MONGOLIAN NATIONAL CHAMBER OF COMMERCE AND INDUSTRY
DEPARTMENT OF PATENT, TRADEMARK, AND GEOGRAPHICAL INDICATION

Address: MNCCI Bldg., Mahatma Gandhi street, 15 khoroo, Khan Uul district, Ulaanbaatar 17011, Mongolia
Email: patenttmbur@mongolchamber.mn

Who we are:

Mongolian National Chamber of Commerce and Industry /MNCCI/ is the first intellectual property agent in Mongolia since 1970. The MNCCI's Department of Patent, Trademark and Geographical Indication is specializing in filing prosecution of industrial property rights and effectively providing exceptional legal services and consultancy on intellectual property rights in Mongolia. Moreover, we have longstanding and good relationship with more than 30 law firms around the world.

Services we provide:

Initial searching; filing prosecutions; trademark renewals; assignments and other registrable transactions; responding to office actions; submitting oppositions against applications related to industrial designs, inventions, utility models, and trademarks.

Trademark-related Frequently Asked Questions

1. **What is the relevant trademark authority in Mongolian jurisdiction?**

The Intellectual Property Office of Mongolia (IPOM) is the governmental implementing agency tasked with the regulation of intellectual property rights (such as patents, trademarks, geographical indications, copyright and related issues) in Mongolia.

2. **What is the relevant trademark legislation in Mongolia jurisdiction?**

The Mongolian Law on Trademarks and Geographical Indications covers protection of trademark rights and geographical indication, exclusive rights of the trademark owner, obligations of users of geographical indication, functions and responsibilities of the Government agency, consideration of appeals, requests, and disputes, etc.

3. **What are the requirements for registering a trademark under the Mongolian Law on Trademarks and Geographical Indications?**

A trademark is any sign or any combination of signs used to distinguish the goods and/or services offered by one undertaking from those offered by another.

The following items shall not be registered as trademarks:

- indications, the content of which is contrary to public order or morality;
- indications liable to deceive or mislead consumers as to the nature, quality, geographical origin or other characteristics of the goods or services.
- it is identical with, or similar to, a trademark registered or applied for registration in Mongolia in respect of similar goods or services where its use would result in a likelihood of confusion on the part of consumers;

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- it is identical with, or similar to, a trademark which has become well-known among the public, regardless of the nature of the goods or services and where the use would take unfair advantage of, gain profits from, cause damages, or be detrimental to, the repute of the well-known trademark

4. What types of trademarks can be used in Mongolia?

A trademark can be expressed in words, figures, letters, numerals, devices, three-dimensional configurations, colors, sounds, scents, and any combinations thereof.

5. How long does it take to register a trademark in Mongolia?

For a smooth case of an applied mark, the original registration certificate will be issued within 6-9 months of the filing date.

6. Do the power of attorney and other relevant documents require notarization and/or legalization?

The Power of Attorney plays a significant role in filing all registrations and/or applications at the IP Office of Mongolia as evidence. The POA form and other relevant documents do not require notarization or legalization. A simple sign on the POA will suffice here. Additionally, the IP Office accepts scanned copies of original documents.

The signed POA for new registration is available for submission to the IP Office within 2 months from a filing date. Paying an additional official fee allows you to extend the duration by 2 months.

7. What is the timeframe for the MNCCI to conduct an initial search report on the mark?

Let you know that the IP Office does not conduct initial search reports. An applicant should appoint an IP agent to assist in conducting search reports.

Furthermore, the initial search is not mandatory and is entirely optional; depending on our workload, the MNCCI will deliver a search report within 1-3 business days following the client's instructions.

8. How long does it take for the MNCCI to provide the client with a filing receipt?

The MNCCI usually sends a filing receipt to the client within 2 to 5 working days after receiving instructions.

9. Does the MNCCI work on preliminary refusal decisions of trademark applications filed through the International Registration System?

The MNCCI has gained considerable experience in responding to preliminary refusal decisions and has overcome the refusals with 90-95 percent completion owing to the grounds of refusal (absolute or relative ground).

10. Does the IP Office accept a letter of consent as evidence?

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A letter of consent can serve as a document acceptance by the IP Office. Getting consent or permission for the use from the owner is crucial for overcoming various oppositions and/or office acts with high completeness.

11. Does previous trademark protection grant in other countries impact successful trademark registration in Mongolia?

Unfortunately, the answer is no. This means that grant(s) of trademark protection obtained in other countries will not affect successful registration in Mongolia. The foreign protection grant will be regarded as insufficient grounds for promoting the TM application procedure.

12. What documents are required to submit various applications to the IP Office?

- An application for registration of a mark must include (1) work instructions; (2) mark name and/or logo; (3) name and address of the applicant; (4) If an applicant has an official representative or IP agent, he or she must provide a signed Power of Attorney; (5) a description of the goods/services; and (6) a priority claim (if applicable).
- If an applicant wishes to claim a priority, he or she must provide a declaration for priority of an earlier application within three months from the filing date *(Article 7.7 of the Law);*
- A list of the goods and services grouped into the NICE International Classifications *(Article 3.1.17 of the Law)*;
- If an applicant wishes to make recordal of change of name and address, he or she must provide a "Commercial Registry Statement";
- If an applicant wishes to make recordal of assignment, he or she must provide a "Deed of Assignment". */If necessary, we will send you the Deed of Assignment form/*

13. When should trademark owners request the IP Office regarding the registration amendments and records?

If name and address of the owner has been changed/the right of the trademark owner has been transferred to another one, the owner must notify in writing within 6 months from the day the change occurs; relevant changes shall be recorded in the IP Office.

14. Does Mongolia allow trademarks to be canceled for non-use?

On May 6, 2021, as part of the amendment of the Mongolian Law on Trademarks and Geographical Indications, the non-use cancellation procedure was introduced.

If the owner of the trademark has not used it for five years without a valid/reasonable reason, the registration for the type or classification of such not-used goods and services that has not been used shall be considered invalid by an interested party's request. Any interested party, on the ground provided for Article 33.1.3 of the Law, may submit to the Dispute Resolution Commission a request for invalidation of trademark registration. If the Dispute Resolution

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Commission finds that the request is well founded, the decision shall be taken to invalidate the registration of the trademark, and the IP Office shall be notified accordingly.

15. How is priority claimed?

An application with a priority claim must be filed within six months from the date the earliest foreign application was filed. Thus, the applicant should submit a certified copy of the prior application or related evidence where the applicant wishes to claim the priority date.
A priority claim may also be made within six months from the day when the trademark was used for the first time on goods/services displayed at an official international exhibition hosted or acknowledged by any member countries of the Paris convention.

16. What is the process for determining the filing date of an international trademark application designating Mongolia?

The filing date of the trademark application designating Mongolia by international trademark application shall be accorded as of the date of the international registration or of the date of the request for territorial extension of the registration.

17. Is it possible to get the original registration certificate again?

If the owner of the trademark wishes to reacquire the trademark original certificate due to its loss or other reasonable reasons, he or she shall submit a request and pay an official service fee. The request shall clearly state the reason for the readmission and, if possible, attach evidence of the reason.

18. What is the general procedure for trademark registration?

The general procedure for registering a trademark in Mongolia is dependent on the following steps:

Formality check: After receiving the application documents, the IPOM will conduct an initial formality check. If the required application documents are filled in and the fees are paid, the IPOM will accept the application, determine a filing date.

Official Notice: If the application documents meet the requirements but some details need to be corrected, the IPOM will issue an official notice and require the applicant to correct them within 20 days. The applicant can submit the corrections once; if the examiner is dissatisfied with the corrections, the application will be rejected.

Approval for publication: If an application is entitled to registration, the applied mark will be published. Third parties may oppose the application within three months from the filing date.

Substantive examination: A trademark examiner shall review and assess TM applications to make sure they meet the requirements for registration under Articles 5.1 and 5.2 of the Law.

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Furthermore, the trademark examiner may also review third-party oppositions to the application.

The opposition to the international trademark application, may be filed within five months from the date of the international publication.

Registration: If the application passes the substantive examination, it will proceed to registration.

19. How is a trademark adequately represented?

A black-and-white design often provides broader protection.

A reproduction of image must substantially represent the mark as used or intended to be used in connection with the goods/services of the applicant, should be in JPEG format, should not exceed 10cm × 10cm.

If a trademark being registered is presented in a three-dimensional configuration, it should contain two or more perspectives showing its generic and specific characters.

If a trademark being registered is expressed by sound, a sonogram should be provided to the application if it cannot be expressed through recording, musical notes, or verbal specifications.

20. Is "proof of use" required when filing a trademark application?

No, proof of use is not required to file the application at the Office. Mongolia is a first-to-file jurisdiction and trademark rights commence upon the trademark registration date.

21. Does Mongolian jurisdiction recognize Collective or Certification marks?

Yes, Mongolia does recognize Collective and Certification marks.

22. What are the ways to overcome an absolute grounds refusal?

The absolute grounds for refusal are specified in Article 5.1 of the Mongolian Law. An application is an active way to appeal the refusal.

In the appeal, the applicant may consider the following arguments:

- Indicates that the mark comes under the permitted exceptions.
- Argues that the refused mark is not identical to impermissible signs under Article 5.1.
- Argues acquired distinctiveness for the refusals based on the lack of distinctiveness according to Article 5.2.

23. Does the IP Office issue an original certificate for renewal and recordal actions?

The IP Office has quit issuing original certificates for Renewals/Records Amendments since 2019. The Office does issue "Official Notices on Amendments to TM Registrations" online within 1-2 months of submittal.