



Battle for BBC Top Gear trademark in Russia



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INTELLECTUAL PROPERTY, RUSSIA

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The name of the world popular BBC program “Top Gear” was registered as a trademark in Russia in 2015 in the name of The British Broadcasting Corporation (The BBC) with regard to telecommunication services. On 30 of March 2018 the Chamber for patent disputes of the Russian PTO (Rospatent) decided to cancel the registration as a result of an action by an individual entrepreneur, who claimed to own a registration for the same trademark with earlier priority.

In 2016 the individual entrepreneur had filed an application for registration of the mark “TopGear” and also purchased the right for that with priority date of 25 October 2005 (“the senior mark”) from a company under liquidation. On the basis of this prior right for “the senior mark” the registration of the BBC trademark “TOP GEAR” was held void, which means the

trademark is cancelled from the date of registration as if it was never registered.

A trademark in Russia can be cancelled in case the relevant registration decision was taken in breach of Article 1483 of Civil Code, prohibiting the registration of trademarks that are identical or similar to existing trademarks with earlier priority for similar goods, in order to avoid confusion among customers. A cancellation request can be filed only by the interested party within a period of first 5 years of protection of the mark under question.

The Chamber for patent disputes of the Russian PTO (the Chamber) had found that the individual entrepreneur was an interested party and had duly filed the cancellation request, since he was a proprietor of an earlier similar mark registered for the same services. In the course of the review of the case the BBC had argued that the individual entrepreneur was not using its mark and



his actions amounted to unfair competition. This argument was dismissed by the Chamber holding that the use of “the senior mark” by the owner was irrelevant as well as indicating that an assessment of wherein the actions of the other party constituted an unfair competition fell besides its competence. As a result the Chamber cancelled the trademark “TOP GEAR” of the BBC. The BBC had in its turn filed a cancellation request against “the senior mark” on grounds of non-use.

The BBC filed an appeal to the Russian Court for Intellectual Property arguing that the cancellation of its trademark resulted in an abuse of right by the entrepreneur and that the Chamber should have considered the aim and intention of the latter in adjudging the case. The Court reviewed the decision of the Russian PTO but rejected the appeal of the BBC.

The cassation instance reviewed the case and concluded that the decision of the Chamber to cancel the trademark registration was correct. It confirmed that the Chamber cannot make an assessment of intention and abuse of right, since this falls out of its competence. The Court also noted that the cancellation of “the senior mark”, that took place effective on the date of the hearing case in cassation instance, did not change the circumstances, as “the senior mark” was cancelled for the future, while existence of “the senior mark” on

the date of filing of trademark application “TOP GEAR” by the BBC was a fact that remained unaffected.

However, the cassation instance also cancelled the decision of the appellate court holding that not all circumstances and arguments in the case had been considered. The decision emphasized that the Court for Intellectual Property should have paid due attention to the fact that “the senior mark” was not used for homogeneous services and this could influence the likelihood of confusion of similar marks and, accordingly, the cancellation decision of the “TOP GEAR” mark registered by the BBC. As a result, the cassation instance cancelled the appellate decision and sent the case back for the re-adjudging by the Court for Intellectual Property, holding that the non-use of “the senior mark” must be taken into account by the court in its new re-consideration of the case.

The new hearing at the Court for Intellectual Property is scheduled for 07 August 2019, when the Court will review the case again taking into account the cassation decision and possibly allow the “TOP GEAR” trademark of the BBC to survive the battle.





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