



The Russian Court for Intellectual Property challenges the provisions of the Civil Code on well-known trademarks before the Constitutional Court



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The Russian Court for Intellectual Property (IP court) referred to the Constitutional Court the conformity of Article 1483 clause 6 part 3 and Article 1508 of the Civil Code of the Russian Federation (the Civil Code) in conjunction with each other, to the extent that they allow to prevent the registration of a trademark on the ground of an existing well-known mark, which on the priority date of the challenged mark had neither well-known mark status nor an application filed for registration as such.

Russian law considers a well-known mark a particular type of trademark and foresees special provisions defining the conditions for registration. Article 1508 of

the Civil Code provides that at the request of the owner a trademark or a non-registered mark may be recognized by the Russian Patent and Trademark Office (Rospatent) as a well-known mark, if due to intensive use by the date indicated in the application, the mark became notorious among the relevant consumers with regard to goods of the applicant. It further states that a notorious mark is protected without time limit, also against non-similar goods if the use of the mark by another entity can create an association with and prejudice to the owner of the notorious mark. Article 1509 provides the procedure of registration of the well-known mark and issuance of a registration certificate. It also regulates the recording of notorious marks registered in Russia in a special



register, which currently contains 209 trademarks.

The case behind the reference to the Constitutional Court commenced in 2015, when Russian company ForaFarm registered trademark “Loshadinaya doza” (Horse dose) for goods in Class 03 of the Nice classification. Another Russian company Zeldis, as owner of three trademarks “Loshadinaya sila” (Horse power) registered during 2011-2014 for goods in Classes 03 and 05 of the Nice classification, filed with the Rospatent a cancellation application against Horse dose arguing that it was registered in breach of the law prohibiting registration of marks similar to existing trademarks. The Rospatent rejected the objection and kept in force the registration of the conflicting mark. Zeldis appealed the decision in the IP Court, but failed to persuade the Court of the similarity of the marks. Both the appeal and the cassation instances held in 2017 that there was no likelihood of confusion of the marks.

Still in 2017, Zeldis filed an application with the Rospatent for recognizing its trademark as a well-known mark. Russian law allows the applicant to claim the date of gaining notoriousness retrospectively, and trademark Loshadinaya sila was acknowledged as well-known, effective from 01 March 2017, which was earlier than the priority date of the conflicting mark.

The Civil Code extends the protection of notorious trademarks to non-similar goods, if the use of the mark can create an association with the owner of the well-known mark and prejudice the interests of the owner. Zeldis counted on the provision providing stronger protection to the registered well-known mark, and made a new attempt to cancel trademark Loshadinaya doza, which was a success, and the conflicting mark was cancelled. The defendant then appealed the decision of the Rospatent both in the appeal and cassation instances in the IP Court. The latter put the proceeding on hold and turned to the Constitutional Court with its reference. The concern raised by the IP Court in front of the Constitutional Court was that the

trademark could be cancelled on the ground of potential confusion with the notorious mark, even when there was no registered conflicting well-known mark on the priority date of the cancelled trademark and the application for registration of such mark was not filed yet. Besides, the IP Court considered that the freedom of the applicant to choose the date of recognition of the mark as well-known may not comply with the Russian Constitution and fail to guarantee the right to use and protect a trademark.

The Constitutional Court did not find any ambiguity of the provisions claimed to be inconsistent with other provisions of Russian law and rejected the reference. However, the Constitutional Court took a chance to clarify the existing balance of the interests of trademark holders, and issued a finding explaining its position on the matter. The Court clarified that Russian law does not connect the recognition of the trademark (or a mark) as well-known with a preceding trademark registration. In accordance with Article 1508 of the Civil Code and in line with Article 6*bis* of the Paris Convention, at the request of the applicant the Rospatent may recognize and register as well-known either a registered trademark or a mark not registered and protected in Russia.

Further, the Court held that the applicant may choose the date from which a mark should be considered well-known, but the mark is registered as well-known only if it meets the features of notoriety. The law does not foresee any other requirement in connection with that date, and so, the date of recognition of the mark as well-known can be earlier than the date of a relevant decision and even earlier than the date of the application. The Constitutional Court held that the notoriety of the mark is factual and the procedure of the Rospatent for acknowledging the mark as well-known aims at confirming or denying a fact. If the materials provided with the application do not prove the notoriety of the mark or the mark became well-known after the priority date of another identical or similar trademark registered for similar goods, the Rospatent rejects the

application. The Court concluded that this eliminates the possibility of arbitrary and unreasonable choices of the date from which a mark should be considered well-known.

In addition, the Court emphasized that the protection of the well-known mark may be cancelled during the whole period of its validity if the mark loses notoriety. Consequently, the mark must conform to the characteristics of well-known marks envisaged by Russian law

on the date of filing an application. The applicant must provide evidence of notoriety of the mark both for the claimed date and the application date. The Constitutional Court reminded that the owner of a trademark conflicting with a well-known mark may also claim and prove the absence of notoriety on the priority date of its mark.



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