



# Rejected well-known mark “Raffaello”, remand by Court for Intellectual Property to the Russian PTO for reconsideration

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In 2018 SOREMARTEC S.A. filed an application for recognition and registration of its trademark “Raffaello” as well-known in Russia. Raffaello is the name of popular coconut ball sweets with an almond inside. The company claimed that the mark had become notorious for confectionery goods, namely sweets, in Russia by 22 August 2017. In December 2018 the Russian PTO rejected the application. The Company filed an appeal with the Court for Intellectual Property.

The trademark was used in Russia by a Russian entity under a license agreement with the trademark holder. The applicant for registration as well-known mark was the trademark holder,

while all documents connected with the production, marketing and sale of the goods in Russia referred to the Russian licensee.

The Russian PTO provided both technical and substantive reasoning for the refusal, including:

- absence of connection between the goods produced under license and the trademark holder and absence of proof that consumers associate the trademark with the trademark holder;
- results of the sociological survey that was provided considered by the PTO unreliable, as they did not include competitors and subsidiaries among those surveyed;
- consumers do not identify straightforwardly the trademark owner as the producer of goods.



Subsequent to the appeal filed by SOREMARTEC S.A. (case SIP-196/2019), the Court held that the PTO had not duly reviewed and assessed all evidence provided and found that the reasoning for refusal was ill-grounded.

The Court explained that the review of an application for notorious mark implies that the authority shall assess the use of the mark as a sign of origin of the goods of an entity known to consumers. The application could be rejected in case the mark was not used at all, was not used for the purpose of identifying the goods or had not gained a reputation among consumers.

The Court adjudged that whereas the PTO had referred to the different versions of the mark used in connection with the goods, yet it failed to investigate if the mark was perceived by consumers as a new mark identifying a different

origin or as a variation of the same trademark.

The Court also held that the notoriety of the mark does not require one to build a connection between a specific producer, seller of the goods or trademark owner and the mark, and that consumers do not need to know the exact company names of trademark owner and producer, they just need to understand the origin of goods.

Consequently, the Court adjudged null and void the refusal of the “Raffaello” application for registration as a well-known mark and ordered the Russian PTO to review the case taking into consideration the holdings contained in the Court’s judgement. The PTO shall schedule a new hearing, when a new panel reconsiders the application.



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