



**Arzinger** 

**INTELLECTUAL  
PROPERTY RIGHTS**



## INTELLECTUAL PROPERTY RIGHTS

In the context of innovations, development of world trade and international system of intellectual property our practice is moving ahead. Members of our team have joined Ukrainian and international IP-organizations, such as

International Trademark Association (INTA), Ukrainian national group of International Association for the Protection of Intellectual Property (AIPPI).

### WE PROVIDE A FULL-SERVICE OFFERING WHICH INCLUDES:

#### — **Dispute resolution:**

- Combating international trade in counterfeit goods
- Protection of trademarks and well known marks
- Protection of inventions, industrial designs, utility models etc.
- Protection of author rights and related rights, in particular, on the internet and in film industry
- Protection of confidential information and trade secrets
- Contractual relations with regard to intellectual property rights
- Unfair competition cases

#### — **Consulting on IP law:**

- Consulting on multiply legal issues related to IP rights
- Complex legal audit in IP law
- Legal analysis of documents

#### — **Drafting documents and agreements:**

- Individual and collective labor agreements covering protection of IP rights
- License agreements
- Agreements on assignment of exclusive IP rights
- Franchise agreements
- Author agreements
- Non-disclosure agreements
- Agreements on research and development (D&R)

#### — **Registration in Ukraine and abroad:**

- Trademarks, industrial designs, inventions, utility models
- Domain names
- Author rights and related rights
- Agreements regulating management of intellectual property rights
- Legal assistance in determining whether a trademark is well known in Ukraine

# SELECTED INTELLECTUAL PROPERTY LAW PROJECTS

## 1. REPRESENTING A WORLD LEADING MANUFACTURER AND EXPORTER OF SPICE MIXTURES FOR THE FOOD INDUSTRY IN A PATENT LITIGATION CASE TRIED BEFORE COMMERCIAL COURTS OF UKRAINE

On behalf of our client we initiated and won a commercial dispute on revocation of the patent of Ukraine for industrial design as being issued in violation of patentability requirements. The claim for revocation of the patent of Ukraine was based and proved by the fact that the patented industrial design did not meet the condition of novelty since the claimed subject matter i.e. essential features, thereof were disclosed in the world before the date of filing.

## 2. REPRESENTING A NATIONAL FMCG MANUFACTURER IN A CEASE AND DESIST ACTION ON INDUSTRIAL DESIGN INFRINGEMENT

We represented and provided defense in a cease and desist action on industrial designs (branded bottle) infringement (packaging materials for FMCG industries) against a national competitor (Slavutich (BBH)). The use of the industrial design was sustained at the pre-trial stage.

## 3. REPRESENTING THE INTERESTS OF THE CLIENT IN THE ANTIMONOPOLY COMMITTEE OF UKRAINE (AMCU) IN A CEASE AND DESIST ACTION ON UNFAIR COMPETITION

We represented the client's interests in a cease and desist action against local entities infringing on a trade mark under international registration. Unauthorized use of the trademark was recognized as anti-competitive practices in form of business reputation misuse. The legal claims were enforced through the regional department of the Antimonopoly Committee of Ukraine.

## 4. REPRESENTING LYSOFORM CLOSED JOINT STOCK COMPANY (UKRAINE) AND LYSOFORM DESINFEKTION AG (SWITZERLAND) IN A TRADEMARK LITIGATION CASE

We instituted and won a cease and desist action against the research and production association TOV "Simesta Waal" (Ukraine). On behalf of the client we laid a claim on prohibiting the use of a label placed on the goods and demanded to remove or destroy the label applied since the use of the label concerned violated proprietary rights under an internationally registered trademark.

## 5. REPRESENTING A FAMOUS INTERNATIONAL EXHIBITION COMPANY IN A DISPUTE CONCERNING ILLEGITIMATE ALIENATION OF THE IP RIGHTS

We represented our client's interests in a dispute concerning alienation of the rights to the IP object owned by a legal entity effectuated by the executive manager of the legal entity concerned for understated price. The dispute was settled with an amicable agreement between the parties.

## 6. REPRESENTING AND ADVISING A LARGE NATIONAL INDUSTRIAL ENTERPRISE, A MEMBER OF A GLOBAL AGRIBUSINESS AND FOOD COMPANY BUNGE, ON RESISTING A RAIDER ATTACK ON THE TRADEMARK IN COURT AND ADMINISTRATIVE PROCEEDINGS

We represented and advised the client on defending the rights to the internationally registered trademark being attacked in the course of a hostile takeover of the subsidiary to Bunge in Ukraine. In the raider attack a number of claims on prohibiting the use of the trademark along with request to terminate international registrations of the trademark in Ukraine were brought. Finally, the trademark concerned was declared a well-known mark in Ukraine and the right of our client to its use granted to him under the license agreement was thus recognized.

## 7. REPRESENTING A MAJOR UKRAINIAN BANK, A MEMBER OF THE INTERNATIONAL BANK GROUP, IN REGISTRATION PROCEDURES OF TRADEMARKS IN UKRAINE; ADVISING ON ENFORCEMENT AND PROTECTION OF INTELLECTUAL PROPERTY RIGHTS TO THE TRADEMARKS

On behalf of the client we drafted a license agreement authorizing the use of a trademark under international registration in Ukraine, provided assistance with the national registration of trademarks and domain names in Ukraine, elaborated legal papers required for registration, etc. Upon request of the bank we conducted legal audit and provided legal opinion on illegitimacy of using the signs confusingly similar with the trademarks owned by the bank as violating the proprietary rights of the bank.

## 8. REPRESENTING NORDFOLIEN GMBH (GERMANY), INTERNATIONAL SPECIALIST IN HANDLING INDUSTRIAL PACKAGING, IN THE NATIONAL PART OF THE PCT IN UKRAINE

On behalf of German Patent Attorneys Association we instituted and performed a national procedure for patenting an invention (packaging material) under the Patent Cooperation Treaty. Our services encompassed technical translation of the international application, its adaptation to the legal requirements of Ukraine, filing the application with the State Patent Office of Ukraine, communicating and following through the patenting procedure.

## 9. REPRESENTING AND ADVISING REED MESSE WIEN GMBH (AUSTRIA), A SUBSIDIARY TO THE WORLD LEADER IN ORGANIZING SPECIALIST EXHIBITIONS, FAIRS AND BUSINESS EVENTS, ON THE ENFORCEMENT AND PROTECTION OF IP RIGHTS IN UKRAINE

We took over representation of the client in the State Department of Intellectual Property of Ukraine in the matters of registering trademarks and agreements on assignment of exclusive IP rights to the internationally registered trademarks in Ukraine, elaborated agreements regulating assignment of economic IP rights, advised on the management of IP rights to the trademarks in Ukraine, conducted legal analysis of license agreements upon compliance thereof with the law of Ukraine.

**10. CONDUCTING IP LEGAL DUE DILIGENCE FOR THE EUROPE'S LEADING PROVIDER OF ONSITE MARKETING SOLUTIONS**

The IP due diligence investigation was performed as a part of complex legal audit of a Ukrainian provider of web solutions considered as a target company in a planned transaction. The legal due diligence was performed in order to identify and, where applicable, to mitigate and eliminate risks resulting from IP management, assignment of rights to the IP objects created by employees within labor legal relations, maintaining secrecy and ensuring protection of trade secret from disclosure realized in violation of law.

**11. CONDUCTING LEGAL IP DUE DILIGENCE OF THE BIGGEST UKRAINIAN PROVIDER OF SOLUTIONS IN THE SPHERE OF PHARMACEUTICAL MARKETING AND SALES**

In the course of legal due diligence selected IP objects, i.a. databases, works produced by employees within the labor relations, trademarks, computer programs, commercial names, were inventoried and investigated as intangible assets of the company; these were examined upon legitimacy of using thereof while running business activities, and by conducting marketing research and providing services, in particular. The IP law issues were considered in the context of international contractual relations, labor, tax and corporate law.

**12. REPRESENTING THE PUBLISHING HOUSE BURDA VERLAG MEDIEN (GERMANY) IN A DISPUTE AGAINST LAKTALIS UKRAINE (TRADEMARK PRESIDENT) ON INDEMNIFICATION FOR NON-PECUNIARY DAMAGES**

We represented interests of the international publishing house Burda Verlag Medien in a legal action brought by Laktalis Ukraine, owner of the trademark PRESIDENT, for indemnification for non-pecuniary damages and disproving the published information as untrue.

**13. ADVISING A LARGE UKRAINIAN ENTERPRISE, MANUFACTURER AND IMPORTER OF ADHESIVES, SEALANTS AND SURFACE TREATMENTS, IN A CASE PERTAINING TO PROTECTION FROM ANTI-COMPETITIVE PRACTICES AND UNAUTHORIZED USE OF A TRADEMARK**

We advised our client on protecting from unauthorized use of a trademark on the Internet and defending from anti-competitive practices realized in discrediting a business entity via spreading inaccurate data damaging its reputation; the data were placed on the websites under the names identical to the trademark owned by the business entity concerned.

**14. REPRESENTING THE UKRAINIAN PUBLISHING HOUSE, THE LEADER IN THE UKRAINIAN MARKET OF PERIODICALS IN TERMS OF SALES AND AUDIENCE COVERAGE, IN A CASE ON VIOLATION OF INTELLECTUAL PROPERTY RIGHTS TO A TRADEMARK**

We successfully represented the interests of our client in the State Department of Intellectual Property of Ukraine in a matter on objecting application to the trademark in Ukraine on the grounds that the sign applied for registration as a trademark did not meet the requirements for legal protection.

**15. REPRESENTING THE MEDIA CONCERN HUBERT BURDA MEDIA (GERMANY) IN COURT AND BEFORE THE ANTIMONOPOLY COMMITTEE OF UKRAINE (AMCU)**

We represented the interests of our client before the AMCU and in court in a case on nullifying the decision of the AMCU on recognizing the actions of our client as unfair competition in form of discrediting a business entity, imposing a penalty and obligating "Burda" to disprove the published information as untrue.



## OUR TEAM



### Igor Darmogray, Counsel

**Education:** Institute of Intellectual Property and Law at the State Department of Intellectual Property of Ukraine, Specialist in Intellectual Property Law

Kyiv National Taras Shevchenko University, Specialist in Law

Institute of International Relations, Kyiv National Taras Shevchenko University,

Master of International Relations and Interpreter of the English Language

Brigham Young University (Utah, USA), MA in International and Area Studies

**Experience:** Igor specializes in intellectual property law, court representation and international arbitration, tax law and international public law. He has extensive experience in: obtaining legal protection of intellectual property; representation in ordinary, commercial and administrative courts in Ukraine and before adjudicative bodies under foreign jurisdictions and in international commercial arbitrations. Igor has worked as a Counsel at Arzinger since 2007. Prior to this he held a position of Counsel at the Ukrainian Embassy in Germany, and was Third Secretary at the Department of Policy, Planning and Analysis at the Ministry of Foreign Affairs of Ukraine.

**Languages:** Ukrainian, Russian, English, and German



### Andriy Kiyashko, Of Counsel

**Education:** National Technical University of Ukraine «Kyiv Polytechnic Institute», Diploma in Thermo-physics

National Technical University of Ukraine «Kharkiv Polytechnic Institute»,

Diploma in Intellectual Property Management

State Institute of Intellectual Property, Kyiv

Qualified as a Patent Attorney (State Registration No. 228)

**Experience:** Andriy Kiyashko specializes in Intellectual Property.

He has extensive experience as a qualified IP professional. Since 2002 he has been a registered Patent Attorney; in this capacity he has prepared more than 1500 applications for trademarks, industrial design, inventions and utility models. Prior to joining Arzinger he worked in the Ukrainian Patents Office, as Principal Examiner of Inventions at the Construction and Mining Department.

**Languages:** Ukrainian, Russian, English



### Iryna Lishchuk, Associate

**Education:** Interregional Academy of Personnel Management (Ukraine),

specialist in law, international commercial law

National Technical University of Ukraine «Kyiv Polytechnic Institute» (Ukraine),

translator of English and German languages

Julius-Maximilian-University (Wurzburg, Germany), postgraduate program on data processing, law studios.

Institute of International Communication and Culture (Bayreuth, Germany),

summer course on international economic relationships

**Experience:** Iryna Lishchuk specializes in intellectual property law and competition law.

She has wide experience in intellectual property law, data and IP rights protection in the Internet, foreign economic activity. She has been working with Arzinger since 2007.

**Languages:** Ukrainian, Russian, German and English



### Volodymyr Tereshchenko, Associate

**Education:** Institute for International Relations, National Taras Shevchenko University Kyiv,

Master degree in International Relations with honor, translator of German language.

Institute for Political Science, Wilhelm Westfalen University (Muenster, Germany)

Dr. Phil. in political science

National Taras Shevchenko University Kyiv, lawyer

**Experience:** Volodymyr Tereshchenko specializes in intellectual property rights related issues, protection of intellectual property rights to industrial designs, tax matters, corporate law and foreign economic activity.

He has worked with major state companies. He has been working with Arzinger as associate lawyer since 2007.

**Languages:** Ukrainian, Russian, German and English



### Pavlo Barbul, Associate

**Education:** Ukrainian State University of Finance and International Trade (Ukraine)

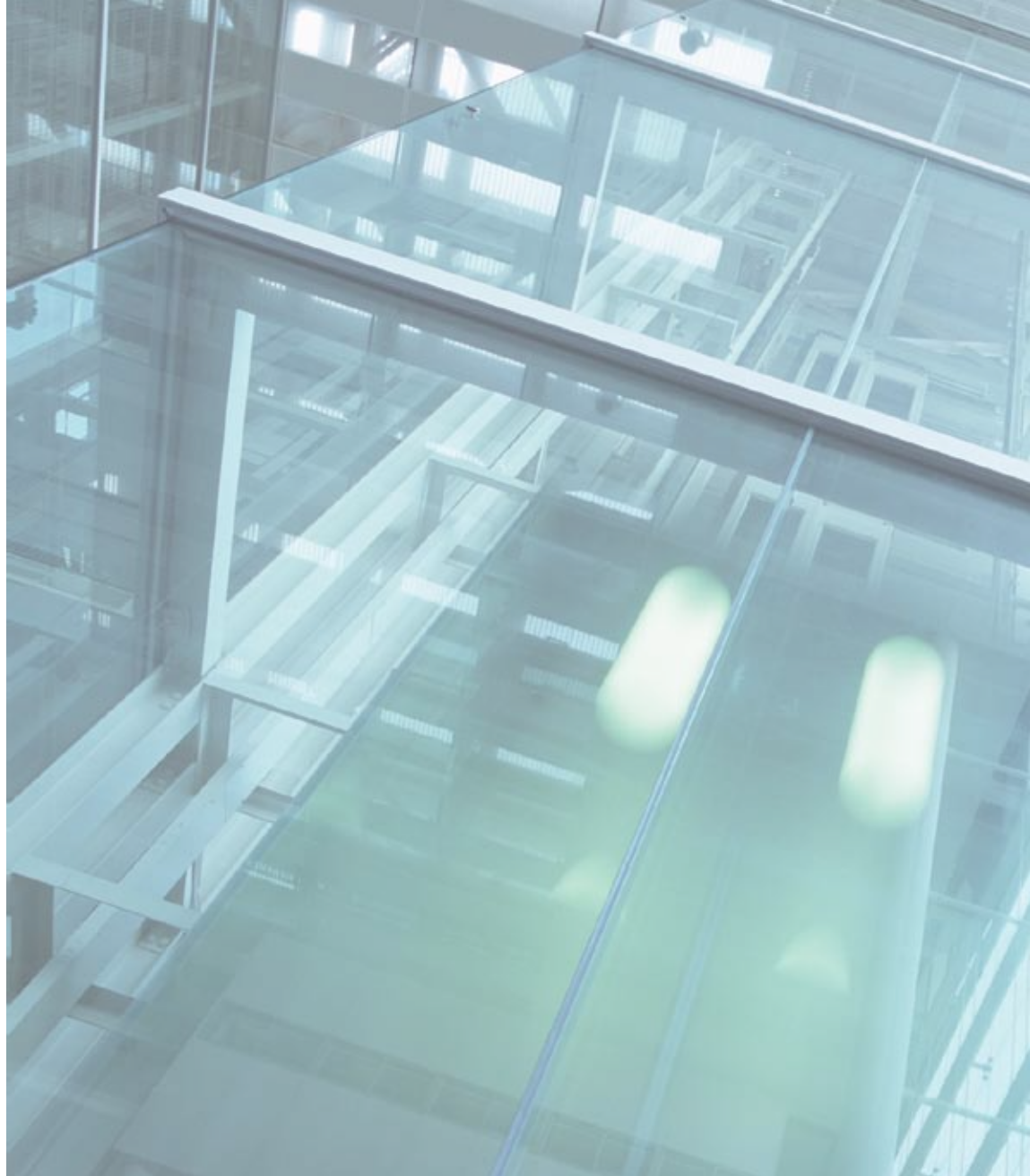
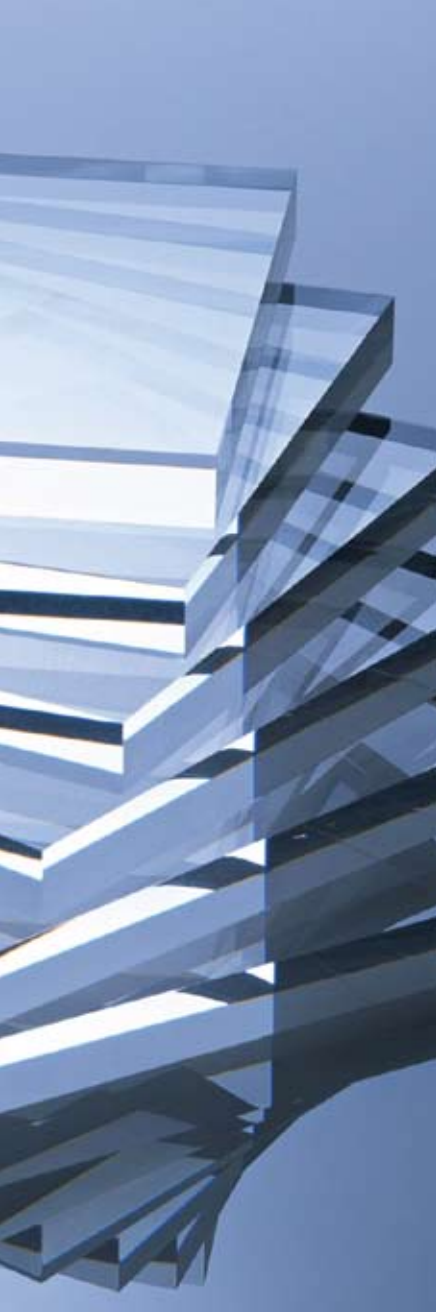
**Experience:** Pavlo Barbul specializes in intellectual property law, corporate law/ M&A, antitrust and competition law.

He also has experience in protection of intellectual property rights in administrative and court proceedings.

Before his joining Arzinger he worked as an in-house counsel in a leading Ukrainian machinery holding.

He has been working with Arzinger since 2007.

**Languages:** Ukrainian, Russian, English



**Head Office**

Business Centre Eurasia  
75, Zhylyanska st., 5th floor, 01032, Kyiv, Ukraine  
tel: +38 044 390 55 33; fax: +38 044 390 55 40

**Lviv Office**

6, Generala Chuprynky st., office 1, 79013, Lviv, Ukraine  
tel: +38 032 242 96 96; fax: +38 032 242 96 95

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