

General Trademark Regulations

Trademark Law

Legal basis for trademark law is part IV of the Russian Civil Code, which came into effect on January 1st, 2008 as further amended, and substituted all there-existing IP laws.

The Russian Federation is a member of the Madrid Agreement and the Madrid Protocol.

Trademark protection is obtained by registration. Marks not deemed to be distinctive in the examination can be registered if distinctiveness has been acquired by use in Russia before the date of filing trademark application.

Trademarks which were protected in the former Soviet Union will be also protected in Russia.

Classification

Nice classification, 11th edition

What is Registrable as a Trademark

Any protectable word, design, slogan, sound, symbol etc. can serve as a trademark that identifies goods or services. The list of signs that may function as trademarks is open, which allows for registration of non-traditional marks.

Article 1482 of the Civil Code provides that verbal, pictorial, three-dimensional and other indications or their combinations may be registered as trademarks. A trademark may be registered in any colour or colour combination.

Registration of marks that are lacking in distinctiveness is not allowed. Particularly, the separate letters and combinations of letters, which do not have a word character or which are not perceived as a word, are regarded as void of distinctive character (for example the combination of vowels).

The following trademark types are registrable: trademarks, service marks, collective marks and well-known trademarks.

Registration Proceedings

The application is filed at the Federal Service of Intellectual Property (Rospatent).

Multiple-class applications are possible.

Foreign applicants need a local trademark agent.

A non-legalised power of attorney is sufficient for a local trademark attorney.

Foreign applicants do not need a domestic registration.

The examination in Russia consists of formal and substantial stages. During the formal expert examination, the presence of the necessary application documents and their compliance with established legal requirements is verified. The substantial examination stage is carried out to establish whether the claimed designation conforms to the registrability requirements.

A trademark application may be rejected either on absolute or relative grounds or on both absolute and relative grounds.

The processing time from first filing to registration or first office action is approx. 6-7 months.

The details of the application are published after registration of the application (after receipt of the application, which is filed in compliance with the existing requirements, by Rospatent).

The information about State registration of the trademark is published immediately after registration of the trademark in the State register of trademarks.

Opposition Period

Russian law contains no provisions governing formal opposition against pending applications. However, Rospatent publishes the details of trademark applications; after publication but prior to making a decision on trademark registration, any person is entitled to file with Rospatent written objections specifying the reasons for rejection of the Registration (according to p. 1 of Article 1493 of the Civil Code); the aforesaid objections are then taken into account during the examination of the application (the objections are to be based on Articles 1477 and 1483 of the Civil Code). The opposition procedure is not a substitute for, but supplements, the examination of the trademark application, which is conducted by Rospatent.

The invalidation actions against registered trademarks based on the following grounds may be filed at the Chamber of Patent Disputes of Rospatent within 5 years from the date of publication of information about state registration of trademark:

if a registered trademark is identical or confusingly similar to the trademark owned by a third party with the earlier priority date (both registered or applied for registration) in relation to similar goods or services;

if a registered trademark is identical or confusingly similar to third party's well-known mark with the earlier priority date in relation to similar goods or services;

if a registered trademark is identical or confusingly similar with third parties' appellation of origin or geographical indication protected in Russia or applied for registration before the priority date of the registered trademark;

if registered trademark includes the element(s) which are protected as the means of individualisation of other persons according to the Civil Code (or the elements confusingly similar to them) for similar goods and services;

if a registered trademark is identical/confusingly similar to a title of work of science, literature, or art, to a character or quotation from such a work, a work of art or a fragment thereof known in Russia on the filing date of the application for registration of a trademark, without the consent of the rights holder, if the rights to the respective work arose earlier than the priority date of this registered trademark;

if a registered trademark is identical/confusingly similar to a name, a pseudonym or their derivatives, to a portrait or facsimile of a person known in Russia on the filing date of the application without the consent of this person or his heir;

if a registered trademark is identical/confusingly similar to industrial design, conformity mark, the rights to which arose earlier than the priority date of the registered trademark.

The invalidation actions based on all other grounds stipulated by the Russian legislation are not restricted by any deadline. This means, that in case, e.g. violation of company name or misleading nature of the trademark is claimed, a trademark can be revoked within the whole time it is in force.

Invalidation actions against registered trademarks based on relative grounds (them being similar or identical to other persons' trademarks having an earlier priority) may be filed at the Chamber of Patent Disputes of the Russian Patent and Trademark Office within 5 years from the publication date of the registered trademark. Invalidation actions based on all other grounds stipulated by the Russian legislation are not restricted by any deadline. This means, that in case, e.g. violation of company name or misleading nature of the trademark is claimed, a trademark can be revoked within the whole time it is in force.

Trademark Duration

A trademark registration is valid for 10 years from date of filing the application (or in case of filing a divisional application - for 10 years from date of filing first application).

The registration is renewable for periods of 10 years.

Trademark Application Fees

The official fee for filing a trademark application is RUB 3,500 for up to five classes and RUB 1,000 for each additional class (if more than five classes are requested). The examination fee is RUB 11,500 for one class and RUB 2,500 for each additional class. The official fee for the registration of a trademark and issuance of the certificate of registration in the electronic form is RUB 16,000 for up to five classes and RUB 1,000 for each additional class (if more than five classes are requested). The official fee for issuance of the certificate of registration in a paper form (if such document is required) is RUB 2,000. A 30% reduction of the amounts of the official fees is available in case of electronic handling of trademark cases.

Latest update

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Gorodissky & Partners, Moscow, Russian Federation

Trademark Use Requirements

1. Use for trademark registration

In Russia, use is not required for trademark registration. Evidence of use is not presented at the time of filing a trademark application.

2. Use for trademark renewal

In Russia, use is not required for trademark renewal. Evidence of use is not presented at the time of filing a trademark renewal application.

3. Use in order to preserve rights in a trademark

In Russia, a trademark may be subject to cancellation if the mark has not been used within three years from the date of registration or has thereafter not been used continuously for three years.

Non-use cancellation procedures are reviewed by the Intellectual Property Court (IP Court), located in Moscow. IP Court has the exclusive jurisdiction over this type of cases as the first instance court and cassation court.

In the course of court proceedings, the claimant is required to prove a legitimate interest in the cancellation of a trademark, while the defendant is required to prove the real and proper use of the trademark.

Partial non-use cancellation is available. It is possible to include several similar trademarks registered in the name of the same owner (defendant) into one non-use cancellation action, however, IP court may subsequently divide actions against different trademarks into several, at their own discretion.

3.1 Burden of proof

The burden of proof of use remains with the trademark owner. In other words, the defendant must prove the use of a litigious mark.

3.2 Nature and extent of use

It is necessary to support use in the local jurisdiction, i.e. in Russia. Use in other countries is irrelevant.

The use shall be actual and continuous. Sporadic, intermittent, token or one-off use will not suffice.

Use must be related to real sales and marketing of goods and services, as well as passing (provision) of such goods and services to end-users and consumers. In this context, invoices and checks showing trademarked goods and services and the years of sales, will be very helpful.

It will be also advisable to show that the trademark owner has taken all reasonable and preparatory steps to further production and sales of the goods or provision of services, for example, through advertising, promotional activities, signing preliminary contracts, etc. It will not suffice to use only a trademark application as evidence of intent and demonstrating a legitimate interest.

Use by a licensee constitutes genuine use if the above evidence is submitted. A licence is subject to state registration with the Federal Service for Intellectual Property (Rospatent). Failing such registration, licences are deemed invalid against third parties, however, the lack of licence registration does not affect the proof of use. In other words, even an unregistered licence may serve as proper evidence of trademark use.

In addition to the use of a trademark by its owner and licensee, use of a trademark by a third party under the trademark owner's control may be also defined as eligible use. Trademark owner's control must be documented either on the corporate or contractual basis.

3.3 Means of demonstrating use

Use may be demonstrated by means of photographs of products or product packages bearing the mark, labels, catalogues, price lists, production agreements, invoices, advertisements, etc. showing the year of production or sale. References to trademark owner (its licensee or controlled person) and the whole chain of product transfer – from the trademark owner to the end-user or consumer – must be disclosed.

All documents confirming trademark use may be submitted in copies; however, the original documents must be available at court hearings. Russian translation is mandatory.

The evidential material shall contain the dates of use which shall relate to the three recent years before a pre-trial request has been sent to the defendant. The pre-trial request is a must and cannot be avoided in such type of proceedings.

Evidence should also include certificates/declarations of compliance, hygiene certificates or other similar documents required for the sale of the respective goods in Russia. Customs declarations confirming the import of such goods into Russia, an agreement between the exporter and the party in whose name the goods are imported, supply and distribution agreements, etc. should be also provided in case the marked goods are produced outside Russia.

3.4 Circumstances and time periods for excusable non-use

There are certain circumstances and time periods of excusable non-use, for example, force-majeure facts, sanctions and clinical trials may be regarded as such. Of course, such circumstances must be documented to serve as evidence of excuse to non-use.

The IP Court has viewed bankruptcy proceedings initiated with regard to a trademark owner company as circumstances justifying the non-use of a challenged trademark, however, the Supreme Court has recently changed this position. Nowadays, bankruptcy proceedings may not be regarded as the excuse to non-use.

4. Further relevant aspects or legal provisions with regard to the use of a trademark

Reimbursement of Legal Costs: If the IP court partially satisfies the claim (for example, only in connection with one class), the legal costs are reimbursable in full. The doctrine of 'proportionality of legal costs' is not applicable for this type of cases.

International Registrations

The same evidence and rules of trademark use shall be presented with respect to all trademarks, either national or international registrations if they are challenged on the ground of non-use by a third party.

Legal protection of an international registration may be terminated with regard to all or part of the goods/services if the trademark has not been used for any three consecutive years following its grant of protection date in Russia.

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Grace Period for Trademark Renewal

Regular TM renewal time

A trademark may be renewed during 1 year preceding the expiry date. There is also a special six-months grace period if this year has been missed.

Formal requirements for renewal

Power of Attorney from the owner of the trademark is required. No proof of use shall be presented.

Publication of renewals

Renewals are published in the Official Bulletin and reflected in the online trademarks database.

Grace period for renewals

The grace period for renewals is 6 months starting the day after the expiration date of the trademark.

Additional fees during grace period

The additional official fee for late renewals during the grace period is RUR 2,500 per renewal. A 30 per cent reduction of the amount of the official fees is available in case of electronic handling of trademark cases

Proceeding after expiry of grace period

After expiration of the grace period, the trademark is automatically invalidated.

Notification of owner/agent of pending cancellation due to non-payment

Neither a notification on the necessity to pay renewal fees nor information on expiry of a trademark are issued by the Trademark Office.

Restoration of lapsed TM

Once lapsed the trademark cannot be restored.

Possibility of reregistration by 3rd parties after lapse

A lapsed trademark may be re-registered in the name of a third party at any time.

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Trademark Licensing

Trademark Licence Agreement

A written form of a trademark license agreement is obligatory. A trademark can be licensed for some or all of the goods/services covered by trademark registration and for all territory of the Russian Federation or its part. Licenses may be sole, exclusive or non-exclusive. The sale or assignment of a registered trademark does not automatically terminate the license. Consent of licensee is not required to assign a licensed trademark. There are certain statutory provisions prescribing the terms of licensing. For example, the licensee shall be obliged to control the quality of the licensed goods/services as set by the licensor, and the latter has the right to control the compliance of this provision; both parties are jointly liable for claims of third parties filed against the licensee as a manufacturer (producer) of goods (services). The license agreement must provide for the amount of compensation, or define a procedure of calculating thereof. Otherwise, it has to be expressly declared in the agreement that the granted licence is gratuitous (the latter should not be stated for agreements between commercial entities).

Recordal

There are certain provisions in the law providing for the mandatory recordal of trademark licenses with Federal Service for Intellectual Property (Rospatent). There is no time frame for filing and recordal of a trademark license in Russia. Only licensing of registered marks is recorded. Licences against pending marks or trademark applications cannot be filed and recorded with Rospatent.

There is no prescribed form for a license agreement. Parties are free to choose their own form of contract and governing (applicable) law, but it must contain the following required information (i.e. terms and conditions):

1. The territory (by default, the licensee shall have the right to exercise its use throughout the whole territory of Russia)
2. The trademark (its registration number)
3. The goods and services for which the licence is granted (as per trademark registration and relevant classes)
5. The full and correct names and addresses of licensor and licensee
6. The duration of license (by default, the term is considered to be five years)
7. The type of licence (by default, the license is considered to be non-exclusive)
8. The manners of the permitted use (e.g. manufacture, sales, advertising)
9. The compensation for the license granted (e.g. lump-sum payment, royalties)
10. Quality control clause
11. Sublicensing clause (by default, sublicensing is prohibited)
12. Termination clause (mutual and unilateral; by default, unilateral termination is not allowed)

The following documents are required for a recordal:

1. A power of attorney (if the request for a recordal is filed by a representative)
2. A genuine license agreement, or its notarized extract with essentials, or a notification with essentials, jointly signed by both sides.

Names and positions as well as clear signatures of the signatories must be indicated. Stamps (corporate seals) are required for Russian entities. Notarization and legalization are not required.

Effectiveness

The license agreement becomes effective from the date of its conclusion; however, the license is considered as granted and enforceable against third parties only after the official recordal with Rospatent. Retroactivity clauses are enforceable.

Non-use Cancellation and Infringement Proceedings

The use by a recorded or unrecorded licensee is a permitted use. Recordation of a license does not play a decisive role, i.e. it does not affect the decision on trademark non-use as there should be other related documents confirming the sale and marketing of trademarked goods in commerce (e.g. invoices to customers). The licensee may join the trademark owner in infringement proceedings if their rights are affected.

The exclusive licensee can institute infringement proceedings in Russia if its rights are affected (infringed). Only an exclusive and recorded licensee may institute infringement proceedings in his own name. The non-exclusive licensee does not have such a privilege.

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