

## ARTICLE

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### **Turkmenistan: Intellectual Property Protection**



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The legislation base of Turkmenistan was significantly changed in November 2008 - new intellectual property protection laws have been put into force include, "On inventions and industrial designs," Law of Turkmenistan, Oct. 23, 2008; and "On trademarks, service marks and appellation of origin," Law of Turkmenistan.

Note that early there was a single patent law that regulated provisions in the area of inventions and industrial designs protection, as well as trademarks. Protection of copyright objects is regulated by norms of Saparmurat Turkmenbashy's Civil Code of Turkmenistan.

Turkmenistan is a participant in the following IP protection international agreements and conventions:

1. Convention on World Intellectual Property organization establishment
2. Paris Convention on protection of industrial property
3. Patent Cooperation Treaty
4. Eurasian Patent Convention
5. Protocol under Madrid agreement on international registration of marks

#### **Copyright**

In accordance with acting Turkmenistan legislation, objects of copyright are:

- Literary works
- Dramatics or musical dramatics, choreography, pantomimes and other works
- Musical works
- Audiovisual works
- Sculptures, pictorial art, graphics, lithographic and other works of fine arts
- Arts and crafts, and works of monumental arts
- Works of architectural, urban planning and garden art
- Photographic or similar works
- Maps, plans, design sketches, illustrations and other similar works relating geography, topography and other sciences

Derived works including translations, processing, and other revisions of science, literature and art works; collections such as encyclopedias and databases; and other compound works are also objects of copyright. The author of creation is the physical person who has created the work, and in the case of audiovisual work, the author can be both the physical person and legal entity. The copyright includes the author's moral and property rights.

The copyright shall act during the author's life and 50 years after his or her death. The copyright for creation established anonymously or under pseudonym shall act during 50 years from the date of lawful edition of such creation. Copyright shall be handed over according to the copyright agreements and by way of inheritance. Moral rights shall not be handed over in accordance with testament.

The assignment of property rights can be made based on copyright agreement concerning assignment of exclusive rights (exclusive license), or based on copyright agreement concerning assignment of nonexclusive rights (nonexclusive license). Exclusiveness of license presupposes granting right of use for one person with the right of prohibition to use the copyright by other persons. The right of use under nonexclusive license shall be granted for several persons concerning similar types of use.

Copies of works, manufacture and distribution of which entail violation of copyright and copies of works protected in Turkmenistan, imported without agreement of copyright holders in Turkmenistan from the state where these works have not been protected, or protection of which has been ceased, shall be deemed as counterfeiting goods.

Civil, administrative and criminal responsibilities have been foreseen for

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copyright infringement. The holder of exclusive copyrights has the right to demand that the infringer stop the infringement, indemnification, and compensation of losses with confiscation of counterfeiting goods.

### **Neighboring Rights**

The subjects of neighboring rights are performers, producers of phonograms, videograms and broadcasting organizations. Neighboring rights and copyrights shall include moral and property rights. The performer's rights shall act during 50 years from the date of the first performance. The rights of phonogram and videogram producers shall act during 50 years after their first publishing or during 50 years after the first recording. The rights of broadcasting or cable distribution organizations shall act during 50 years after the first cable transmission.

Copies of phonograms and videograms, production and distribution of which entail violation of neighboring rights, and copies of phonograms and videograms protected in Turkmenistan, imported without agreement of neighboring rights holders in Turkmenistan from the state where the phonograms and videograms have not been protected, or protection of which has been ceased, shall be deemed as counterfeiting goods. Civil, administrative and criminal responsibilities have been foreseen for violation of neighboring rights.

### **Inventions & Industrial Designs**

In accordance with Turkmenistan legislation, invention is the new engineering solution of task that has invention level and industrial applicability.

An industrial design is an art-engineering solution that determines physical configuration of industrial product. The industrial designs shall not be deemed solutions, stipulated exclusively by technical function of product, architecture objects (excluding small architectural forms), industrial, hydrotechnic and other fixed structures, printed production, objects of unstable form from liquid or similar substances, products, which are controversial to public interests, principles of humanity and morale.

The Turkmenistan patent system includes two types: (1) limited patent and (2) patent. The expertise includes three steps: (1) formal expertise, (2) limited expertise, and (3) patent expertise. The limited patent shall be issued only after limited expertise, and the patent after patent expertise.

With respect to inventions, limited expertise shall include checking of submitted documents and checking of invention compliance with conditions of patentability according to art. The limited patent shall be

issued after completion of limited expertise. Request for patent expertise shall be submitted within five years from the filing date of application. During patent expertise, the invention compliance with condition of patentability shall be checked. The patent shall be issued after the carrying out of patent expertise.

The similar procedure of expertise shall be carried out with respect to industrial designs: the limited patent shall be issued after limited expertise, and the patent after patent expertise.

The limited patent for invention shall act during 10 years from the date of application for invention. Patent for invention shall act during 20 years from the date of application for invention. The patent for invention of medicinal agent, pesticide or agrochemicals for which it is necessary to obtain permission in the established order, can be prolonged for up to five years. The limited patent for industrial design shall act during 10 years from the date of application. The patent for industrial design shall act during 15 years from the date of application for industrial design.

The patentee has exclusive right to use and permit or prohibit to other persons to use patented invention or industrial design. The right based on patent (limited patent) can be transferred to any interested person in full scale or partially under the assignment agreement. The right of use can be transferred under the license agreement, at that the following licenses shall be differentiated: exclusive license, nonexclusive license, blanket license, and compulsory license.

Compulsory license shall be issued based on court decision, if the patentee does not use invention, industrial design during five years from the date of patent issuance, and refuses to issue the license for other persons. The assignment agreement and the license agreement shall be subject to obligatory registration in the Patent Office of Turkmenistan. The agreement shall be deemed invalid without registration.

The violence of exclusive right for invention, industrial design is:

- Use of patented invention, industrial design without permission of the patentee
- Manufacture, usage, import, sale offer, sale and other introduction into commercial turnover or keeping with this purpose of product in which the patented invention or industrial design has been used
- Manufacture, usage, import, sale offer, sale and the other introduction into commercial turnover or keeping with this purpose of product, obtained through the method directly protected by the

patent

- Manufacture, usage, import, sale offer, sale and the other introduction into commercial turnover or keeping with this purpose of device, under operation of which in accordance with its designation, the patented method shall be automatically realized
- Realization of patented method or offer concerning its usage
- Motivation of third persons to realize aforementioned actions

The person, illegally used invention, industrial design by demand of the patent holder or by the court decision must cease violation, compensate losses, compensate moral damage and publish court decision for rehabilitation of patentee goodwill. In addition, the customs control by customs bodies regarding protection of patent holder rights or licensee has been foreseen by current Turkmenistan legislation.

### **Trademarks, Service Marks & Appellations of Origin**

Verbal, graphic, three-dimensional, other designations, and their combinations can be registered as trademarks. The trademark can be registered in any color and color combination. The legal protection of a trademark shall be granted based on its registration. The trademark's holder has the exclusive right for use and disposal of the trademark, as well as the right to prohibit its usage or confusingly similar signs by other persons.

Descriptive marks, state arms, emblems, flags, and other signs and symbols, false designations or designations allowing misleading of consumers, or that are controversial to public interests, principles of morale and humanity; violating the rights of the third persons (holders of trademarks, trade names, copyright infringement) shall not be registered as trademarks. The term of registration validity is 10 years with a possibility of prolonging it for each of the following 10 years.

The trademark's owner shall use the trademark. Otherwise, registration can be canceled in connection with continuous non-use of the trademark during any three years after its registration by the claim of any interested person.

The owner can transfer the exclusive right for the trademark to the other person concerning all or part of the goods and services under the assignment agreement. The right of trademark use can be transferred under the license agreement, which can make it a mandatory condition that the quality of the licensee's goods shall not be lower than the quality of licensor, and that the licensor will control the fulfillment of his condition. The assignment agreement and license agreement shall subject to the

obligatory registration in the Patent Office of Turkmenistan. The agreements shall be deemed invalid without registration.

Other than that, the new law regulates relations in the area of protection of well-known trademarks. The registered trademark, mark protected in Turkmenistan without registration based on international agreement or designation used as trademark, which is widely known in Turkmenistan in consequence of intensive usage, can be acknowledged in the quality of well-known trademark.

The legal protection of a well-known trademark shall be granted based on the decision of the Patent Office of Turkmenistan. Legal protection of a well-known trademark shall be spread on the goods, which are dissimilar to those in respect of which it has been acknowledged as well-known trademark, if usage of it by the other person relating determined goods is associated with the owner of the well-known trademark and can impinge its legal interests.

The new object of legal protection in Turkmenistan - appellation of origin - has been introduced in connection with introduction into effect of new trademark law. Certificate for right of origin appellation use shall act during 10 years from the day of application and can be prolonged for the following 10 years by order of its owner. The certificate holder has not the right to grant license for use of origin appellation to the other persons.

The violation of exclusive trademark rights includes:

- Manufacture, use in advertising, prints, official letterheads, signboards, under demonstration of showpieces at exhibits and markets in Turkmenistan
- Import, sale offer, sale and other introduction into commercial turnover on territory of Turkmenistan, or keeping and/or transportation with this purpose
- Usage and/or allocation under work performance or service rendering
- Usage in domain names and/or under other methods of electronic addressing
- Other actions relating trademark or designated by it goods caused damage to owner of trademark or goods consumers

According to the trademark law, counterfeiting goods are goods, label and packings of these goods, where trademark, appellation of origin, or confusingly similar designation has been illegally used.

The person who has violated the right for trademark, well-known

trademark, appellation of origin, by demand of owner and decision of the court shall cease its usage, compensate losses, publish the court decision for rehabilitation of owner goodwill, and remove from the goods illegally used designation. The court has the right to pronounce judgment about confiscation of counterfeiting goods.

Customs measures have also been foreseen for protection of rights for trademark, well-known trademark and appellation of origin. Illegal usage of alien trademark, mark of servicing, appellation of origin or goods marking, can entail criminal responsibility. At that, sanctions can be both in the form of forfeit and punishment in the form of correctional labor for up to two years.

### **Perspectives**

The development of law concerning unfair competition that allows enhancing of protection of IP owners, according to Article 10 of the Paris Convention on protection of industrial property, has been planned in prospect.

It has also been planned to amend Customs Code concerning maintenance of effective registration mechanism for protection of IP objects by Customs bodies that allows owners ceasing import of counterfeiting goods to the territory of Turkmenistan. There is also an issue concerning development of such laws as "Trade Name Law," "On Protection of Domain Name Law" and "On Protection of Selection Achievements Law."

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