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# Protection of well-known trademarks in Russia

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Russia, as a member of the Paris Convention for the Protection of Industrial Property, affords protection of well-known trademarks from reproduction or imitation by third parties. Russian legislation, otherwise than most other European jurisdictions, though, provides for a special registration of well-known trademarks where the Chamber for Patent Disputes within the Russian PTO (Rospatent) is endowed with broad powers of granting (or withholding) well-known trademark protection. Registered well-known trademarks, as compared to those notorious trademarks that are not registered as well-known, enjoy substantial advantages in disputes bearing on their unlawful use. The holder of the registered well-known trademark does not need to prove the notoriety of its trademark in Court, and its chances of success become much higher in consequence. Below, we provide an overview of the advantages afforded to well-known registration, as well as of the conditions and procedure for such registration, and some examples of recent case law.

#### Advantages of well-known registration

As earlier mentioned, the official registration of a well-known trademark releases its holder from the need to prove its notoriety in disputes. There are other significant advantages afforded by well-known registration over ordinary trademark registration, which are chiefly as follows:

- (i) well-known registration has no time limit;
- (ii) well-known protection extends to non-homogeneous goods and services if the consumer would associate the use by another person/entity of the trademark with such non-homogeneous goods and services with the holder of the well-known trademark, and if such use may interfere with legal interests of the trademark holder; and
- (iii) well-known protection covers, as well, period of time prior to the filing date, if the applicant for well-known registration presents evidence of notoriety prevailing in such time period.

#### Conditions for recognizing a trademark as well-known

Trademarks registered in Russia through a national procedure or under the Madrid Agreement/Protocol, and unregistered designations used as trademarks in Russia (hereinafter, jointly “trademarks”) can be recognized as well-known subject to demonstrating the following conditions:

- (i) the intensive use of the trademark on the claimed date;

- (ii) the wide renown attaching to the trademark in Russia among certain (categories of) consumers;
- (iii) the wide renown attaching to the trademark in Russia with respect to the applicant's goods; and
- (iv) provided that there is no earlier identical or confusingly similar trademark of another person registered with respect to homogeneous goods.

#### Procedure for well-known registration

The procedure for recognizing a trademark as well-known is initiated by filing an application with the Chamber for Patent Disputes within Rospatent. The Chamber, within a month, issues an acceptance notice confirming admissibility and indicating a hearing date, which should be scheduled within 21 days from the date of the acceptance notice.

The application should specify the reasons for granting well-known status and be accompanied by documents and materials evidencing its well-known character (see in detail below), trademark images in shape and color and evidence of payment of the applicable State fee. The application must furthermore specify the date as from which recognition of the well-known status is applied for, with reasons.

The Expert Commission of the Chamber consisting of three members considers the case in a closed hearing without the presence of the applicant. The applicant can be invited to attend an additional hearing if such hearing is needed.

The Expert Commission issues its decision within 2 weeks after the last hearing (if there are more than one). The entire proceedings usually take 3 to 4 months upon filing the application.

If the application is rejected, the Chamber's decision can be appealed to the specialized IP Court.

#### Evidence of notoriety

According to the Rospatent administrative practice, the applicant should produce the following information to support the notoriety of a trademark and prove it by documents and materials attached to the application:

- a) on the intensive use of the trademark and the initial date of its use, by evidence and information on, to exemplify: locations where the goods were distributed, volumes of sales, methods of trademark use, annual

- average numbers of consumers concerned with the products, position of the manufacturer on the relevant market, etc.;
- b) on other countries where the trademark enjoys well-known status;
  - c) on advertising costs dedicated to the trademark (for instance, by means of annual financial reports);
  - d) on the trademark value and the investments dedicated to it (according to annual financial reports);
  - e) on consumers' awareness of the connection between the goods affixed with the trademark and the applicant; and
  - f) on the results of consumer surveys (see below).

### Consumer survey

A consumer survey is commonly seen as the main and necessary evidence of a trademarks' well-known character. A survey should meet certain requirements according to the Recommendations for Consumer Surveys issued by Rospatent ("Recommendations"):

- (i) the survey should be carried out by an independent organization who takes the Recommendations in due account;
- (ii) the survey should cover at least six locations in Russia that should necessarily include Moscow and St. Petersburg;
- (iii) the survey should comprise at least 500 respondents in any two locations and at least 125 respondents in each location; and
- (iv) the survey should refer to opinions expressed by average consumers when conducted with respect to consumer goods.

According to the Recommendations, a survey should in particular answer the following questions:

- a) Is the respondent familiar with the trademark?
- b) Who is the trademark holder or manufacturer of the goods affixed with the trademark?
- c) When did the trademark become widely known?
- d) Where does the respondent know of the trademark from?

### Cancellation of a well-known registration

A well-known registration can be challenged and found invalid during the entire term of its protection if it was registered in contravention of conditions for recognizing a trademark as well-known, namely, if, on the claimed date, it lacked wide renown among consumers for the claimed goods/services as a result of its intensive use in

Russia, or in case of existence of earlier conflicting trademark rights of another person.

Russian law does not provide for the cancellation of well-known registration because the registered well-known trademark allegedly lost its notoriety.

### Case law

#### *On granting well-known registration:*

The Russian standard of notoriety is rather high. There are approximately 700,000 ordinary registered trademarks in Russia, of which just 199 were recognized as well-known. Therefore, collecting and presenting evidence of notoriety, even with respect to extraordinarily famous trademarks, should be considered a demanding exercise, always bearing in mind that the demonstration of the trademark's renown should be strongly focused on the Russian market and consumers.

- To exemplify, we list below the documents and materials presented in support of the notoriety of trademark "NISSAN", which was granted well-known registration in the name of Nissan Jidosha Kabushiki Kaisha with respect to automobiles by the Chamber in 2016. As one sees, Nissan had demonstrated a strong Russian presence, as well as provided results of a consumer survey. Despite of this, the trademark was recognized well-known only from January 2015, which was, probably, the application submission date.
  - information and print-outs from the Internet on Nissan, its worldwide organization and trademarks, including print-outs from its Russian website [www.nissan.ru](http://www.nissan.ru);
  - affidavits from the applicant certified by a notary public;
  - Russian Wikipedia articles about Nissan;
  - brand rankings by Forbes, Interbrand, Fortune, Brand Finance, and ZBrand;
  - copies of publication of well-known registrations in Japan and China;
  - a catalogue of Nissan cars offered for sale in Russia;
  - an extract from the Russian company Register with respect to the Russian Nissan companies, OOO "Nissan Motor Rus" and OOO "Nissan Manufacturing Rus";
  - Russian publications on the starting and thereafter continuation of manufacture of Nissan cars in Russia;
  - a list of Russian official distributors;

- advertisement samples from Russian automobiles specialized magazines and media;
  - commercial videos;
  - Russian press publications on trademark “NISSAN”;
  - examples of the trademark use by Nissan dealer centers and on exhibitions in Russia;
  - results of the Russian consumer survey.
- The IP Court (2017) reversed the Chamber’s decision which had denied well-known registration for trademark “OKEY” – a famous Russian supermarket network – with respect to retailing services. The Chamber had found that the evidence submitted did not demonstrate the trademark’s notoriety, as the geography of the consumer survey did not cover the entire territory of Russia and, therefore, was not sufficiently representative. The Court did not agree with the Chamber’s findings and ruled that other materials and evidence submitted, apart from the survey, proved instead the renown of the trademark in Russia. This case demonstrates the significance of consumer survey results over other evidence, as well as the effectiveness of the judicial remedy (IP Court) over the administrative phase (Rospatent).

On denying well-known registration:

- The IP Court (2013) upheld the decision of the Chamber for Patent Disputes denying well-known protection to designation “KINDER” for confectionary (Class 30) in the name of Ferrero S.p.A. based on the earlier Russian trademarks “KINDER” in the name of Soremartec S.A. and Ferrero Ardennes S.A. despite of the fact that all companies belonged to the same company group.
- The Chamber (2016) denied a well-known registration for the designation



(Alyonka), a famous Russian chocolate brand, in the name of Moscow confectionary factory “Krasnyi Oktyabr” (in English: Red October) on the grounds that that word designation was only a “fragment” of the famous



chocolate label with the dominating image of a little girl . Moreover, the applicant had been already granted well-known protection for the entire label, which comprised its parts and “fragments”.

*On enforcing well-known protecting against infringement of trademark rights:*

- The Russian Supreme Court (2011) upheld the appeal and cassation judgements in the case *OOO “Kamaz” v. OOO “Bauer”* which found the wholesale supply by OOO “Bauer” of toy vehicles affixed with trademark “KAMAZ” infringing the plaintiff’s rights in its well-known trademark “KAMAZ” registered for overweight vehicles (Class 12) and awarded a compensation to the plaintiff. Thus, the Courts extended protection of well-known registration “KAMAZ” to non-homogenous goods supplied by the defendant.
- The Commercial Court of the Khabarovsk Region (2016), as court of the first instance, found unlawful the use of well-known trademark “BOLSHOI” – registered in the name of the plaintiff, the world-famous Russian Bolshoi Theater – in an advertising campaign for concerts of opera and ballet soloists carried out by defendant, OOO “Svobodnyi Teatr” (in English: Free Theater), with no license from the Russian Bolshoi Theater, and awarded a substantial compensation to the plaintiff.