

## No Trademark Pirate Can Avoid CANON Fire

Vladimir Biriulin, Partner at Gorodissky & Partners, Russia, documents the details of a case in which Canon defended its well-known trademarks in Russia against a local company's attempt to cancel and copy them.

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Canon, the familiar name of the Japanese optical, imaging, and industrial products company, came to Russia more than 25 years ago with its cameras and printing paraphernalia, and became popular due to the quality of its products. From the outset, Russia became an important market for hi-tech equipment, and Canon could cater to the needs of amateur and professional users. Building on its cautious marketing strategy in Finland through its subsidiary, Canon expanded into Russia and established a Canon Russia subsidiary.

For many years, Canon supplied equipment to Russia with no questions asked. In the spring of 2022, Canon temporarily suspended its business in Russia because of the conflict in Ukraine, or because of the high volatility of the Russian Ruble as some media explained.

By that time, Canon had a number of its trademarks registered in Russia. Namely:

**CANON** (№ 28129),

**Canon** (№ 58987),

**Canon** (№ 314687),

**КЭНОН** (№ 320959),

**Canon Business Center**

(№ 375851) in class 9.

As is known, in Russia, after a three-year period of non-use of a trademark, an interested person may cancel it. An interested person may be any person who has a lawful interest in the cancellation of the trademark. That person should have the intention to use the trademark not only for labelling goods for which the trademark is registered, but may also use it for similar goods. When some foreign companies left the Russian market, there were a number of attempts by "interested" persons to

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register trademarks similar to those belonging to the companies that had left the market.

Stroyresurs Ltd., a Russian company, filed a trademark application No 2023739712

**[CANON]** in 2022 in Class 9, obviously planning to cancel the original trademarks in due time.

One year later, the patent office issued a notification informing Stroyresurs that its applied designation is similar to Canon's trademarks. Stroyresurs, following its plan, initiated a non-use court action against Canon. In order to prove its interest as required by law, Stroyresurs submitted a preliminary supply contract for electronic locks labelled with CANON designation, an agreement of joint activities for developing a pilot sample, a task order, and other similar documents. Based on those documents, the plaintiff argued that they were indeed an interested person to cancel the trademarks in respect of mechanical locks, electronic and electrical locks, and eye viewers.



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Canon traversed the claim, arguing that the plaintiff had no real interest in the cancellation of the trademarks but was interested in registering a trademark identical to famous trademarks and imitating the name of the well-known company. They wanted to ride on the popularity of the Canon trademarks, confuse consumers, and obtain unfair advantages for promoting their goods on the market. The disputed trademarks became well known through long periods of use in general, as well as with respect to specific goods such as cameras, printers, scanners, and other goods.

The court noted that the plaintiff had previously (January 2024) sent a proposal to Canon, asking it to abandon its trademarks, but the letter went unaddressed. Such a letter is a formal requirement of the law.

The court agreed that there was indeed a preliminary contract for working out designs of locks, eye viewers, and other items carrying the designation **CANON**. The catch, however, is that the contract was concluded after the proposal to abandon the trademarks was sent, which means that the plaintiff had no interest in the trademarks before that proposal. When trying to cancel a trademark, the plaintiff must provide evidence showing that they do something in connection with the marketing of goods for which the disputed trademark is registered, i.e., electronics. Absence of interest is an independent basis for rejecting the cancellation claim.

The court compared the applied designation **CANON** and the trademarks owned by Canon and found a high degree of similarity between them. The court took into account information provided by the Japanese company. Thus, according to a public survey, 96% of respondents are familiar

with the trademark **Canon**, 66% of respondents said that this designation is used for cameras, accessories, and lenses, 37% for chargers, and so on. All associated goods are concatenated with the Japanese company. In so doing, people have known the name CANON for many years, and many of them bought and used the goods made by Canon.

Besides, 53% of the respondents said that the designations **CANON** and **Canon** are different versions of the same name, and that they are owned by the same company, and that the products marked are manufactured by Canon or with its permission or license.

The court concluded that the Japanese company is widely known in Russia, which may be explained by its presence in the Russian market for many years. Considering the arguments put forward by both sides, the court dismissed the Russian company's claim.

It should be noted that there was another court case one year earlier: Stroyresurs applied to cancel another Canon trademark, No 90917 in Class 6, and was successful in cancelling CANON trademark for metal and non-metal cables, strongboxes, and wires. Inspired by the success, it attacked Canon again, hoping to divest it of all other trademarks, but failed.

**Bottom line:** The plaintiff failed to cancel Canon's trademarks because it could not prove its interest. That does not mean that the trademarks are now safe. There are murky companies that attack trademarks, order manufacturing products elsewhere, and label them with the attacked trademarks. Some companies that left the Russian market refiled for their trademarks to refresh the three-year period. However, the best way to preserve a trademark would be to sell a consignment or several consignments of goods (thus avoiding accusations of fictitious use) through an authorised agent in order to break the three-year period, even if the company does not want to return to the market. This would not only save money for protecting trademark rights but also would bring some profit to the company.

