

# Knowing the procedure

There is a growing interest in establishing the fame of a mark in Russia, but brand owners need to ensure that they comply with established processes

State registration is a legal basis for trademark protection in Russia. Trademark rights do not arise simply as a result of trademark use before an application for state registration has been filed, or due to the fact that a trademark is famous. Nonetheless, as well as the usual trademark filing procedures through the Russian Patent and Trademark Office (Rospatent) or through Madrid international applications designating the Russian Federation, legal protection for a well-known trademark can also be obtained through a special recognition procedure at Rospatent.

Russia has been a member of the Paris Convention since 1965 and is bound to grant protection to well-known marks. Soviet trademark legislation provided for the protection of well-known trademarks through the 1974 Trademark Regulations and the 1992 Trademark Law. However, both statutes failed to indicate a competent authority for considering petitions for the protection of well-known marks and no rules or proceedings were specified for such marks to achieve protected status.

In 1998 the Russian government appointed the High Patent Chamber as the competent authority to consider requests to recognise trademarks as well known. Consequently, the Rules on Filing Appeals, Requests and Petitions and their Consideration by the High Patent Chamber were issued to regulate procedural issues of the filing and consideration of such cases. The Rules for Recognising Trademarks as Well Known in the Russian Federation were approved in 2000 and corrected in 2004. Subsequently, the High Patent Chamber and the Board of Appeals of Rospatent were restructured into a single administrative body: the Chamber of Patent Disputes. The chamber continued as the responsible authority for the consideration of well-

known trademark cases until January 1 2008, when Part IV of the Civil Code came into force. Part IV stipulates that requests to recognise trademarks as well known must be considered by Rospatent.

Currently, the following normative documents govern the protection and recognition of well-known trademarks:

- Part IV of the Civil Code (Articles 1508 and 1509);
- the Rules on Recognising a Trademark as Well Known in the Russian Federation; and
- the Recommendations of Rospatent for the Questioning of Consumers Regarding the Well-Known Character of a Trademark in the Russian Federation.

Three kinds of marks may be recognised as well known in Russia:

- a trademark protected in the territory of the Russian Federation on the basis of registration (ie, a Russian national trademark registration);
- a trademark protected in the territory of the Russian Federation without registration by virtue of an international treaty to which the Russian Federation is a party (ie, international trademark registrations protected in Russia in accordance with the Madrid Agreement and Protocol procedures); and
- a designation used as a trademark which is not protected in the territory of the Russian Federation.

A well-known trademark shall be granted the same legal protection as is provided for an ordinary trademark. Nonetheless, recognition of a well-known trademark provides its owner with certain advantages. First the legal protection of a well-known trademark is not time limited. Furthermore, protection also extends to

goods or services of a different kind from those 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 exclusive right to the well-known trademark and may impair the lawful interests of the owner.

According to Russian trademark legislation, in order to recognise a trademark as well known, the appropriate request should be filed with Rospatent. In Russia, unlike in many other countries, a trademark is not granted well-known status as result of court proceedings or litigation.

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, in its opinion. The trademark's well-known status should be evidenced by numerous documents and materials confirming the intensive use of the mark and its reputation among consumers, in association with the goods or services for which it is registered and in association with the trademark owner. The procedure involves the following steps:

- the collection of evidence of use in Russia and worldwide, including opinion polls that identify the goods or services for which the trademark has become well known and the date from which it has become well known;
- the preparation and filing of a petition to Rospatent;
- consideration of the petition by the Board of Examiners; and
- receipt of Rospatent's decision, payment of the official registration fee and the issue of a certificate confirming well-known status.

If the board considers that such

documents are insufficient to prove the reputation of the mark as from the date mentioned, the request for recognition of the well-known trademark will be rejected and the board will consider no further evidence. In such case the applicant has the opportunity to file a new request, which will be considered separately. As a rule, the applicant is not involved in the proceedings beyond filing the request with Rospatent, but if the board believes that the applicant should be involved, it might be invited to the hearing or asked to provide some clarification by means of written request.

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

- the results of a consumer survey regarding the goods at issue, revealing consumer knowledge of the trademark and performed by a specialist independent organisation;
- examples of intensive use of the trademark, especially in the territory of the Russian Federation;
- a list of countries where the trademark has acquired a well-known reputation;
- examples of advertising costs incurred relating to the trademark (eg, annual financial reports) and examples of advertising;
- details of the value of the trademark according to annual financial reports;
- information on the applicant's attendance at exhibitions;
- publications in Russian periodicals; and
- shipping documentation relating to the supply of goods to Russia.

In practice, special attention should be paid to the opinion poll results. Such polls must be carried out in at least six of Russia's largest cities.

It is not compulsory to submit all of this information. Trademark legislation does not contain a complete list of obligatory documents which must be submitted along with a petition for the recognition of a trademark as well known.

Information about the trademark's well-known status and registrations in other countries may be submitted when preparing a petition. However, this information alone is unlikely to constitute a good base for recognising the mark as well known in Russia. The main basis for recognising a trademark as well known is evidence of use in Russia and the results of an opinion poll.

Legal protection of a well-known trademark is not time limited. There are no requirements to validate well-known



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trademarks by any means, but such marks are vulnerable to cancellation or invalidation actions filed by interested parties.

When a trademark is recognised as well known, Rospatent will include it in the list of well-known trademarks and a certificate will be issued. Once the mark has been included in the list, information relating to the well-known trademark is published by Rospatent in the *Official Gazette*.

The main difficulty encountered during proceedings to establish the well-known status of a trademark 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 the trademark owner.

Determining the date from when the trademark became well known is also problematic and careful review of all available materials is thus required. The date from which the trademark became well known, in the applicant's opinion, should be indicated precisely. Meanwhile, the Civil Code

stipulates that a trademark or a designation cannot be recognised as well known if it became widely known after the date of registration of a third party's identical or confusingly similar mark, where that mark is intended to be used in connection with similar goods or services to those of the mark seeking well known status.

A petition to recognise a trademark as well known may further be denied if:

- the submitted materials and documents do not prove the fame of a mark in association with all goods mentioned in the petition;
- there is a discrepancy between the mark for which the petition was made and the way in which it has been used; or
- the submitted materials do not prove that the mark was used by the trademark owner.

Rospatent takes a strict approach towards petitions to recognise marks as well known and these are often denied.

Confusion with a well-known trademark may be a basis for:

- refusing to register a similar or identical trademark requested by any third party after the original mark has been recognised as well known;
- cancelling a trademark registration in the name of any third party if the registration might be confused with a well-known trademark; or
- prohibiting the use of a confusingly similar or identical trademark by any third party which is using, or intends to use, the mark in question in connection with similar or dissimilar goods or services, provided that such use is associated by consumers with the owner of the well-known trademark and infringes upon the owner's lawful interests and rights.

A well-known mark may be used as a tool to protect against the use of the same or a similar trademark for goods or services which are dissimilar to those for which the mark has been recognised as well known – provided that the mark used by a third party is likely to confuse consumers due to its association with the original well-known trademark. This option is often used by well-known trademark owners.

Interest in the recognition of well-known trademarks in Russia is growing. A well-known trademark registration may be effective when defending trademark rights and preventing others from registering similar or identical marks, even for dissimilar goods or services. **WTR**