

Can BLACK FRIDAY owner prevent use of 'Real Black Friday'? Russia - Gorodissky & Partners

Confusion
Cybersquatting
Infringement
Enforcement

June 04 2018

- **Owner of BLACK FRIDAY in Class 35 sued respondent for using 'Real Black Friday' and 'realblackfriday.ru'**
- **First instance court found no likelihood of confusion among Russian consumers**
- **Appeal and cassation courts held that plaintiff had abused its rights by suing respondent**

'Black Friday' is the name of the day that follows Thanksgiving in the United States. It is regarded as the beginning of the country's Christmas shopping season. It is not clear exactly when this word combination was coined, but it is thought that it was first used in Philadelphia as early as 1961. Gradually the name caught on; it spread to other countries, including in Europe, and finally it arrived in Russia.

Some Russians went to great lengths to ensure their hold on 'Black Friday'. First, they set up a company called Black Friday Ltd in 2013. Several months later, they filed a trademark application and obtained a registration for BLACK FRIDAY (No 563277) for services in Class 35 (including market research, collection of information in computer databases, and handling automated databases). As can be seen, the activities of the company are not related to shopping in any way.

In 2016 an association of online shops registered the domain name 'realblackfriday.ru'. The site offered goods and discounts from various vendors.

Black Friday Ltd, believing that its rights were being infringed, sued the association for use of the words 'Real Black Friday' and of the domain name 'realblackfriday.ru' itself. It alleged that the respondent should discontinue providing services under that designation and should not use the designation in documents and advertisements; it also claimed compensation in the amount of \$25,000.

The court of first instance examined the activities of both parties and came to the conclusion that the services rendered by Black Friday Ltd and the association were not similar. Therefore, there was no likelihood of confusion among Russian consumers. As a result, the claims were rejected.

Black Friday Ltd appealed. The court of appeal agreed with the findings of the first instance court, and added that Black Friday Ltd had abused its rights by suing the respondent. Such abuse of rights is prohibited by Article 10 of the Civil Code. Black Friday Ltd appealed again to the cassation court.

The cassation court ordered a forensic examination which confirmed that the services rendered on the website at 'realblackfriday.ru' and verified by a notary were not covered by Class 35, in respect of which Black Friday Ltd's trademark is registered. The website did not provide services such as market research, collection of information in computer databases, handling automated databases and other services of the kind protected by the trademark. The judicial division of the cassation court stated that the appeal court had been right to uphold the judgment of the first instance court, and that Black Friday Ltd had abused its rights. Additionally, the judicial division pointed out that 'Black Friday' internet campaigns had been taking place before Black Friday Ltd was incorporated and before its trademark application was filed. This circumstance, in combination with other facts showing that the designation 'Black Friday' had been used in many countries as a symbol of the November sales before the priority date of the trademark, had been correctly evaluated as an abuse of rights.

It is not clear why the conflict happened in the first place in the absence of any tangible interests on the trademark owner's part. The case kept the courts busy for two years, but the IP Court has now put an end to it with its May 2018 judgment (A56-74105/2016).

Vladimir Biriulin, Gorodissky & Partners, Moscow

World Trademark Review™

Daily

World Trademark Review (www.worldtrademarkreview.com) is a subscription-based, practitioner-led, bi-monthly publication and daily email service which focuses on the issues that matter to trademark professionals the world over. Each issue of the magazine provides in-depth coverage of emerging national and regional trends, analysis of important markets and interviews with high-profile trademark personalities, as well as columns on trademark management, online issues and counterfeiting.