

# GORODISSKY & PARTNERS PATENT AND TRADEMARK ATTORNEYS

INFORMATION  
BULLETIN



## #88

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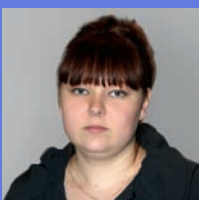


**2013** *Season's Greetings to all our dear clients, associates and colleagues! We wish them happiness, business success and prosperity in the coming year!*

EKATERINA SOLONITSYNA, LAWYER, GORODISSKY AND PARTNERS (EKATERINBURG)

## TRADE MARK AS A COMPETITIVE TOOL

So it happened in our court case, which has become quite famous by now, and where we may draw the line now. It all started back in September 2009, when the lawyers of Ekaterinburg branch of Gorodissky were asked for assistance by an individual entrepreneur, who had already lost his case in the court of first instance.



The gist of the case was that one of the manufacturers of plastic containers in the Perm region registered more than 170 different device trademarks.

Thorough expertise of the said trademarks showed that all of them were schematic representations of relief of the upper surface of covers of a variety

of plastic packages. Those trademarks were registered in respect of the goods of Classes 16 and 30 (plastic packaging and confectionery).

In the court proceedings, involving the lawyers and trademark attorneys of Gorodissky the matter under consideration was the infringement of

were filed (this was also the conclusion made in the court judgment). After consideration of the case materials, it became apparent that the

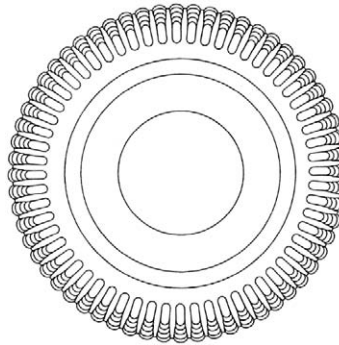
the rightholder's actions related to the acquisition and use of the exclusive rights to the trademark according to Certificates 347507 and 353185, as

an act of unfair competition. In this case, it was necessary to prove that those packages for the cakes had been widely known before the date filing the applications for trademarks, the notoriety of the designation itself, and its use by various persons independent from the rightholder (there were collected various product catalogs, letters from the manufacturers of the packaging, etc.). The bad faith of the rightholder was also obvious in that by registering the trademarks in question, he did not tried in fact to get exclusive rights not to the means of individualization, but to the artistic

**THE UNIQUE CHARACTER OF THE CASE CONSISTED IN THE FACT THAT THE USE OF THE PLASTIC PACKAGING FOR THE CAKES WITH A RELIEF SIMILAR, IN THE OPINION OF THE COURT, TO THE TRADEMARK, WAS RECOGNIZED AS THE USE OF THE DEVICE (NOT 3D!) TRADEMARK**



Cake package



Trademark Registration # 353185

the exclusive rights for two trademarks: under Certificates Nos. 347507 and 353185. In so doing, the claims were laid against both the manufacturer of plastic packaging for the cake,

and the manufacturer of confectionery products, who sold his products in these plastic containers, and also against the owner of the store, who was selling confectionery in the disputed packaging.

The unique character of the case consisted in the fact that the use of the plastic packaging for the cakes with a relief similar, in the opinion of the court, to the trademark, was recognized as the use of the device (not 3D!) trademark. In this case, the court considered the inseparable part of the cover of the package of the cake to be the trademark itself applied by thermoforming method (despite the opinion of the forensic expert that the cover of the packaging for cakes did not have a trademark at all, i.e. there was no designation which could be perceived by consumers as a trademark. This

conclusion was supported by the results of a public poll). In addition, the specific feature of the situation was that the packaging for the cakes

with the controversial relief had been manufactured by the defendant much earlier than trademark applications

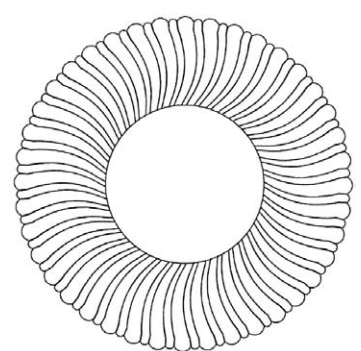
**THE BAD FAITH OF THE RIGHTHOLDER WAS ALSO OBVIOUS IN THAT BY REGISTERING THE TRADEMARKS IN QUESTION, HE DID NOT TRIED IN FACT TO GET EXCLUSIVE RIGHTS NOT TO THE MEANS OF INDIVIDUALIZATION, BUT TO THE ARTISTIC AND DESIGN SOLUTIONS OF THE OUTER LOOK OF A LONG-KNOWN AND WIDELY USED PRODUCTS**

current legislation has no provisions regulating the situation which came to exist in this case. It is for this reason that both the Court of Appeal, and the Court of Cassation upheld the judgment of the court of first instance. In parallel with the court hearings,

and design solutions of the outer look of a long-known and widely used products. Moreover, in this situation, the exclusive rights to the trademarks gave the rightholder the opportunity to prohibit third parties from manufacturing not only the pack-



A cover for cake package



Trademark Registration # 347507

**MOREOVER, IN THIS SITUATION, THE EXCLUSIVE RIGHT TO THE TRADEMARK GAVE THE RIGHTHOLDER THE OPPORTUNITY TO PROHIBIT THIRD PARTIES FROM MANUFACTURING NOT ONLY THE PACKAGES CONTAINING THE IDENTICAL DESIGNATION, BUT ALSO FROM USING A CONFUSINGLY SIMILAR DESIGNATION. THAT GROUP OF THE GOODS COVERED A LARGE NUMBER OF PACKAGES WHICH DID NOT HAVE CLEAR-CUT INDIVIDUAL FEATURES AND WHICH WERE PRODUCED AT THAT TIME BY A NUMBER OF DIFFERENT COMPANIES**

ages containing the identical designation, but also from using confusingly similar designations. That group of the goods covered a large number of packages which did not have clear-cut

individual features and which were produced at that time by a number of different companies.

the lawyers of Gorodissky decided to submit to the anti-monopoly authority a complaint for the recognition of

**DESPITE LONG DURATION AND COMPLEXITY OF THE CASE, THE LAWYERS AND ATTORNEYS OF GORODISSKY WERE ABLE TO ACHIEVE RECOGNITION BY THE ANTI-MONOPOLY AUTHORITIES OF THE Rightholder's ACTIONS ASSOCIATED WITH THE STATE REGISTRATION OF TRADEMARKS UNDER CERTIFICATES 347507 AND 353185, AS AN ACT OF UNFAIR COMPETITION. THE COURTS RECOGNIZED THE DECISION OF THE ANTI-MONOPOLY AUTHORITY LAWFUL AND JUSTIFIED**

The situation was complicated by the fact that the rightholder was the owner of a huge number of trademarks (over 170), which were schematic representations of the relief of the covers of different packages for cakes, produced by third parties independently from the rightholder. This meant that the rightholder had the real opportunity to influence the market for plastic packaging in the whole territory of Russia, in particular, by not allowing third parties to produce many types of packaging for cakes. It should be noted that the rightholder himself did not make most of the packages the surface relief of which could be considered similar to the trademarks registered by him, nor did the rightholder use many of the registered trademarks for marking his own products. Despite long duration and complexity of the case, the lawyers and attorneys of Gorodissky were able to achieve

recognition by the anti-monopoly authorities of the rightholder's actions associated with the state registration of trademarks under Certificates 347507 and 353185, as an act of unfair competition. The courts recognized the decision of the anti-monopoly authority lawful and justified. This, in turn, allowed Gorodissky & Partners to apply to the Russian PTO and seek invalidation of the said

**AS A RESULT, THE CLAIMS OF THE Rightholder WERE DISMISSED IN FULL, IN ADDITION, HE LOST TWO OF HIS TRADEMARKS**

trademarks which eventually formed the basis for the revision and subsequent cancellation of the judgements of the court upon new or newly discovered circumstances. As a result, the claims of the rightholder were dismissed in full, in addition, he lost two of his trademarks. This case is important because it es-

tablishes a precedent by which other manufacturers of plastic packaging can at least in some way protect their rights and be able to continue producing their products. However, despite favorable outcome of the aforementioned lawsuits, the situation is still problematic. Gorodissky & Partners managed to cancel two registrations however that person has more than 170 similar trademarks. This suggests that such lawsuits may occur over and over again, leading to serious financial and time losses for the good will producers. In this regard, it is hoped that the judicial practice on this issue will be changing, in particular; the courts in cases of illegal use of a trademark will be more and more, along with other issues, clarify the question of whether the controversial designation is used by defendants as a means

of individualization or this designation performs other functions and is not perceived as a trademark by the consumers. Certainly, some changes in this regard are already visible but the Russian courts still rarely practice this approach.

# MARK YOUR CALENDAR! GORODISSKY IP SEMINAR IN ST. PETERSBURG - 2013

On August 28-30, 2013, Gorodissky & Partners will host the 9th IP Annual Seminar «Obtaining and enforcement of intellectual property rights in Russia» for foreign clients and associates as well as for all those interested in learning and updating the knowledge about the Russian IP ever changing landscape, now especially in view of the Russia's joining WTO.

This time our focus is on IP rights in automobile industry and related sectors. In addition to Gorodissky team of speakers we are going to invite Russian and foreign IP experts from major automobile manufactures including those from Russian-based facilities near St.Petersburg, Kaliningrad and Kaluga to share their expertise.

The Seminar will be held in one of the best city hotels – Kempinski Hotel Moika 22 St.Petersburg

We invite you for getting a lot of professional and sightseeing fun in the marvelous city of St. Petersburg!

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# NEWS

## OCTOBER, 15. 2012, TORONTO

Sergey Medvedev, Lawyer, LLM (Gorodissky & Partners, Moscow) spoke on «Russia joins the WTO: Changes in the Russian IP & Tech Climate Coming» at the Hot Topic Workshop during LES USA & Canada Annual Meeting together with Paul Jones, Head of Jones & Co. (Canada). The Conference gathered more than 900 delegates.

## OCTOBER, 3-6. 2012, BARCELONA

Vyacheslav Rybchak and Vadim Shipilov, Trademark attorneys (Gorodissky & Partners, Moscow), attended the 85th Annual Pharmaceutical Trade Marks Group (PTMG) Conference headlined «Realities for Pharmaceutical Trade Marks in the Physical and Virtual World». More than 400 attendees discussed topical questions such as legal aspects of pharmaceutical trademarks protection, trade dress and non-traditional trademarks, social media and compliance.

## SEPTEMBER, 18-21.09.2012, ATHENS

Irina Korzun and Alexander Nesterov, Partners and Trademark attorneys (Gorodissky & Partners, Moscow), took part in the 26th MARQUES Annual Conference «Trade Marks: Sign of the Times». About 600 attendees considered topical issues for brand owners, including the impact of social media and domain name expansion, new enforcement and anti-counterfeiting strategies and the latest developments on third-party use of trade marks. There were also the regular Workshops and updates on WIPO, OHIM and CJEU case law.

## SEPTEMBER, 9-11.09.2012, HELSINKI

Viktor Stankovsky, Partner, Patent Attorney, and Yaroslava Gorbunova, Lawyer (both of Gorodissky & Partners, St.Petersburg), attended the LES Scandinavia Annual Meeting which gathered over 100 delegates from Finland, Sweden, Denmark, USA, China and Russia. Topic issues of IP protection and technology transfer were in the focus of discussion.



PHOTO (FROM LEFT TO RIGHT): JAMES E.MALACKOWSKI, LESI PRESIDENT, ZHANG XINMIN, FIRST SECRETARY OF THE CHINA EMBASSY IN FINLAND AND VIKTOR STANKOVSKY, GORODISSKY & PARTNERS

## SEPTEMBER, 5-7. 2012, MOSCOW



PHOTO: THE AUDIENCE The 8th Annual IP Seminar «Obtaining & Enforcement of IP Rights in Russia» was held in the Moscow office of Gorodissky & Partners.

About 20 leading patent/trademark attorneys and lawyers of the Gorodissky shared with the international audience the up-to-date information on IP legislation in Russia. The most interesting cases from Gorodissky attorneys practice were presented, as well as general overview of current legal issues. Topical questions like patent and trademark proceedings before the Russian and Eurasian Patent Offices, overall IP enforcement and litigation, parallel import, trade dress and know-how protection, use of utility models, protection of IP rights within Eurasian economic unity etc. attracted much attention of the attendees. Two special Workshops devoted to trademarks and biotech/pharma patents successfully added seminar sessions.

The seminar was well-attended by over 30 professionals from Denmark, Sweden, Germany, USA, UK, Switzerland, the Netherlands, Abkhazia, Belarus and Russia, who represented ABBYY Software House, Siemens AG, LEO Pharma, ABB, Novartis, JETRO and others.

## SEPTEMBER, 3-4. 2012, TOKYO

Sergey Vasilyev, Ph.D, Lawyer (Gorodissky & Partners, Moscow), gave a presentation «Disposal of know-how: a challenge to practitioner» at the Licensing Executives Society (LES) Asia Pacific Regional Conference «Maximizing the Value of Licensing Intellectual Property in Pan Asia». The conference welcomed representatives of public institutions, patent and trademark firms, R&D centers, universities, courts, transnational corporations from many countries.

## JULY, 03-04. 2012, MOSCOW

Vladimir Mescheriakov, Counsel, and Sergey Medvedev, LLM, Lawyer (both of Gorodissky & Partners, Moscow), were speakers at the regular seminar «Enforcement of IP rights in Russia» held by M-Logos Law Institute on topic issues of protection and turnover of IP rights in Russia.

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