

# RUSSIAN FEDERATION

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## I OVERVIEW

The Russian Civil Code defines a trademark as a sign that serves to individualise goods and services of legal entities and entrepreneurs. In other words, a trademark is a sign that is capable of distinguishing goods and services of one legal entity or entrepreneur from another legal entity or entrepreneur. Russian legislature provides that any designations – including but not limited to verbal, pictorial, combined, three-dimensional signs and other designations or their combinations – may be registered as trademarks. A trademark may be registered in any colour or colour combination, or just black-and-white. Sound and animation marks can also be registered. There is no relevant legislation nor sufficient practice regarding olfactory marks.

Registration of marks that are lacking in distinctiveness is not allowed. Despite the fact that the Civil Code indicates the designations that should be recognised as lacking in distinctiveness, in some situations the criteria of distinctiveness are arguable and remain at the discretion of the trademark office. Moreover, the Civil Code provides for the possibility of registration of marks based on their acquired distinctiveness through intensive pre-filing use in Russia.

Colour marks (either colours *per se* or colour combinations), sound marks, texture marks, olfactory marks, position marks, hologram marks, motion marks, taste marks, etc. may be registered in Russia but their inherent registrability depends on distinctiveness: either distinctive features of the mark itself or acquired distinctiveness through intensive use in Russia.

It should be noted that Russia is a first-to-file country. Legal entities or entrepreneurs who first apply for registration of a trademark enjoy a priority right to obtain trademark registration. According to Russian legislation, rights for a trademark appear from the moment of state registration and no rights derive from the use of an unregistered trademark. Therefore, it is essential to file trademark applications without delay even if the trademark owner does not yet intend to use its trademark on the Russian market.

The examination of trademark applications consists of a formal examination and thereafter a substantive examination allowing an examiner to determine whether the filed designation is inherently registrable and whether it is confusingly similar to any pending third-party applications or registered marks.

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A national trademark application has to be filed with the Federal Service of Intellectual Property (hereinafter the PTO), also known in Russia as Rospatent, which is an administrative body responsible for the examination of applications and issuance of decisions once the results of such examinations are known.

Under Russian legislation, foreign applicants should be represented by Russian trademark attorneys registered at the Russian PTO. Therefore, in order for an application to be filed in the name of an entity residing outside Russia, this entity has to appoint its Russian agent as its representative before the Russian PTO in all proceedings.

## **II LEGAL FRAMEWORK**

### **i Legislation**

Russian domestic trademark legislation includes:

- the Constitution of the Russian Federation, which names protection of intellectual property in the provisions on rights and freedoms;
- the Russian Civil Code, in particular Part IV, which is a codified set of legal norms for prosecution, enforcement and transactions for trademarks;
- the Federal Law of 26 July 2006 No. 135-FZ ‘On competition protection’, which has provisions on unfair competition issues involving trademarks;
- the Federal Law of 13 March 2006 N 38-FZ ‘On advertising’, dealing with certain aspects of using trademarks in advertising;
- the Resolution of the Government of Russia of 23 September 2017 No. 1151, which provides for the amount of state duties paid during trademark prosecution;
- the Resolution of the Government of Russia of 24 December 2015 No. 1416, which provides general rules for recording trademark-related transactions. Detailed procedural issues relating to such records are approved in the Order of the Russian Ministry of Economic Development 10 June 2016 No. 371; and
- the Orders of the Russian Ministry of Economic Development of 20 July 2015 Nos. 482 and 483, which regulate the detail of all trademark prosecution procedures.

The most relevant international treaties of Russia for trademark matters are:

- the Madrid Agreement concerning the International Registration of Marks 1891–1967;
- the Protocol relating to the Madrid Agreement concerning the International Registration of Marks of 1989;
- the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Union) 1957–1977;
- the Paris Convention for the Protection of Industrial Property;
- the World Trade Organization Agreement on Trade-Related Aspects of Intellectual Property Rights 1994 (the TRIPS Agreement);
- the Nairobi Treaty on the Protection of the Olympic Symbol 1981;
- the Trademark Law Treaty 1994; and
- the Singapore Treaty on the Law of Trademarks 2006.

### **ii Authorities**

Trademark prosecution is dealt with by the PTO, which also renders decisions on trademark invalidation actions. The PTO comes under the jurisdiction of the Russian Ministry of Economic Development.

Decisions by the PTO on trademark matters are reviewed by the Intellectual Rights Court, which also hears cassation appeals on trademark infringement cases, rendered by lower commercial courts. Decisions by the Intellectual Rights Court may be further appealed to the Russian Supreme Court.

The Federal Antimonopoly Service fights unfair competition and unfair advertising cases that might also involve trademarks. In particular, a decision by the Service on unfair competition relating to trademark registration and use is a ground for the PTO to invalidate a trademark.

The Russian police and the Russian customs authorities are competent in various types of trademark infringements.

### **iii Substantive law**

The law provides for registration of collective marks. A collective mark is defined as a mark of a union, business association, concern or other voluntary association of enterprises being capable of distinguishing goods manufactured or commercialised by it having common characteristics as to quality or otherwise. When filing an application for registration of a collective mark, it is imperative to submit a by-law of the collective mark containing the rules concerning use of the mark. These rules must indicate:

- the name of the association entitled to register the mark in its name;
- the list of enterprises entitled to use the mark;
- the purpose of registration of the mark;
- a list of goods and a description of their common characteristics (relating to quality or otherwise);
- the conditions for use of the mark;
- the principles by which use of the mark will be controlled; and
- the sanctions for violation of the rules.

The names of the enterprises entitled to use the mark and an extract from the rules relating to the common characteristics of the goods for which the mark is registered will be mentioned in the publication of the registration of the collective mark in the official bulletin. The owner of the registration must inform the PTO of any amendment to the rules.

Any interested person may apply to the Intellectual Property Court for the (total or partial) cancellation of registration of the collective mark if it is used in relation to goods not having common qualitative or other common characteristics. Collective marks cannot be assigned or licensed to third parties.

Collective marks and applications for registration of collective marks may be transformed respectively into trademarks or trademark applications.

### ***Well-known marks***

A trademark can enjoy protection as a well-known mark that may not necessarily be a registered designation. Russian legislation foresees the procedure of recognition of a well-known trademark.

As well as the usual trademark filing procedures through the PTO or registration via the Madrid System, legal protection for a well-known trademark can also be obtained through a special recognition procedure. In Russia, unlike in many other countries, a trademark is not

granted well-known status as a result of court proceedings or litigation. According to Russian trademark legislation, for a trademark to be recognised as well known, the appropriate request should be filed with the PTO.

A well-known trademark shall be granted the same legal protection as is provided for an ordinary trademark. Nonetheless, a well-known trademark provides its owner with certain important advantages:

- the legal protection of a well-known trademark is not time-limited;
- protection extends to goods or services of a different kind from those for which it is recognised as well known, if use of the mark by another person is likely to be associated by consumers with the owner of the well-known trademark and may impair its lawful interests;
- protection of a well-known mark may start at the period that predates the filing date of the respective request to recognise the trademark as well known; and
- the commercial value of a well-known trademark is higher than that of an ordinary trademark.

The well-known status should be evidenced by numerous documents and materials confirming intensive use of the mark and its reputation among consumers in association with the goods or services for which the request is being made for it to be recognised as well known, and in association with the trademark owner. In seeking to have its trademark recognised as well known, the applicant should indicate the goods or services for which the mark has become well known, and the date from which the trademark became well known.

The following information may be submitted with the petition for the recognition of a well-known trademark:

- the results of a consumer survey regarding the goods in question, revealing consumer knowledge of the trademark and performed by a specialist organisation;
- examples of intensive use of the trademark, especially in Russia;
- a list of countries where the trademark has acquired a well-known reputation;
- examples of advertising costs incurred relating to the trademark and examples of advertising;
- details of the value of the trademark;
- publications in Russian periodicals; and
- documents containing information about supplies of goods to Russia, etc.

It is not compulsory to submit all the above-listed evidence. Trademark legislation does not contain a list of obligatory documents that must be submitted with the petition for the recognition of a trademark as well known.

Practice shows that it is recommended that evidence of use of the trademark in Russia be submitted in support of the petition. Special attention should be paid to the results of the consumer survey. Such polls must be carried out in at least six of Russia's largest cities, including Moscow and St Petersburg. Other cities may be chosen by the applicant, depending on the sphere of activity and the regions of trademark use.

Determining the date from when the trademark became well known is also crucial, and a careful review of all available materials is required. The date from which the trademark became well known should be indicated precisely.

The Russian PTO has a strict approach to petitions for the recognition of marks as well known, and they are often denied. The main difficulty encountered during proceedings

is demonstrating that consumers have a strong association between the trademark and the goods or services for which the trademark is used, and with the trademark owner. Often consumers recognise the trademark, but have little knowledge about its owner. Formally a trademark may belong to an IP-rights holding company, the name of which is not known to consumers. Furthermore, if the date from which the applicant would like to have its trademark recognised as well known refers to a period in the past, the supporting evidence should predate the date mentioned in the request.

As of November 2017, 190 well-known trademarks are published in Russia, including Nike, Coca-Cola, Disney, Tiffany, Intel, Adidas, Gillette, Nikon, Elle, Heinz and Casio.

### ***Certification marks***

It is possible to have a certification mark registered in Russia. However, the registration procedure is quite different from that used in relation to trademarks.

In particular, a legal entity that created its own voluntary system of certification is entitled to get both the system and the certification mark identifying it registered. The registration can be implemented by filing an application with the Russian Federal Service for State Standardisation. According to the current rules, the certification mark has to be distinctive and visually perceivable. The rules make it very clear that trademarks cannot be used as certification marks. The registered certification marks are entered into a special state register, which is separate from the Register of Trademarks.

Certification marks have nothing to do with intellectual property (IP) objects. However, a certification mark can be registered as a trademark if it meets registrability requirements and is not in conflict with third-party rights.

### ***Geographical indication***

A trademark that has a geographical indication as a part of its designation can be registered in Russia subject to the disclaimer of the geographical indication, provided that such registration will not mislead consumers in respect of the geographical origin of the goods or the whereabouts of the manufacturer.

## **III REGISTRATION OF MARKS**

### **i Inherent registrability**

Approximate time frames for trademark registration procedure in Russia are as follows:

- the official filing receipt is issued within one month of the date of filing an application or sooner;
- the official action is issued within 10 to 12 months of the date of filing the application (an examiner's objections, if any, may increase the term to between two and three years, depending on the circumstances of the case, number of appeal stages, etc.); and
- where the trademark is successfully registered, the registration certificate is issued within two months of the date of payment of the official fee for registration.

There are no specific additional documents that should be filed with the trademark application except power of attorney. Filing power of attorney is optional but if it is absent from the application materials, the examiner may request submission of this document and that may have a negative impact on the registration terms. It should be issued by the applicant and signed by the authorised person with an indication of that person's name and position

in the company. The date and place of the signature should be indicated as well. Neither notarisation nor legalisation is required. The power of attorney can be submitted after filing the application.

In cases of a priority claim under the Paris Convention, it is necessary to submit a certified copy of the first (home) application. The filing particulars should correspond to those in the home application. The home application can be submitted after filing an application under the Convention, but within three months of the date of filing the Convention application with the PTO. This term cannot be extended. Split priority is not foreseen in Russia.

Formal examination (in one class) is 2,450 roubles (about US\$45) and 700 roubles (about US\$12) for each additional class over five. Substantive examination (in one class) is 8,050 roubles (about US\$140) and 1,750 roubles (about US\$30) for each additional class after the first. In the case of non-electronic filing, the official fees increase by 30 per cent. The official fee for registration is 11,200 roubles (about US\$195) and 700 roubles (about US\$12) for each additional class over five, and the official fee for issuance of the certificate is 1,400 roubles (about US\$25).

Examination in Russia consists of a formal and a substantive stage. A formal examination of a trademark application is conducted within one month of the application being filed. During the formal expert examination, the necessary application documents and their compliance with established requirements are verified. The outcome of the formal examination will be that either the application is accepted for consideration or a decision is taken to refuse acceptance for consideration.

The aim of the substantive examination stage is to determine whether the filed designation conforms to the registrability requirements. A trademark application may be rejected on either absolute or relative grounds, or both.

Absolute grounds are those that relate to the substance of the mark itself and include: lack of distinctiveness; risk of misleading and capability of confusing; similarity to or identity with state symbols and marks; reproduction of full or abbreviated names of international or intergovernmental organisations or their symbols; and reproduction of the official names or images of the most valuable objects of Russia's and worldwide cultural heritage.

Relative grounds for refusal include:

- identity or similarity to the extent of confusion with prior trademarks (both registrations and applications) owned by third parties in relation to similar goods or services;
- identity with or similarity to the extent of confusion with well-known marks; and
- identity with or similarity to the extent of confusion with third parties' industrial designs, appellations of origin, company names or commercial designations.

A trademark may also be refused protection if it incorporates protected means of individualisation of other persons (and confusingly similar signs) as well as copyrighted objects owned by third parties, names, pseudonyms (or derivatives thereof), pictures, facsimiles of famous persons, or industrial designs owned by third parties as elements of the trademark.

Before making a decision about the results of the examination of an application, notification of the results of the checks for compliance of the applied designation with the requirements is sent to the applicant. The applicant may then submit arguments in response. Those arguments shall be taken into account when a decision is made on the results of the examination, provided they are submitted within six months of the notification being issued.

The substantive examination is followed by the examiner's decision, which may be in the form of a registration decision in full, a registration decision for a part of the applied goods or services (and, consequently, refusal for the rest of the goods) or a refusal decision affecting all the goods or services.

Provided the applicant agrees with the decision, the registration fee should be paid within the prescribed period of time.

## **ii Prior rights**

Russia is a first-to-file jurisdiction. Legal entities or entrepreneurs who first apply for registration of a trademark have a priority right to obtain trademark registration. Russian trademark legislation does not recognise prior use rights (as a general rule, the exclusive right to use a trademark in Russia arises as a result of state registration).

## **iii Inter partes proceedings**

There is no opposition system with respect to pending applications; however, recent amendments to the Civil Code provide that:

- the Russian PTO should publish information on filed trademark applications;
- third persons have the right to review all trademark documents on file and not only those comprising the filing of original trademark applications; and
- third persons have the right to submit to the Russian PTO their observations against pending trademark applications before official action is taken. Such written observations may be taken into account by the examiner during the examination. Observation letters may be used as the effective tool to make sure that prior rights are taken into consideration by the examiners.

Russian legislation foresees another instrument for raising objections based on prior rights against a trademark. Within five years of information on a registration being published in the official bulletin of the Russian PTO (after a trademark is registered), the owners of the prior trademark rights have an opportunity to file an invalidation action against the trademark registration with the Chamber of Patent Disputes of the Russian PTO. In the event of an invalidation action, the trademark owner is notified and both parties are invited to a hearing for the matter to be discussed. The Russian PTO then makes a decision to reject the invalidation action and leave the trademark in force, to invalidate the mark in full, or to partially invalidate the mark.

An invalidation action or a cancellation action against a trademark registration on other grounds already provided for by legislation may be filed during the entire term of validity of the trademark.

## **iv Appeals**

If a decision is not acceptable, the applicant may appeal to the Chamber of Patent Disputes of the Russian PTO within four months of the date the decision is issued. The decision that results from consideration of the appeal by the Chamber of Patent Disputes may be further appealed to the Intellectual Rights Court.

## **IV CIVIL LITIGATION**

### **i Forums**

Trademark infringement disputes are heard by commercial courts of first instance located in constituent parts of Russia. Their decisions may be appealed to the appellate commercial courts. Further appeals (on current cases) go through the Intellectual Rights Court and the Russian Supreme Court. Finally, a supervision appeal may be filed with the Russian Supreme Court.

In the case of a defendant not being a business entity or an individual entrepreneur, a court of general jurisdiction may also establish competence.

Trademark non-use disputes come under the exclusive jurisdiction of the Intellectual Rights Court, which hears such disputes on the merits in the first instance, and the Presidium of the Court hears cassation appeals on current cases. A supervision appeal may be filed with the Russian Supreme Court.

### **ii Pre-action conduct**

Pre-action cease and desist letters are not required. The exception is for claims of damages or compensation for IP infringement, where there may be a cause for action if there is a total or partial refusal of payment, or in the case of no response within 30 days.

Cease and desist or demand letters are now mandatory to a certain extent. In other words, it is not possible to sue an infringer in court by claiming damages or monetary compensation, if the demand letter is not dispatched in advance of the civil action. In accordance with the relevant law, the infringer has 30 days to respond to the cease and desist letter. Failure to respond, or receipt of a negative reply, provides the trademark owner (or its registered or exclusive licensee) with a legal standing to claim monetary relief. The easiest and most effective out-of-court enforcement option is to send a demand letter to the alleged infringer requesting a voluntary cessation of the trademark infringement.

### **iii Causes of action**

The following causes of action are applied in terms of trademark enforcement:

- trademark infringement – use of the designation, similar to the trademark, to individualise goods or services for which the trademark is registered, or for homogeneous goods or services, if as result of such use likelihood of confusion arises; and
- trademark infringement that may be a matter of unfair competition, which is prohibited in Russia. Unfair acquisition and use of trademark rights are not permitted. Passing-off and imitation of trade dress are also treated as unfair behaviour, which may be prosecuted. The Federal Antimonopoly Service (FAS) is empowered to consider disputes related to unfair competition through a special quasi-judicial procedure. This starts on the basis of a complaint to be filed by the injured party (e.g., a trademark owner or local distributor). Should the action on unfair competition be successful, the respondent (infringer) would be forced to cease the established illegal activities and pay the administrative fine in favour of the state budget (which may be up to 0.15 per cent of the corresponding infringer's profits). This procedure usually lasts about six to 10 months, although it can take longer if the binding order from the FAS is appealed in court.



Company names are protected against unauthorised use for the same activity by the company whose company name was included in the state company register later than the name of the plaintiff.

As regards commercial designations, it is not permitted to use a designation that may create confusion regarding ownership of the enterprise by a specific person, in particular a designation that is confusingly similar to the company name, trademark or a commercial designation owned by another person.

Domain names are not treated as an IP subject matter. However, good-faith senior users of domain names may argue bad faith if a lawsuit is filed by persons who register their designation as the trademark (in certain cases, a trademark invalidation action may be also appropriate).

#### **iv Conduct of proceedings**

Proceedings are initiated when all procedural requirements are met (i.e., payment of state duty, notification of the defendant, etc.). A representative needs to have a duly executed power of attorney.

The court schedules a preliminary hearing during which it considers whether the case is ready for a main hearing on the merits. The defendant is obliged to provide a response (objections) to the lawsuit.

Each party is obliged to prove the asserted facts: the plaintiff must prove that the defendant uses the trademark; and the defendant must prove whether there are legitimate grounds for use, or the defendant is in breach.

Various types of evidence may be used during the proceedings – documents (e.g., bills of lading and other sale confirmation documents), physical evidence (such as samples of counterfeit products), expert opinions, social poll results, private detective reports, witness statements, audio and video tapes. All evidence must meet the requirement of relevance to the case and admissibility.

At the appeal stage, new evidence is submitted only as a means of explanation of why the evidence was not submitted in the first instance.

Typically, proceedings in the first instance court last for three to six months, unless there are notification issues. The decision enters into force upon expiration.

The winning party has the right to recover court expenses (including legal fees), the amount of which is determined by the court, based on the submitted documents.

#### **v Remedies**

The remedies available for trademark infringement include:

- permanent injunction;
- damages or monetary compensation (in one of three determinations: (1) between 10,000 and 5 million roubles; (2) twice the cost of the counterfeit products; or (3) twice the cost of the licence);
- seizure and destruction of the counterfeit products; and
- publication of the court order.

The plaintiff may also claim a preliminary (temporary) injunction, such as the arrest of the allegedly counterfeit goods pending adjudication.

## **V OTHER ENFORCEMENT PROCEEDINGS**

### **i Administrative proceedings**

Unlawful use of a trademark shall incur an administrative fine, which has to be paid in favour of the state budget, and confiscation of the counterfeit goods for the purpose of destruction.

Administrative proceedings usually begin with a complaint, which the trademark owner has to file with the police or customs authority, so that the latter can take action. Administrative action may take about three to five months to complete, unless the decision of the first instance court is appealed by the infringer. Practically, an administrative procedure proves to be the most efficient enforcement option to cease trademark infringement at the border in the context of importation of counterfeit goods into Russia. This measure is also applicable when small shops offer for sale and sell counterfeit products on the domestic market.

### **ii Criminal proceedings**

Illegal use of a trademark may also lead to criminal, but only in the event of substantial damages being caused to the trademark owner, or if the trademark infringement is repeated. The typical statutory criminal sanctions are (1) a criminal fine; (2) forced labour; (3) correctional work; or (4) imprisonment. In the course of criminal procedures, the trademark owner is also entitled to file a civil lawsuit to recover damages. The total duration of criminal proceedings is usually hard to predict, although the approximate timing is one to two years, unless the decision of the first instance court is appealed by the infringer. In practice, criminal procedures are applied against large-scale or gross infringers who are manufacturing and distributing counterfeit goods in large quantities all over the country.

## **VI RECENT AND PENDING CASES**

The Russian legal system does not include precedents as sources of law. However, courts take into account legal positions in the decisions of the High Court (the Russian Supreme Court and the previously effective Supreme Commercial Court).

In the Resolution of the Russian Supreme Court of 20 January 2016 on Case No. 310-ЭС15-12683, A08-8801/2013, the High Court developed criteria under which the trademark infringement lawsuit may be dismissed due to bad faith. In the Resolution of 21.03.2016 N 307-ЭС16-1414 on Case No. A56-61922/2014, the Russian Supreme Court stressed the liability of the host-provider when not complying with the legitimate trademark owner's request to shut down the infringing website.

In terms of practice, attention should be paid to decisions by the Intellectual Rights Court, which acts as the cassation court for current cases.

The Intellectual Rights Court has considered many notable cases in recent years, including a trademark invalidation dispute filed by the heir of the first man in space, Yuri Gagarin, against alleged use of the surname in a trademark (Case SIP-238/2016), and an unfair competition case involving trademark registration of a popular soft drink (Case SIP-744/2014).

One example of a significant award for trademark infringement is a case involving the grey import of supplies of medical devices (Resolution of the Commercial Court of Saint-Petersburg and Leningrad Region of 6 June 2016, Case No. 56-709/2016), where the trademark owner was awarded 45 million roubles.

## **VII OUTLOOK**

The most recent development is the introduction of mandatory pretrial proceedings in non-use cases – the plaintiff must forward an offer to the trademark owner requesting assignment of the trademark or its abandonment.

Discussions are taking place with the aim of reconsidering the parallel import prohibition within the Eurasian Economic Union. Currently, the regional principle of trademark exhaustion is applied.

Trademark infringements on the internet have also been in the limelight during the past few years. Amendments on information intermediary liability now enable host-providers effectively to shut down infringing websites at the trademark owners' request.

## **ALEXANDER NESTEROV**

### *Gorodissky & Partners*

Alexander joined Gorodissky & Partners in 2001 and was promoted to partner at the firm in 2012. His experience includes counselling clients on protection and enforcement of trademarks and service marks, and appellations of origin and other trademark issues. He represents clients before the Russian PTO, commercial courts, and the Russian IP Court. Alexander also focuses on registration proceeding strategy and on infringement cases, and advises clients on transactional, opposition and cancellation work.

## **SERGEY MEDVEDEV**

### *Gorodissky & Partners*

Sergey joined Gorodissky & Partners in 2007. He advises clients on various matters related to legal protection, ownership, acquisition, exploitation, licensing, securitisation, litigation and enforcement of IP and IT rights in Russia and CIS. He litigates and actively enforces IP/IT rights in Russia. He combats unlawful and unauthorised use of IP/IT and illegal content on the internet, represses unfair competition and false advertising, tackles parallel imports and grey market goods, and fights against counterfeiting and piracy. Sergey represents the interests of clients in court and with law enforcement agencies.

## **ILYA GORYACHEV**

### *Gorodissky & Partners*

Ilya joined Gorodissky & Partners in 2013. He is a senior lawyer and focuses on providing legal support on intellectual property and general commercial matters, including unfair competition; domain disputes, licensing, assignments; franchising and other IP-related transactions; advertising and marketing regulations; IP issues in M&A transactions; IP due diligence; personal data protection; and industry-related regulatory affairs, including advising life science companies. He also assists with IP enforcement and anti-piracy, and handles all types of IP infringement cases before the courts and administrative bodies.

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