

Maintaining trademark rights when business operations are reduced: the role of proactive re-filing

Alexander Nesterov of Gorodissky & Partners examines the legal risks associated with non-use and outlines practical re-filing strategies to help companies safeguard their brands in uncertain conditions.



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Proactive re-filing should be treated not as an abuse of rights, but as a legitimate and pragmatic adaptation tool that preserves the legal presence of a brand until commercial activity can resume.

In the context of a changing geopolitical landscape and the transformation of the international business environment, many foreign companies have revised their presence in the Russian market. Reduced operations, suspended activities, or a complete exit create a practical legal dilemma: how can a rights holder maintain exclusive trademark rights in a jurisdiction where business presence is limited or absent? This article explains the legal risks of a passive approach and outlines proactive re-filing as a pragmatic tool for preserving trademark protection in conditions of uncertainty.

A trademark is a designation that enables consumers to distinguish the goods and services of one producer from those of others. For many companies, trademarks are among their most valuable intangible assets: unauthorized use can mislead consumers as to the origin of goods or services and cause reputational harm. Accordingly, effective protection requires proper registration and maintenance of rights.

Circumstances

Premature termination for non-use: Article 1486 of the Civil Code

Under Article 1486 of the Civil Code of the Russian Federation, legal protection of a trademark may be prematurely terminated (in relation to all goods or part of the goods/services) if the trademark is not used continuously for three years with respect to the goods/services for which it is registered.

Pre-trial step and claim window

An interested party that believes the rights holder is not using the trademark sends the rights holder a proposal to either:

- apply to the federal executive authority for intellectual property (Rospatent) with a statement of renunciation of the right to the trademark;
- conclude an agreement on alienation (assignment) of the exclusive right (in full or in part).

If, within two months from sending the proposal, the rights holder neither files the renunciation statement nor concludes the assignment agreement, the interested party

has the right to apply to the court within 30 days after the expiry of those two months, seeking premature termination of legal protection due to non-use.

Who may "use" the trademark and who bears the burden of proof

Use is recognized when the trademark is used by:

- the rights holder;
- a licensee under a license agreement;
- another person using the trademark under the rights holder's control.

The burden of proving use lies with the rights holder. When deciding a non-use claim, the court may consider evidence that the trademark was not used due to circumstances beyond the rights holder's control. Although the law allows excusable reasons for non-use in principle, courts may assess such arguments critically where use was suspended after February 2022 due to the owner's voluntary withdrawal from the Russian market.

What qualifies as "use": Article 1484 of the Civil Code

Under Article 1484 of the Civil Code, use of a trademark includes placement of the trademark:

- on goods (including labels and packaging) produced, offered for sale, sold, displayed at exhibitions and fairs, or otherwise introduced into civil circulation in the Russian Federation, as well as stored, transported, or imported for such purposes;
- in the performance of works or rendering of services;
- on documentation related to the introduction of goods into civil circulation;
- in offers for sale, advertising, signage, and promotional materials;
- on the Internet, including in domain names and other addressing methods.

Key risks when operations are reduced or ceased

When commercial activity is reduced or suspended in Russia, foreign rights holders face several interconnected risks:

- non-use termination risk; competitors or other interested parties may initiate premature termination proceedings (in whole or in part); without evidence of use for the prior three years, the trademark becomes vulnerable;
- third-party filings after termination; if the mark is terminated, similar designations may be registered by

third parties, creating legal barriers to resuming activities;

- bad-faith registrations and counterfeits; designations that reproduce, copy, or imitate famous foreign brands may be registered by unscrupulous persons in anticipation of a subsequent buyout; third parties may also start producing counterfeits that damage reputation;
- dilution and loss of consumer trust; in a prolonged absence of original goods, consumer recognition may erode; use of imitative signs can lead to dilution and loss of trust that may require time to restore upon return;
- loss of customs enforcement leverage; the former rights holder may lose the ability to combat counterfeits at customs.

Collectively, these consequences may materially complicate or block a future return to the market under the same brand.

Proactive re-filing as a preservation tool – and an important constraint

One effective tool for preserving rights in difficult conditions may be proactive re-filing of an application for an already registered trademark that has not been used for more than three years (or is approaching that period).

Constraint: the "duplicate registration" issue (Article 1481)

Article 1481 emphasizes that a trademark certificate certifies the exclusive right of the owner in relation to the goods and services specified in the certificate. As a result, registering a designation identical to an existing trademark in the name of the same rights holder for an identical list of goods and services may be treated by the trademark authority as contradicting the nature of exclusivity and as contrary to public interests.

Therefore, if a rights holder's goal is to secure a new, "fresh" registration that effectively restarts the three-year non-use grace period while preserving a legal and commercial connection with the original brand, the filing strategy must be structured to avoid an impermissible "duplicate" for the same scope.

Practical re-filing options applied under current conditions

Several applicable and effective approaches are described below:

Option A – change the object of protection (the designation)

File a designation that is not identical to the

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existing mark but retains recognizability. This appears to be the most legally safe path.

Practical techniques include:

- adding verbal elements (e.g., “[Original Brand] Premium”, “[Original Brand] Group”), ensuring the additions change overall phonetic and semantic perception;
- changing color or graphics (e.g., monochrome if the original was in color, or minor graphical refinements);
- registering the word element separately from the graphic logo, or vice versa.

Option B – change the scope of protection (goods/services list)

File an identical designation but for a different list of goods and services. A practical approach is to analyze the existing list, identify strategically important positions, and file a new application focused on them, refining or narrowing broad terms (e.g., specifying more precise types of software or clothing rather than using overly broad terms).

Option C – direct replacement with loss of priority (least desirable, but possible)

File an identical mark for identical goods/services; when the earlier registration is cited during examination, the rights holder files a statement of renunciation of the earlier registration, allowing the new application to proceed. The critical drawback is that the priority date of the old mark is irrevocably lost, which may weaken the position in disputes with third parties that may have begun using the designation in the interim.

Combined strategy (often optimal)

The optimal approach is often a combined strategy. For example, filing a series of applications:

- for a modified graphic designation for key goods;
- for the verbal part separately for a broader list;
- for a combined designation if the previous registration for verbal and graphic elements was separate for the same goods and services.

This creates flexibility for proper future use aligned with the registrations.

Final recommendations

In conditions of forced reduction of operations in Russia, trademark management should shift from an operational approach to a strategic one. Doing nothing and attempting to “sit out” the crisis can be portrayed as the riskiest scenario, potentially leading to loss of rights. Proactive re-filing should be treated not as an abuse of rights, but as a legitimate and pragmatic adaptation

tool that preserves the legal presence of a brand until commercial activity can resume.

Recommended action plan:

1. Proactively act before the three-year non-use period expires.
2. Conduct a trademark portfolio audit and identify vulnerable registrations and key brands on a regular basis.
3. Select a re-filing tactic for each key brand (prefer Option A; use Option C only if the others are not workable).
4. Structure evidence of “use” in line with Article 1484 to be able to discharge the burden of proof if challenged.
5. Periodically monitor the market and filings to detect and respond early to bad-faith applications, registrations, and counterfeit risks.
6. Companies that approach this issue proactively retain legal “gateways” for returning, while less prudent competitors may find those doors closed.

RÉSUMÉ

Alexander Nesterov, Partner and Russian Trademark Attorney, joined Gorodissky & Partners in 2001 and was promoted to partner at the firm in 2012. His experience includes counseling 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 is keen on registration proceeding strategy and infringement cases. He also advises clients on transactional, opposition, and cancellation work.

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