TRADEMARKS AND THEIR LEGAL NATURE.

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Within the national legal system of the Republic of Uzbekistan, the circulation and the legal protection of intellectual property objects, particularly trademarks are primarily governed by the Civil Code of the Republic of Uzbekistan and the special Law “Law on Trademarks, Service Marks, and Geographical Indications”.[1] According to the applicable legislative provisions, a trademark is deemed to be a distinctive sign that serves to individualize the goods produced and services provided by a particular natural or legal person from the same type of goods and services of other persons, that is, to distinguish them from one another.[2] However, such a sign is granted legal protection only upon the registration with the Ministry of Justice of the Republic of Uzbekistan, in the manner prescribed by law.

It needs to be noted that although Article 1102 of the Civil Code does not provide a full and exhaustive definition of the concept of a trademark, it unequivocally establishes that legal protection of a trademark arises exclusively upon the state registration in the prescribed manner. While this provision determines the primary role of the Civil Code with regard to trademark regulation, it does not provide a complete and substantive legal definition of this concept. The full legal definition and elements of the concept trademark are set forth in Article 3 of the Law “Law on Trademarks, Service Marks, and Geographical Indications,” according to which a trademark and a service mark

[1] Civil Code of the Republic of Uzbekistan No 163-I of 21 December 1995 art 1102; Law of the Republic of Uzbekistan No 267-II of 30 August 2001 on Trademarks, Service Marks and Appellations of Origin (as amended up to Law No LRU-908 of 15 February 2024) art 4.

[2] Law of the Republic of Uzbekistan No 267-II of 30 August 2001 on Trademarks, Service Marks and Appellations of Origin (as amended up to Law No LRU-908 of 15 February 2024) art 3.

are signs registered in the prescribed manner that serve to distinguish the goods and services of one legal entity or individual from the similar goods and services of other legal entities and individuals.

It is important to note that the primary criterion for the emergence of proprietary rights in a trademark is its compliance with the statutory requirements for legal protectability. A trademark is only registered based on examination conducted by the competent state body in the established manner. As the competent authority, the Ministry of Justice of the Republic of Uzbekistan is the principal institution for the registration of trademarks and the protection of related rights.

The legal equivalence of trademarks and service marks is also reflected in international treaties in this field. In particular, Article 16 of the Treaty on the Law of Trademarks, signed in Geneva on October 27, 1994, stipulates that member states shall apply the corresponding provisions of the Paris Convention to service marks and ensure their registration[3]. Furthermore, under Article 15 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (hereinafter referred to as the **"TRIPS Agreement"**), any sign or a combination of signs used to distinguish the goods or services of one enterprise from one another shall be eligible for protection as a trademark.[4]

According to civil law scholars, the right to a trademark is, by its legal nature, characterized as an exclusive legal monopoly right.[5] That is, the lawful owner of the trademark is granted the exclusive authority to use and dispose of the trademark at their discretion, while the state has to ensure its legal protection by granting the right to prohibit third parties from using the

[3] Trademark Law Treaty (adopted 27 October 1994, entered into force 1 August 1996) 2037 UNTS 35, art 16.
[4] TRIPS Agreement (n 1) art 15(1).
[5] Mathias Strasser, 'The Rational Basis of Trademark Protection Revisited: Putting the Dilution Doctrine into Context' (2000) 10 Fordham Intell Prop Media & Ent LJ 375 https://ir.lawnet.fordham.edu/cgi/viewcontent.cgi?article=1650&context=iplj

trademark, or any signs confusingly similar thereto, without authorization. In legal doctrine, this prohibitive power is often referred to as a ‘negative right’. The logic of this definition is that trademark rights are considered monopoly rights: while granting the owner absolute authority to use the mark, the state simultaneously prohibit others from using any signs that are identical or confusingly similar. Any infringement of this exclusive right by third parties is considered as a ground for the application of liability measures, including the recovery of pecuniary and non-pecuniary damages, as well as the imposition of administrative liability.

From a theoretical perspective, trademarks are considered to be of great importance in economic relations since they constitute one of the principal means of reflecting the individual characteristics of participants in civil circulation and commercial organizations.[6] First, trademarks serve not only to reflect the distinctive features of goods, works, and services and the individual characteristics of their producers. Furthermore, they function as a vital mechanism for forming consumer perceptions regarding the quality of goods, works, and services. In scientific literature, the following three main functions are distinguished according to their role in circulation.[7]

First, the personalization function serves to distinctly differentiate one manufacturer’s products from other similar goods in a competitive market environment, thereby helping consumers distinguish among them. This function is primary and fundamental in relation to all other functions of a trademark.

[6] William M Landes and Richard A Posner, *The Economic Structure of Intellectual Property Law* (Harvard University Press 2003) https://inter-droitetaffaires.com/wp-content/uploads/2020/03/The-Economic-Structure-of-Intellectual-Property-Law.pdf

[7] Nicholas Economides, ‘The Economics of Trademarks’ (1988) 78 TMR 523 https://neconomides.com/uploads/Economides_Economics_of_Trademarks.pdf

Second, the informational function provides the consumer with a prompt signal about the product's origin, manufacturer, and specific characteristics, enabling them to make a conscious and informed choice. Through this function, the trademark creates an information bridge between the consumer and the manufacturer.

Third, the marketing function serves as a means of promoting the product in the market and increasing its appeal by instilling a positive perception of its quality, safety, and brand in the public consciousness. The marking function has already become increasingly important in light of the modern digital marketing.

Trademarks are classified according to various criteria as a means of reflecting the specific characteristics of manufactured goods and services. Owing to their diversity in form and expression, trademarks are traditionally divided into verbal, figurative, three-dimensional, and combined marks. However, modern trademark laws have also started to recognize non-traditional marks, including sound, olfactory, and color marks.[8] Furthermore, depending on the system of signs used, trademarks are divided into verbal, non-verbal, and combined types. According to the number of entities entitled to use them, they are divided into individual and collective marks. Depending on the degree of recognition among consumers, trademarks are classified as ordinary, well-known, and famous; and based on the degree of protection afforded to consumers' rights, they are divided into ordinary and certification marks.

In practice, the most widespread and frequently used type is word trademarks, which account for more than 80 percent of all registered trademarks worldwide.[9] As a rule, both established words existing in the

[8] Annette Kur and Martin Senftleben, *European Trade Mark Law* (OUP 2017).

[9] WIPO, *World Intellectual Property Indicators 2023* (WIPO 2023) https://www.wipo.int/edocs/pubdocs/en/wipo-pub-941-2023-en-world-intellectual-property-indicators-2023.pdf

language and artificially created signs not previously found in the language may be registered as word trademarks. The key difference between these two types is that artificially created signs are usually more easily imprinted on the consumer's memory and create an association directly linked to a specific product or enterprise. Examples of word trademarks may include signs composed of ordinary dictionary words, such as "Apple" for computers and smartphones; or artificially coined terms, such as "Samsung," "Nikon," and "Kodak"; as well as marks derived from proper names, such as "Ford" and "Chanel"; advertising slogans, such as "Just do it!" and "I'm lovin' it"; and abbreviations formed by combinations of letters, such as "LG," "BMW," and "IBM."

In the scientific literature, word trademarks are generally divided into two main categories, namely phonetic and phonographic marks.[10] Phonetic trademarks are protected solely by their pronunciation, that is, their sound, and their graphic representation is of little significance. In phonographic trademarks, on the other hand, the arrangement of letters, their size, font, and other visual elements are of considerable importance.

Pictorial, or figurative, trademarks are composed of visual representations developed through artistic design and include symbols, depictions of animals or plants, product characteristics representations, or abstract graphical elements. Depending on the content of the images they depict, pictorial trademarks are classified as: those conveying symbolic meaning; those related to the manufacturing process; those expressing the nature of the product; and those featuring pictorial elements with lettering. A distinctive feature of pictorial trademarks is that they manifest as graphic elements formed by the artistic composition and color arrangement of images

[10] J Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (5th edn, Thomson Reuters 2021) § 7:1–7:15.

and pictures. Illustrative examples include the crocodile emblem of Lacoste and the “swoosh” logo of Nike..

Three-dimensional (3D) marks consist of the unique, non-repeating three-dimensional shape of the product itself or its packaging. These marks display three-dimensional configurations comprising shapes, lines, and spatial elements that may represent either the product itself or its packaging. Illustrative examples of 3D trademarks include the contour bottle associated with Coca-Cola and the characteristic packaging design of Ferrero Rocher.

Combined (composite) marks are formed through various combinations of words, letters, numbers, and images that convey a complex meaning, and are very widespread in commerce. In most cases, composite trademarks consist of verbal and pictorial sselements possessing independent substance, which ensures their faster recognition in the market and a broader scope of legal protection.

With the rapid development of the digital economy, the protection of non-traditional trademarks, including sound, olfactory, spatial arrangement, and color trademarks has been also becoming increasingly important. According to scientific researchers, including A.A. Zhilin, the judicial practice and legislation of Western countries are constantly developing modern standards for the protection of intellectual property. The development of the digital economy creates the need to ensure the protection of intellectual property, particularly trademarks, not only within a single territory but also at the international level. Modern forms of maintaining trademark rights and ensuring their legal protection are emerging in the legislation and judicial practice of Western countries, which in turn serves as a model for the modernization of legislation in other states, including Uzbekistan.

Sound marks are generally used as service marks and include musical melodies, positive radio station signals, and other types of acoustic sounds.[11] For example, the United States, Germany, France, Poland, and South Korea have expressly provided for the registration and protection of sound marks such as the lion's roar by Metro-Goldwyn-Mayer and a famous ringtone associated with Nokia. However, Japan, China, Brazil, and Mexico legislation did not provide legal protection for sound trademarks until recent years.

In the People's Republic of China, olfactory trademarks are used less frequently than sound trademarks. These marks embody original scents, which, under general rules, are considered the know-how of the manufacturer. The main obstacle to the registration of olfactory marks, such as the distinctive smell of tennis balls, as objects of legal protection is that their precise and complete representation in graphic or verbal terms is methodologically very difficult, making their registration as protected objects relatively rare in practice. Color trademarks, on the other hand, display various color effects that possess distinctive character.[12]

Although the European Union's Directive 89/104 on trademarks does not explicitly provide for the registration of non-traditional marks, no strict prohibition is established either, and as a result, they have been protected through judicial precedent.[13] Specifically, Article 3 of the Directive does not contain separate provisions regarding the legal protection of trademarks consisting of colors and combinations of colors, but there are also no rules that would exclude them. Furthermore, pursuant to Article 3(2)(b) of Directive 89/104, religious symbols or other signs of a higher significance cannot be

[11] Irene Calboli and MRF Senftleben, *The Protection of Non-Traditional Trademarks: Critical Perspectives* (OUP 2018).

[12] Case C-104/01 *Libertel Groep BV v Benelux-Merkenbureau* [2003] ECR I-3793, paras 27–42

[13] First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks [1989] OJ L40/1, art 3.

registered as trademarks. Another important aspect of the European Union's Directive is that it provides for both mandatory and optional grounds for refusing to register trademarks or declaring them invalid. In particular, under Article 3(1)(b) of Directive 89/104, the lack of distinctive character in a trademark is the main ground for refusal of registration.

Collective trademarks have a separate legal significance. They are used by a voluntary association of business entities such as an association, guild, or union of enterprises that produce products of uniform quality, production technology, or other common characteristics.[14] The difference between a collective trademark and a simple individual one is that (1) it certifies that the product is manufactured not by a single entrepreneur but by all members of the association, and that (2) it meets a uniform quality standard. In other words, a collective mark serves to individualize products manufactured not by a single producer but by business entities producing a certain type of goods.

The issue of providing legal protection for collective trademarks is regulated differently in the legislation of foreign countries. In particular, in the People's Republic of China, the United States, France, Italy, and Austria, the legal status of collective trademarks is generally determined by trademark legislation. In Scandinavian countries such as Finland, Sweden, Norway, and Denmark, collective trademarks are protected by separate specialized legislation. The international legal basis for this mechanism is clearly established in the Paris Convention for the Protection of Industrial Property.[15]

Well-known trademarks differ from ordinary trademarks in that they are widely or commonly recognized by consumers and have become firmly

[14] Ryan Abbott (ed), *Research Handbook on Intellectual Property and Artificial Intelligence* (Edward Elgar Publishing 2022).

[15] Paris Convention for the Protection of Industrial Property (adopted 20 March 1883, revised at Stockholm 14 July 1967, entered into force 26 April 1970) 828 UNTS 305, art 6ter(1)(a).

established in the public consciousness.[16] This, in turn, creates the need to provide special legal protection for these marks, because they require broader protection not only in the class in which they are registered but across all classes of goods and services. The main purpose of providing special legal protection for a well-known trademark is to prevent unfair competition practices that cause significant material harm to the rights holder, damage their business reputation, and create a false or misleading impression in the consumer about the product and its manufacturer. In some countries, particularly Austria and Japan, the interests of holders of exclusive rights to well-known trademarks are protected through mechanisms for preventing unfair competition.[17]

Certification marks serve to indicate the conformity of goods and services with certain state or international standards and environmental requirements. This mark is used to designate the quality characteristics of a standard product among other products. In the legislation of foreign countries, the term “certification mark” is interpreted differently. In the legislation of the People’s Republic of China, certification marks are defined as marks belonging to an organization whose authority includes the supervision of certain goods and services. This organization issues certification marks as marks confirming the quality, origin, materials used, method of manufacture, and other characteristics of goods produced and services provided by other natural or legal persons.

Under the 1994 Geneva Convention and Article 15 of the WTO’s TRIPS Agreement, any sign or combination of signs that can distinguish one enterprise’s products from those of another may constitute as a trademark. Furthermore, under the provisions of Article 6*ter* of the Paris Convention of

[16] WIPO, *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks* (adopted 29 September 1999, WIPO Publication No 833) arts 2–4.

[17] Frederick W Mostert, *Famous and Well-Known Marks: An International Analysis* (3rd edn, INTA 2004) 56–78.

1883, the countries of the Union shall undertake to refuse the registration of state flags, coats of arms, official marks, control marks, and other state emblems as trademarks or as elements of such symbolic representations without the competent authority authorization, and to prohibit any imitation thereof from a heraldic point of view.

In accordance with the requirements of the national legislation of Uzbekistan, specifically, Article 10 of the Law, the elements that are not eligible for protection include, but are not limited to: state symbols; official control marks; names of international intergovernmental organizations; words in common use; as well as distinguishing and identifying marks of state services; signs lacking distinctive character; signs used to describe the goods, including their kind, quality, quantity, characteristics, intended purpose, and value, as well as the place and time of their production or sale; marks that are false or may mislead the consumer about the goods or their manufacturer. It is strictly forbidden to register and protect as a trademark signs that are contrary to public interest, the principles of humanity, and moral norms.

In conclusion, it should be emphasized that a trademark is considered to be an object of monopoly right, protected by law, while the purpose of it is to distinguish goods produced or offered by a particular enterprise, individual, or legal entity, and which has been duly registered by an authorized body in the name of the trademark owner. The development and legal consolidation of this institution serves not only to protect the interests of individual entrepreneurs but also to ensure the soundness of the overall economic competitive environment and to guarantee the rights of consumers.

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8. Paris Convention for the Protection of Industrial Property (adopted 20 March 1883, revised at Stockholm 14 July 1967, entered into force 26 April 1970) 828 UNTS 305

9. Trademark Law Treaty (adopted 27 October 1994, entered into force 1 August 1996) 2037 UNTS 35

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