

# GORODISSKY & PARTNERS PATENT AND TRADEMARK ATTORNEYS

INFORMATION  
BULLETIN



## #82

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calendar:

### 8<sup>TH</sup> ANNUAL SEMINAR

## "OBTAINING AND ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS IN RUSSIA"

SEPTEMBER 5-7, 2012, MOSCOW

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# SIMPLICITY IS WORSE THAN ROBBERY



It seemed to have sunk into oblivion those times when in Russia, marks, that mimic the marks of well-known companies or even identical to them, were rampant registered. The era has passed when the Russian PTO registered the famous marks, giving them legal protection for unknown firms or businesses, placing the burden of challenging the registrations on these companies, through which the marks become known. Examples of such registrations are set.

For obvious reasons, the possibilities of the Russian PTO during the search were limited, since in those days to

access this source of information as the Internet for each examiner was impossible, and such a criterion as «the

possibility of misleading the consumer regarding the manufacturer of goods» was rarely used. Examples of registra-

tions of trademarks of the well-known companies, provided by firms and entrepreneurs who do not have anything to do with these marks – a lot. Fortunately, the approach of the Russian PTO to the emergence of those registrations has changed dra-



REGISTRATION #409061



REGISTRATION #373906

**FORTUNATELY, THE APPROACH OF THE RUSSIAN PTO TO THE EMERGENCE OF THOSE REGISTRATIONS HAS CHANGED DRAMATICALLY, AND IT IS NOW UNLIKELY THAT EXAMINATION OF AN APPLICATION FOR A TRADEMARK, IMITATING A FAMOUS MARK, OR EVEN CONTAINING A SIMILAR ELEMENT, WAS CARRIED OUT WITHOUT TAKING INTO ACCOUNT SUCH CRITERIA AS «THE POSSIBILITY OF MISLEADING THE CONSUMER»**

matically, and it is now unlikely that examination of an application for a trademark, imitating a famous mark, or even containing a similar element, was carried out without taking into account such criteria as «the possibility of misleading the consumer.» Already for a long time during the examination it has been investigated whether the designation, in respect of which the trademark registration applied, is used by any other company than the Applicant, and whether in connection with it, the consumer could be misled about the manufacturer of products or the company providing services.

Already for a long time, the opportunities for such search have existed, and there are no problems for the corresponding search via the Internet. All the more surprising is the appearance of the Russian registrations of trademarks as ##409061 and 373906. It seems obvious that these registrations contain the image of the «Star Ball,» which is known by the Russian viewers, representing the great part of the population of Russia, as a symbol of the UEFA.

Furthermore, of course, the image of the «Star Ball» is well known to football fans, which is a huge number of the male and female population of Russia. How could the examiners of the Russian PTO making decisions on registration of such trademarks, have not considered the well-known «Star Ball» of the UEFA, is not clear. Thus, the protection of the trademark was provided to the «BETCITY,» LLC, from Rostov-on-Don (Russia), in respect of services of classes 36 and 41, where a list of services of class 41 includes such services as

«the Organization of sports competitions» (Registration #373906). The trademark (Registration #409061) was registered in respect of goods included to the Class 3, in the name of the Moscow businessman Gleb Bobkov. Neither the «BETCITY,» LLC, nor

Mr. Bobkov has any relation to the UEFA, except maybe the fact that employees and managers of the «BETCITY» and Mr. Bobkov are football fans, and the «Star Ball» is dear to them as a symbol of the famous football association. It is quite obvious that UEFA could not ignore the facts of providing legal protection to

a Russian company and an individual having no relations to the Association and filed objections against legal protection of the said trade marks. Goroditsky & Partners trademark attorneys and lawyers assisted in this matter.

It is quite interesting the attitude of the right holders of these trademarks to the fact of the objection.

1. The history of the struggle with the registration of the trademark (Registration #373906) was quite lengthy. The first step was to file an objection of the UEFA with the Chamber for Patent Disputes. The grounds for filing

ing the consumer were not taken into consideration by the Chamber. However, it should pay tribute to the Russian PTO, which in this case admitted its mistake made during the examination, and the issued by the Chamber decision that does not take into account the fame of the trademark of the UEFA, and the possibility of misleading the consumer, has not been approved and the objection was adjudged again.

Throughout the reoccurring hearing a representative of the right holder presented arguments that, according to him, representative, argued that «the five-pointed stars» that make up the «Star Ball» of the UEFA are weak

elements, since the use of «five-pointed stars» in the trademarks and other symbols is quite often. As an illustration, the trademarks were exemplified that include 1, 2 or 3 five-pointed stars, the symbol of the

European Union, and the halos of the saints. Let's leave without comment the lawfulness and expediency of bringing some of these references, and note that in the second hearing, the Chamber of Patent Disputes took into account not only the similarity of the marks, but also the reputation of the UEFA, in this connection - the possibility of misleading the consumer regarding the company, which provides services and does not have any manufacturing links or other association with the UEFA, and the Chamber has made a decision on the recogni-

**HOWEVER, IT SHOULD PAY TRIBUTE TO THE RUSSIAN PTO, WHICH IN THIS CASE ADMITTED ITS MISTAKE MADE DURING THE EXAMINATION, AND THE ISSUED BY THE CHAMBER DECISION THAT DOES NOT TAKE INTO ACCOUNT THE FAME OF THE TRADEMARK OF THE UEFA, AND THE POSSIBILITY OF MISLEADING THE CONSUMER, HAS NOT BEEN APPROVED AND THE OBJECTION WAS ADJUDGED AGAIN**

objections were a confusing similarity of the registered trademark with the registrations of the UEFA trademarks, having an earlier priority, and a possibility of misleading the consumer regarding a company providing services under classes 36 and 41.

At the first hearing, the Chamber of Patent Disputes recognized the similarity of marks, but rendered a decision on the recognition of granting legal protection to a trademark null and void in respect of a part of services, which are identical and kindred ones with respect to the earlier registrations of the UEFA. The facts of the reputation of a trademark and the grounds of the possibility of mislead-

tion of granting legal protection to the trademark completely invalid.

It would seem that all is clear. However, notwithstanding the decision and the documents presented on the use of the UEFA trademark in Russia, «BETCITY,» LLC, continued the fight and have applied for early termination of the legal protection of the UEFA registrations referred to in the decision of the Chamber of Patent Disputes by virtue of which, in addition to the misleading the consumer, the decision was made by the Chamber. The Applications were reviewed, and the UEFA has proven the use of its trademark in respect of virtually all services. It seems strange the persistence of the

«BETCITY,» LLC, and there may be some misunderstanding of the situation, as the «BETCITY,» LLC, could not but understand that the figurative element of its trademark, no doubt, is

of its mark is contesting a trademark registration in the name of Mr. Bobkov in respect of Class 3. The desire of the businessman to make his trademark recognizable

**FURTHERMORE, OF COURSE, THE IMAGE OF THE «STAR BALL» IS WELL KNOWN TO FOOTBALL FANS, WHICH IS A HUGE NUMBER OF THE MALE AND FEMALE POPULATION OF RUSSIA**

associated with the UEFA «Star Ball,» to which the «BETCITY,» LLC, has not any relationship, and its desire to use the intellectual property of others is, at least, strange, even under a naive perception of the relationship to other company's intellectual property. It should be noted that after the completion of the deliberation of all the Applications at the Chamber for Patent Disputes, the «BETCITY,» LLC, no longer uses in its trademark the image of the ball and the star, and currently it uses the designation that is quite sufficient for individualization of the company.

2. The second example of the UEFA successful struggle for the purity

and successfully sell his products, is quite understandable. However, it is impossible to understand in this case, why the entrepreneur deems it conceivable to exploit the intellectual property of others and the absence of any of its merits or any participation in the creation of the UEFA symbol. As well, it is difficult to imagine that the examiners who took the decision on registration of the trademark, did not know that the «Star Ball» is the official symbol of the UEFA. It is also difficult to understand by what the expertise is guided in making the decision to register this trademark, practically, identical to the symbol of UEFA,

which can be seen in television broadcasts.

One can only assume that this decision was based on the belief that the goods of Class 3 in no way associated with football. However, this belief cannot be considered legitimate, since no doubt, that the football fans use products of Class 3, and the labeling of these products with the trademark when the symbol of the UEFA is well-known, with very high probability will be considered as the non-existent relationship with of the Moscow businessman with the UEFA.

In considering this objection filed by the UEFA concerning the possibility of the misleading the consumer, the Chamber for Patent Disputes ruled on the recognition of granting legal protection to the registration #409061 to be void completely.

It should be noted that the right holder has not contested the decision.

**MARK YOUR CALENDAR**

# GORODISSKY & PARTNERS IP ANNUAL SEMINAR – 2012

**GORODISSKY & PARTNERS WILL HOST 8TH ANNUAL SEMINAR «OBTAINING AND ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS IN RUSSIA» IN MOSCOW, ON SEPTEMBER 5-7, 2012**

The seminar has General Sessions – “Patents”, “Trademarks” and “IP Enforcement”, which are focused on the latest trends in the Russian IP system with such main topics as:

- Strategies of obtaining patents by the Russian and Eurasian routes
- Filing stage know-how by using PPH with the Russian PTO
- Patent examination procedures and appealing in the Russian PTO
- Peculiarities of trademark proceedings
- Non-traditional trademarks
- Well-known trademarks in Russia and Ukraine
- Protection of trade dress
- Parallel import
- Notable IP battles in the Russian courts
- IP transactions and security interests, etc.

and also includes Special Workshops:

- Workshop “Patents in Pharma area” covering biotech inventions, pharma patents under Eurasian and National systems, invalidation and appeal procedures for pharma patents, pharma and agrochemical patent extensions
- Workshop “IP in Eurasian Economy Community” covering Agreement on common governing principles in the sphere of IP rights protection and Customs Union (Russia, Belorussia and Kazakhstan). Among the seminar speakers – patent/trademark attorneys and IP lawyers of Gorodissky & Partners and invited IP experts from Belorussia and Kazakhstan.

The official language of the seminar is English.

The seminar attendees and accompanying persons will also enjoy a social program with a rich choice from sightseeing tours to social events during one of the most attractive seasons in Russia – “Indian Summer”.

**We look forward to seeing you in Moscow in September 2012!**

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# NEWS

## DECEMBER 6-9, 2011, BRUSSELS

Valery Medvedev, Managing Partner, Gorodissky & Partners (Moscow), was invited to deliver a lecture and to chair one of the Workshops of IP Week 2011 in Brussels - "Litigation in BRICS Countries: Where Do WE Stand Now?". About 400 professionals from European Commission, industrial companies, universities and law firms attended the IP Week this year.



PHOTO: SPEAKERS OF THE SESSION

## DECEMBER 06, 2011, MOSCOW

Sergey Medvedev, LL.M., Gorodissky & Partners (Moscow), delivered a lecture "Security transactions in IP" for students of the Russian State Academy of Intellectual Property. The major legal and practical aspects of security transactions in regard of different IP subject matters were enlightened.

## NOVEMBER 29, 2011, MOSCOW REGION

Vladimir Mescheriakov and Dr. Natalia Radchenko (both Counsels of Gorodissky & Partners, Moscow), attended the Annual IP Conference of the Chamber of Russian Patent Attorneys held at "Zarya Hotel" (Moscow region). Vladimir Mescheriakov gave presentations - "Pluses and minuses of proposed amendments to Chapter IV of the Russian Civil Code" and "On Rules of the Chamber of Patent Disputes of the Russian PTO". Dr. Radchenko spoke on "Co-relation of rights to means of individualization and collision of these rights". About 70 Russian and foreign patent attorneys attended the Conference.



PHOTO: AT THE CONFERENCE

## NOVEMBER 23, 2011, EKATERINBURG

Gorodissky & Partners in association with Administration of the Sverdlovsk Region held the 9th Annual Conference "Intellectual Property: from reliable protection to efficient management". Gorodissky & Partners leading IP lawyers, Patent and Trademark Attorneys of Moscow, St. Petersburg and Ekaterinburg offices were the prime speakers on the actual issues of the Russian IP legislation, including particulars of the prosecution, enforcement, evaluation and licensing of IP rights. The Conference was attended by CEO's, companies' managers, IP lawyers and patent/trademark attorneys of Ekaterinburg and the Sverdlovsk region.

## NOVEMBER 12-16, 2011, MANILA

Vladimir Biriulin, Partner, Patent Attorney, Gorodissky & Partners (Moscow), attended the APAA Conference where topic issues of the regional IP landscape and its perspectives were considered by about 1100 attendees from 51 countries, both delegates and observers.

## OCTOBER 19-23, 2011, WASHINGTON

Dr. Evgeny Aleksandrov, Chief Lawyer, Gorodissky & Partners (Moscow), attended AIPLA Annual Conference. Latest amendments in the USA patent legislation, issues of licensing, etc. were considered. Much attention was paid to registration and depositing copyrighted works in the US Congress Library. Over 1 600 delegates of state and international bodies, major industrial companies and law firms attended the conference.

## OCTOBER 16-19, 2011, SAN DIEGO

Sergey Dorofeev, Partner, Patent Attorney, and Sergey Medvedev, LL.M., Lawyer (both of Gorodissky & Partners, Moscow), attended the LES 2011 Annual Meeting held by LES USA and Canada. The Meeting gathered over 1000 delegates representing state institutions, universities, financial structures as well as law firms and business companies, major international corporations among them, from all over the world.

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