names of goods, service shall not be amended.

5. In case if the name, address of the owners of trademarks, tradenames are changed, the Intellectual Property Office, within the period of 6 months, shall be notified in written form. The Intellectual Property Office publishes in the press every time when a decision to extend the term of the certificate of trademarks, tradenames is made, changes in the state record of trademarks, tradenames are made.

#### Article 12. Fee of certificate of trademarks, tradenames

1. For granting and extending the term of certificate of trademarks, tradenames, a fee shall be paid according to the amount reflected in the Law of Mongolia on Stamp-Duty.

2. The fee shall be paid within the period of 3 months from the date of the decision to grant certificate of trademarks, tradenames, to extend the term of certificate of trademarks, tradenames was made.

CHAPTER III  
RIGHTS OF OWNER OF TRADEMARKS, TRADENAMES, OWNERSHIP,  
EXPLOITATION, EXPENDITURE OF TRADEMARKS, TRADENAMES

Article 13. Rights of owner of trademarks, tradenames

1. Registered trademarks, tradenames give an exclusive right to the owner with regard to the trademarks, tradenames.
2. The owner of trademarks, tradenames has the following rights:
  - (I) to exploit registered trademarks, tradenames for his goods, service;
  - (ii) to own his registered trademarks, tradenames / own, exploit, expend/;
  - (iii) to let others to exploit registered trademarks, tradenames under license contract;
  - (iv) to transfer trademarks to others;
  - (v) to get references, confirmation from the Intellectual Property Office on registered trademarks, tradenames;
  - (vi) in the case if his registered trademarks, tradenames are exploited unlawfully by others, to demand to stop it and protection against infringement of his rights,
  - (vii) to demand to stop exploitation of similar trademarks, tradenames to previously registered trademarks, tradenames, and recompensation for occurred damages.

Article 14. Exploitation of trademarks

1. The following actions are considered as an exploitation of trademarks
  - (i) to exploit trademarks for goods, their packaging, service;
  - (ii) to supply goods with trademarks for trade, or stored serve for this purpose;
  - (iii) to import, export goods with trademarks;
  - (iv) to exploit trademarks for official letter, or other documents, advertisements;
  - (v) the owner of trademarks may use letter "c" in circle, which show trademarks were registered, together with trademarks.
2. If a person exploits similar trademarks to registered trademarks without authorisation of the owner of these trademarks, for similar goods, service, it is considered as infringement of rights of ownership.
3. It is not considered as infringement of ownership if registered trademarks are exploited in the following way:

- (i) the owner of trademarks, or a person with owner's authorisation exploits in the country, in the way indicated in paragraph 1 of this Article;
- (ii) the owner of trademarks, or a person with owner's authorisation exploits these trademarks in connection with the goods, if these goods with trademarks are already in the market.

#### Article 15. Exploration of tradenames

1. A legal entity, while participating in civil activities, shall exploit tradenames for advertisement of its goods in packaging, introduction, official documents, exhibition.
2. Tradenames may be exploited by trademarks. In case if trademarks, tradenames are discrepant, trademarks shall prevail.

#### Article 16. Transfer of trademarks to others, termination of rights to own trademarks

1. The owner of trademarks may in whole, or partly, the rights to own trademarks to others by means of inheritance, or other means.
2. The rights to own trademarks may be transferred on the base of a contract. The contract shall be made in written form, and legalized with signiture of both parts, and may be witnessed by notary if so wish.
3. The contract of transfer of trademarks shall be registered in the Intellectual Property Office.
4. The rights to own trademarks shall not be transferred in case if the type, origine, quality, purpose of goods, service, name of place and means of manufacture are misleading the consumers.

The rights to own trademarks terminate by following reasons:

- (i) to transfer completely to others by law, or contract;
- (ii) to lose the rights to own by reason indicated in law;
- (iii) the owner is dead, announced dead;
- (iv) Legal entity is dismantled;
- (v) other reasons indicated in Law.

#### Article 17. Transfer of tradenames

Transfer of exclusive rights to exploit tradenames is forbidden in other cases than a legal entity is restructured, transferred completely to others' ownership.

#### Article 18. License contract

1. Interested person shall make a license contract to exploit trademarks, tradenames with their owner. A license contract shall be made in written form and signed by both parts. In case of an exploitation of tradenames under a license contract, the parties shall pre-agree on measures preventing mislead of consumers.

2. Followings shall be pre-agreed in the license contract:

(i) way, scope, term of exploitation of trademarks, tradenames, quality requirements, inspection for related goods, service;

(ii) rights, duties of parties;

(iii) amount and procedure of payment of recompensation for exploitation of trademarks, tradenames;

(iv) scope of the territory where a license contract is effective

3. License contract shall be registered in the Intellectual Property Office.

4. Collective marks, name of geographical origine of goods shall not be transferred to others by license contract.

#### CHAPTER IV MISCELLANEOUS PROVISIONS

Article 19. Cancellation of certificate of trademarks, tradenames, consideration as invalid

1. An interested person may, if he considers that trademarks are registered breaking the provisions of Article 3 (1), if necessary, Articles 3 (2), (3), 4 (1),(2),(3), and tradenames registered against the provisions of Article 5 (3)-(7), make a request to the court to cancel these trademarks, tradenames.

2. An interested person may, if he considers that trademarks are registered against the provisions of Article 4 (3), iv,v,vi of this Law, apply to the court to cancel the certificate within the period of 5 years from the registration date of the trademarks.

3. If the court, after examination, considers justified, makes a decision to cancel the registration of trademarks, tradenames, ad inform the Intellectual Property Office in written form.

4. The Intellectual Property Office considers the certificates of trademarks, tradenames as invalid in the following cases:

(i) an application to extend term is not submitted within the period of 6 months from the expiry date of certificate of trademarks, tradenames;

(ii) a fee indicated in Article 12 of this Law is not paid in due time;

(iii) owners of trademarks, tradenames informed in written form refusal of the rights of registered trademarks, tradenames;

(iv) economic entity that owns trademarks, tradenames did not transferred under license contract the rights to own these trademarks, tradenames after its dismantle

(v) owners of trademarks, tradenames did not, without any reason, exploit trademarks for 5 years, tradenames for 3 years from their registration.

5. An interested person has the right to apply to the court within the period of 30 days if he disagree with the decision to cancel certificate of trademarks, tradenames.

6. An interested person may, in connection with the provisions of paragraph 4,(iv) of this Article, submit an application for cancellation of certificate of trademarks to the Intellectual Property Office.

7. In case if certificate of trademarks, tradenames is cancelled, the Intellectual Property Office shall make necessary amendments in the state record of trademarks, tradenames, and shall publish in the press.

#### Article 20. Settlement of disputes, grievances

1. The Intellectual Property Office shall settle the following dispute, grievances concerning trademarks, tradenames:

(i) examination in the application for trademarks, tradenames;

(ii) according of filing and priority date;

(iii) rights to be an author.

2. The Intellectual Property Office has the duty to settle disputes and grievances and respond within the period of 30 days from the date of their receipt.

3. If the disputing parties disagree with the decision of the Intellectual Property Office, they may, within 30 days from the receipt of decision, apply to the court.

4. The court shall settle all disputes, grievances except those entitled by Law to the Intellectual Property Office.

#### Article 21. Liability for violation of legislation concerning trademarks, tradenames

1. A person who commits a violation of legislation concerning trademarks, tradenames shall be liable to a fine of up to 2000-50000, an economic entity liable to a fine of up to 10000-250000 tugrigs, and the profits gained from the unlawful exploitation of trademarks, tradenames shall be paid to the owner of trademarks, tradenames, and profits gained from sale of goods shall be transferred to the state ownership, and production and service activities shall be stopped by the judge unless any criminal liability is provided.

2. A person who infringes the rights of owners of trademarks, tradenames shall be liable under the legislation of Mongolia.

Article 22. Enforcement of the Law on trademarks, tradenames

The court may use the previous enforcement with regard to relations arised in connection with trademarks, tradenames, before adoption of the Law on trademarks, tradenames unless they damage to the interests of parties.

Article 23. Entry into force

This Law shall enter into force on February 1, 1997.