

LAW OF MONGOLIA ON TRADE NAMES AND TRADEMARKS

Chapter One General Provisions

Article 1. Purpose of the law

The purpose of this law is to ensure legal guarantees for trademarks and trade names, to protect the rights and legal interests of their owners, and to regulate relations concerning the ownership, use and disposal of trademarks and trade names.

Article 2. Legislation on trademarks and trade names

1. The legislation on trademarks and trade names shall consist of the Constitution of Mongolia, the Civil Law, this law and other legislative acts issued in conformity with them.
2. If an international treaty to which Mongolia is party is inconsistent with this law, then the provisions of the international treaty shall prevail.

Article 3. Definitions in this law

In this law the following terms shall have the following meanings:

- 1) “trademark” means letters, numerals, figurative shapes or a combination of those means of expression which have particular significance and which are used by a legal person or individual who is in the business of production or the provision of services, in order to distinguish that production or service from that of others;
- 2) “collective mark” means a trademark used by members of an association of business entities, which is established in accordance with provisions specified in legislation for carrying out similar production or providing similar services, for goods or services with co-operative characteristics and used under the supervision of the association;
- 3) “place of origin” means the name of the country, city, village or place where goods are produced which have characteristics directly linked with its geographical conditions and the customs of its people;
- 4) “trade name” means a name used by a legal person in accordance with the relevant regulations for carrying out its activities;
- 5) “registered mark” means a trademark or trade name registered in the State register by the Intellectual Property Office and in respect of which a certificate is issued in accordance with relevant procedures;
- 6) “owner of a trademark” means a person who acquires the right to own, use, and charge for the use of a registered mark in accordance with the procedure provided by law;
- (vii) “application” means an application along with any other documents required by law which is submitted to the Intellectual Property Office by a legal person or individual in order to register a trademark or trade name;

- 8) “examination” means the check performed by an authorised officer of the relevant organisation on whether a similar trademark or trade name has previously been registered and in respect of which a certificate has been issued;
- 9) “licence” means the permission given by the owner of a trademark or trade name to another person to use the trademark or trade name after registration by the Intellectual Property Office;
- 10) “filing date” means the date on which an application for a trademark or trade name is received by the Intellectual Property Office in accordance with article 7 of this law;
- 11) “priority date” means the date on which a trademark is received for registration in any member State of the Paris Convention for the Protection of Industrial Property or to be given a priority date in accordance with article 4 of that Convention;
- 12) “international categories for trademarks” refers to the Nice Agreement of 1957 concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks and the Vienna Agreement of 1973 establishing an International Classification of the Figurative Elements of Marks.

Article 4. Registrable trademarks and requirements for registration

1. Trademarks that meet the requirements provided in paragraph 1 of article 3 of this law shall be registered.
2. The following items shall not be considered to be trademarks:
 - 1) words or figurative shapes which represent things and phenomena;
 - 2) common names, formulae, figurative shapes, common geometrical shapes, numerical expressions or indecipherable letters or marks;
 - 3) words or figurative shapes which explain the origin, quantity, weight, quality, purpose or price of goods, the name of the manufacturer or the method or date of manufacture;
 - 4) anything which could be in any way misleading;
 - 5) place names or abbreviations of them or maps or signs showing locations;
 - 6) human names expressed in an undistinctive manner;
 - 7) common expressions of common undistinctive places.
3. The following marks shall not be registered:
 - 1) trademarks that are identical or similar to the national emblem, flags, whole or abbreviated names of mass or international organisations, or official badges of Mongolia or other foreign countries;
 - 2) whole or abbreviated names, portraits, pictures or signatures of famous people used without their permission or that of their heirs;
 - 3) names, pseudonyms, portraits, pictures or titles of imaginative or historical persons of Mongolia used without permission of the competent authorities;
 - 4) words or figurative shapes protected by copyright or industrial design patents of Mongolia used without permission of the author or the owner of rights with respect to them;

5) trademarks which are similar to trademarks used for other goods and services which are registered in Mongolia or which have been submitted for registration;

6) trademarks similar to common trademarks of Mongolia;

7) trademarks whose content is prejudicial to public order and morality.

4. The name of the origin of goods shall be registered only by way of a collective mark.

Article 5. Requirements for the registration of trade names

1. A business entity shall have a name and the exclusive right to use it.
2. Rights with respect to trade names shall begin after entry in the State register and the issuance of a certificate.
3. A trade name shall not be registered in the following cases:
 - 1) if it is similar/identical to a previously registered trade name;
 - 2) if it expresses the legal status of the business entity;
 - 3) if the business entity is not established and registered in accordance with law;
 - 4) if the trade name is expressed by numbers.
4. A trade name shall be brief and written in Cyrillic script. A business entity may register a trade name written in Cyrillic script together with a trade name written in the Latin alphabet if it so wishes.
5. The form of the business entity shall be written after the trade name.
6. A trade name consisting of two or more words shall be written in the following way:
 - 1) if the trade name consists of two words and the second one starts with a consonant, it shall join the first word;
 - 2) if the trade name consists of two words and the second one starts with a vowel, it shall be preceded by a hyphen (-) and start with a capital letter;
 - 3) if the trade name consists of three words and the second one starts with a consonant, the first and second words shall be joined and the third word shall be written after a one-letter space, the first letter to be in lower case;
 - 4) if the trade name consists of three words and the second one starts with a vowel, the second and third words shall be written with a one letter space between them and the first letter of the third word shall be in lower case.
7. A trade name need not have any particular meaning or may have a meaning expressed in brief or may consist of a single letter or syllable and in that case its letters shall all be written in capitals. The letters shall be joined with no symbol between them.
8. A business entity may register its trade name as a whole or in an abbreviated form convenient for daily use and may use the shorter form of the trade name as a trademark. In that case, the trade name shall be registered in accordance with the law in the same way as a trademark.

Article 6. Duties of the Intellectual Property Office with respect to trademarks and trade names

1. The Intellectual Property Office shall carry out the following functions with respect to the registration of trademarks and trade names:
 - 1) receive and decide upon applications for trademarks and trade names;
 - 2) register trademarks and trade names and issue certificates;
 - 3) provide facts for the settlement of disputes by courts with respect to trademarks and trade names;
 - 4) decide on applications and complaints as provided by law;
 - 5) establish a design for certificates of trademarks and trade names;
 - 6) keep a single State register of trademarks, associated contracts and trade names, establish a unified database and publish related information;
 - 7) cancel trademarks and trade names for the reasons and on the basis of regulations provided by law;
 - 8) perform the functions set out in sub-paragraphs 8, 10, 11, 13 and 15 of paragraph 1 of article 5 of the Patent Law and sub-paragraphs 11 and 12 of paragraph 1 of article 6 of the Copyright Law.
2. On the request of an author, the Intellectual Property Office may value works related to trademarks and trade names.

Chapter Two Registration of Trademarks and Trade Names and the Issuance of Certificates

Article 7. Applications for trademarks and trade names

1. A legal person or individual who wishes to register a trade name or trademark shall make an application with respect to that trademark or trade name to the Intellectual Property Office.
2. An application for a trademark shall consist of the application and 10 copies of a graphical representation of the trademark.
3. An application for a trade name shall consist of the application, an enlargement of the written form of the trade name and a copy of the State registration certificate of the business entity.
4. An application should include the surname and name, address and nationality of the applicant or his authorised representative, the date and number of the application, the type of business of the applicant, a request for registration of the trademark or trade name and a graphical representation of the trademark or trade name.
5. If an applicant wishes to register a sign, a collective mark of form of volume, or of colour, he or she shall address this in the application and shall attach a copy of the procedure for use of the mark to the application.
6. If an applicant wishes to register the name of the origin of the goods, he or she shall address this in the application and attach documents confirming the name of origin and his or her right to use it to the application.

7. If trademarks and trade names are expressed in scripts other than Cyrillic or the Latin alphabet, the script shall be transliterated into the Latin alphabet and included with the application.

8. An application for a trademark may specify one or more international categories of goods or services.

9. Prior to State registration of a trade name, an applicant may inquire whether a selected name is similar/identical to a previously registered name.

10. If the selected trade name is only different from a name previously registered by a legal person by virtue of a marginal sign of type, number, letter, or word showing the form of the business entity, the selected name shall be considered to be similar and shall not be registrable.

11. The provisions of paragraphs 6, 7 and 8 of article 6 of the Patent Law of Mongolia shall also apply.

Article 8. Filing date for applications for trademarks and trade names

1. Within 20 days of receiving an application for a trade name, the Intellectual Property Office shall examine the materials relevant to the application and, if the application meets the requirements set out in articles 4 and 5 of this law, shall record the date it received the application as the filing date.

2. If the Intellectual Property Office finds that the application does not meet the requirements set out in articles 4 and 5 of this law, it shall require the applicant to make amendments and alterations within 2 months and shall return the application to the applicant. If the applicant makes amendments and alterations during that period and resubmits the application, the Intellectual Property Office shall record the date of that receipt of the application as the filing date.

3. If the required amendments and alterations are not made and submitted to the Office within the period set out in paragraph 2 of this article, the Intellectual Property Office shall refuse to accept the application.

4. If an individual or legal person applies to register a trademark within 6 months from the date of exposing the goods in the following exhibitions, the filing date shall be recorded as the date of exposure of the goods at the exhibition:

- 1) an exhibition organised by a competent central or local administrative body;
- 2) an exhibition organised on the authority of a competent central or local administrative body;
- 3) an exhibition organised in a foreign country;
- 4) an exhibition organised in the territory of a member country of the Paris Convention by, or with the permission, of the Government of that country.

Article 9. Examination of applications for trademarks and trade names

1. If the Intellectual Property Office finds that an application meets the necessary requirements, it shall examine whether the symbol may be registered as a trademark or trade name in accordance with this law.
2. While the matter is being examined, an applicant may change the application other than by altering the trademark or trade name or by amending the list of names of goods and services. A new application shall be submitted if any change in the list of names of goods is to be made.
3. While the matter is being examined, the applicant may make a separate application with respect to a different category of goods or services.
4. An applicant may withdraw the application while it is being examined. In that case, the applicant shall lose the right to reapply for that trademark or trade name.
5. If a final decision to reject the application or refuse the registration is made by an expert or a court, it shall be considered that such an application was not submitted.
6. Based on the conclusions of its examination, the Intellectual Property Office shall decide whether to register a trademark or trade name within six months from the filing date of application. If necessary, the Intellectual Property Office may extend the term for up to six months.

Article 10. Registration of trademarks and trade names and the issuance of certificates

1. If the Intellectual Property Office decides to register a trademark or trade name, that trademark or trade name shall be entered in the State register, a certificate of trademark or trade name shall be issued and the application shall be stored in the database of trademarks and trade names. The application for a trademark or trade name registered by the Intellectual Property Office shall be stored for a period of 10 years from the expiry of the certificate.
2. The surname and name, address, type of business of the owner of the trademark, the main characteristics of the trademark, the number and date of the decision to issue a certificate, the filing date of the application, and the term of validity of the certificate shall be included on the trademark certificate and the member of the Government authorised to do so shall sign and stamp it.
3. The name of the business entity, the type of business it is engaged in, the decision of the authority that issued the certificate, the filing date and the period of validity of the certificate shall be included on the trade name certificate and the member of the Government authorised to do so shall sign and stamp it.
4. If the Intellectual Property Office refuses to register a trademark or trade name, a copy of the application and the conclusion of the examination shall be sent to the applicant within 30 days from the date of the decision. If the applicant does not agree with the decision, he or she may apply to the court within 30 days from the date of receiving the decision refusing registration.

5. The Intellectual Property Office shall publish in the press the bibliography and graphical representations of registered trademarks and trade names.

Article 11. Term of validity of certificates of trademarks and trade names and their extension

1. A certificate of trademark or trade name shall be valid for a period of 10 years from the date of its issuance.

2. The period of validity of a certificate of trademark or trade name may be extended on the application of the owner for a period of ten years.

3. An application for extension of the term of validity of a certificate shall be made to the Intellectual Property Office during the last year of validity of the certificate. Unless submitted before expiry of the period, an application may be made within six months from the expiry date.

4. In extending the period of validity of a certificate, the list of categories of goods and services to which the trademark or trade name applies shall not be amended.

5. If the name or address of the owner of a trademark or trade name changes, the Intellectual Property Office must be notified in writing within six months. The Intellectual Property Office shall publish in the press each decision to extend the term of a certificate of trademark or trade name and any change in the State register of trademarks and trade names.

Article 12. Fees for certificates of trademarks and trade names

1. For granting or extending the term of a certificate of trademark or trade name, a fee shall be paid in accordance with the rate and amount provided in the Law of Mongolia on Stamp Duties.

2. The fee shall be paid within three months from the date of making the decision to grant the certificate of trademark or trade name or to extend the term of validity of a certificate of trademark or trade name.

Chapter Three Rights of Owners of Trademarks and Trade Names, Ownership, Use and Disposal of Trademarks and Trade Names

Article 13. Rights of owners of trademarks and trade names

1. The registration of trademarks and trade names shall give their owners exclusive rights with respect to them.

2. An owner of a trademark or trade name has the following rights:
1) to use the registered trademark or trade name for his or her own goods and services;
2) to own, exploit, and/or dispose of his or her registered trademarks or trade name;

- 3) to permit others to use the registered trademark or trade name by way of licence contract;
- 4) to transfer the trademark to others;
- 5) to get information and confirmation from the Intellectual Property Office on registered trademarks and trade names;
- 6) if his or her registered trademark or trade name is used unlawfully by others, to require such to cease and to be protected against breach of his or her rights;
- 7) to demand cessation of the use of trademarks or trade names that are similar to previously registered trademarks and trade names and to be compensated for losses suffered.

Article 14. Use of trademarks

1. The following actions shall be considered as being appropriate uses of a trademark:
 - 1) use of trademarks for goods, packaging and services;
 - 2) supply of goods with trademarks for trade or supply or storage purposes;
 - 3) the import or export of goods with trademarks;
 - 4) the use of trademarks on official letters, other documents or advertisements;
 - 5) an owner of a trademark may use Latin letter "c" in circle beside the trademark to show that the trade mark is registered.
2. If a person uses a trademark which is similar to a registered trademark for similar goods or services without the authority of the owner of that trademark, such shall be considered a breach of the owner's rights.
3. It shall not be considered to be a breach of ownership rights if registered trademarks are used in the following ways:
 - 1) if the owner of a trademark or a person with the owner's authority uses the trademark in any of the ways set out in paragraph 1 of this article within the country;
 - 2) if the owner of a trademark or a person with the owner's authority uses that trademark in connection with goods if those goods with that trademark are already in the market of that country.

Article 15. Use of trade names

1. While participating in civil activities, a legal person shall use a trade name to advertise its goods by way of packaging, introductions, official documents and exhibitions.
2. Trade names may be used in the same way as trademarks. If there is a discrepancy between a trademark and a trade name, the trademark shall prevail.

Article 16. Transfer of trademarks to others and termination of rights to own trademarks

1. An owner of a trademark may transfer, in whole or in part, the right to own the trademark to others by way of inheritance or other means.

2. The right to own a trademark may be transferred by way of contract. The contract shall be in writing and executed with the signature of both parties, and may be certified by notary if they so wish.
3. A contract for transfer of a trademark shall be registered in the Intellectual Property Office.
4. The right to own a trademark shall not be transferred if the type, origin, quality, purpose of goods or services or the name of the place or means of manufacture mislead consumers.

The right to own a trademark shall be terminated in the following cases:

- 1) the complete transfer to others by way of law or contract;
- 2) the loss of rights of ownership for reasons provided in law;
- 3) the death of the owner or a declaration that he or she is deceased;
- 4) the dissolution of a legal person;
- 5) other reasons provided by law.

Article 17. Transfer of trade names

Transfer of exclusive rights to use trade names shall be prohibited except where a legal person is restructured or wholly transferred to the ownership of others.

Article 18. Licence contract

1. An interested person shall make a licence contract to use a trademark or trade name with its owner. A licence contract shall be recorded in writing and signed by both parties. In case of a use of a trade name under a licence contract, the parties shall agree on measures to prevent the misleading of consumers.
2. The following shall be agreed in the licence contract:
 - 1) the methods, scope and period of use of the trademark or trade name, quality requirements and the inspection of relevant goods or services;
 - 2) the rights and duties of the parties;
 - 3) the amount and procedures for payment of fees for the use of the trademark or trade name;
 - 4) the range of territory where the licence contract is to be effective.
3. A licence contract shall be registered in the Intellectual Property Office.
4. Collective marks and use of the names of the geographical origin of goods shall not be transferred to others by licence contract.

Chapter Four Miscellaneous Provisions

Article 19. Cancellation of certificates of trademarks and trade names and consideration as invalid

1. If an interested person considers that a trademark has been registered in breach of the provisions of sub-paragraph 1 of article 3 or, if necessary, sub-paragraphs 2 and/or 3 of article 3 and paragraphs 1, 2 and/or 3 of article 4 or a that trade name has been registered in breach of the provisions of paragraphs 3-7 of article 5 of this law he or she may request a court to cancel that trademark or trade name.

2. If an interested person considers that a trademark has been registered in breach of the provisions of sub-paragraphs 4, 5 and/or 6 of paragraph 3 of article 4 of this law, he or she may request a court to cancel the certificate within the period of 5 years from the registration date of the trademark.

3. If, after examination, the court considers the request justified, it shall decide to cancel the registration of the trademark or trade name and shall inform the Intellectual Property Office in writing.

4. The Intellectual Property Office shall treat a certificate of trademark or trade name as invalid in the following cases:

1) if an application to extend its term is not submitted within the period of 6 months from its expiry date;

2) if the fee provided in article 12 of this law is not paid on time;

3) if the owner of the trademark or trade name repudiates in writing the rights of ownership to registered trademarks or trade names;

4) if, on dissolution, the business entity that owns the trademark or trade name does not transfer the right to own that trademark or trade name by way of licence contract;

5) if the owner of the trademark or trade name does not, without any reason, use the trademark for 5 years or trade name for 3 years from its

registration.

5. An interested person may apply to the court within 30 days if he or she disagrees with a decision to cancel a certificate of trademark or trade name.

6. An interested person may, with respect to the provisions of sub-paragraph 5 of paragraph 4 of this article, submit an application for cancellation of a certificate of trademark to the Intellectual Property Office.

7. If a certificate of trademark or trade name is cancelled, the Intellectual Property Office shall make any necessary amendments in the State register of trademarks and trade names and shall publish that in the press.

Article 20. Settlement of disputes and grievances

1. The Intellectual Property Office shall settle the following disputes and grievances with respect to trademarks and trade names:

1) examination of applications for trademarks and trade names;

2) the according of filing and priority dates;

3) rights of authorship.

2. The Intellectual Property Office must settle disputes and grievances and respond within a 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 apply to the court within 30 days from receiving the decision.

4. The court shall settle all disputes and grievances except those falling within the jurisdiction of the Intellectual Property Office by law.

Article 21. Liability for breach of legislation on trademarks and trade names

1. If a breach of the legislation on trademarks and trade names is held not to constitute a criminal offence, a judge shall impose on an offending person a fine of up to 2,000-50,000 togrogs or on an offending business entity or organisation a fine of up to 10,000-250,000 togrogs, profits gained from the unlawful use of a trademark or trade name shall be paid to the owner of the trademark or trade name, profits gained from the sales of goods shall be transferred to the State ownership and production and service activities shall be stopped.

2. A person who breaches the rights of owners of trademarks or trade names shall be liable under the legislation of Mongolia.

Article 22. Enforcement of the legislation on trademarks and trade names

Unless it is contrary to the interests of the parties, a court may use the regulation previously enforced with respect to the rights and obligations arising with respect to trademarks and trade names prior to the passage of the Law on Trademarks and Trade Names.

Article 23. Effective date of the law

This law shall come into effect on 1 February 1997.

Chairman of the State Ih Hural of Mongolia

R. Gonchigdorj