



# Russian court rules that production of sweet wrappings infringes rights for the Russian trademark notwithstanding export without intention to sell in Russia



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In 2018 the Russian customs authority filed an administrative action on the infringement of trademark right against a Russian company.

The Company processed for export to Uzbekistan sweet wrappings produced in Russia featuring the famous trademark KARA-KUM.

The first instance commercial court held that the mark on the wrapping was similar to the Russian trademark registered for sweets, and ruled that the Russian exporter had infringed the trademark. The court of appeal, in its turn, adjudged that Russian law protects the trademark right against undue use only in the territory of the Russian Federation, while the wrappings were

cleared for export. The court of appeal found that the exporter had no intent to use the wrappings or to market goods with such wrappings in Russia.

It also noted that the trademark was registered for confectionery, while the Russian company produced and processed for export only wrappings, which fall within another class of the Nice classification, which is not covered by the trademark registration. As a result, the Court reversed the first instance decision and ordered the return of the seized wrappings for customs.

The Russian Court for Intellectual Property further reviewed the case as cassation instance in August 2019 (case A56-98284/2018), and ruled that the unauthorized use of a mark similar to the



registered trademark, on the goods or their packaging and wrapping, is an infringement of the trademark right and falls under the administrative action. The absence of intent to market goods in Russia, and the export clearance of the wrappings were considered by the Court irrelevant to the case. The Court also upheld the findings of first instance on the similarity of sweets and wrappings for the purpose of trademark infringement

assessment. It explained that wrappings of sweets are made to identify the goods (sweets)002C and both sweets and wrappings are sold as one product and complement each other, informing consumers of the origin of the goods.



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