



Protecting company or trade names in Russia against registration as a trademark by a third party

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📖 INTELLECTUAL PROPERTY, RUSSIA

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1. When a foreign company enters the Russian market and has not yet registered a trademark, attention should be paid to prevent the registration by a third party of a trademark similar to the foreign company's name or trade name.

Article 8 of the Paris Convention (Paris Convention for the Protection of Industrial Property as amended on September 28, 1979) provides that *"... a trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark ..."*.

As a party to the Paris Convention, the Russian Federation adopted the corresponding domestic legislation in paragraph 8 of article 1483 of the Civil Code, which prohibits the registration of trademarks similar to the company name or trade name used in Russia by another

in connection with similar goods or services.

2. The Russian Civil Code contains specific provisions governing the use and protection of a company name and trade name as specific rights, which exist irrespective of the existence of a trademark (sections 1 and 4 in Chapter 76 of the Civil Code). Articles 1476 and 1541 explicitly provide for the existence of the right to the company name and the trade name and that they may be used on an independent basis.

3. The Russian Civil Code defines the company name as the name stated in the official register of legal entities. Conversely, a trade name, which is not recorded anywhere, is defined as the name used by the company to identify its enterprise that became well-known in the region where its commercial activity is deployed in Russia.



4. The protection of a company/trade name against the registration of a similar trademark is subject to the following requirements:

- A) The date of first use of the company/trade name (in Russia) was earlier than the priority date of the trademark application of the third party;
- B) The company/trade name is in existence at the time of examination of the trademark application;
- C) The trademark applied for is similar to the company/trade name;
- D) The goods/services claimed by the trademark application are similar to the kind of activity carried out by the company/trade name owner.

5. The above will be verified by the examiner in order to assess the compliance of the trademark application with the special requirements related to the company/trade name rights. If the trademark registration could infringe third parties' rights to a company/trade name, the application will be denied based on paragraph 8 of article 1483 of the Civil Code. However, the examiner is neither obliged, nor has the means to positively verify all existing company and trade names, and will as a rule look at open source information provided by search engines in the Internet. He may discover a conflicting right, but obviously not all existing company/trade names that are similar to the trademark applied for will appear out the search.

6. While Russian law does not at present foresee an opposition procedure, as is usual in the intellectual property systems of EU countries, the rightholder may resort to a different option. Article 1493 of the Russian Civil Code allows any third party to file its observations with the Russian Patent Office (Rospatent) in connection with any trademark application.

The observations should be filed after the date of publication of the application and before the grant or denial decision is taken by the Rospatent. The official term in accordance with the Administrative Regulation to accomplish trademark registration is 18 months and 2 weeks; however, according to statistics, the

average term of a trademark application examination in 2019 was only 6 months.

7. The observations should be filed with regard to a specific trademark application and with the reference to the application number. All observations of third parties received by the Rospatent within the prescribed period shall be reviewed and taken into account by the examiner.

8. Information about Russian entities, including registered company name and kind of business activity is recorded in the Russian Unified State Register of Legal Entities, and the examiner has access to this information on the basis of company registration numbers. However, if a foreign company has not yet registered a branch/entity in Russia, the examiner will not be able to obtain information about company names registered outside of Russia, and all relevant evidence will need to be provided along with the observations.

9. The protection of the trade name similarly entails the need to provide proof of existence and ownership. Moreover, as the trade name is not registered anywhere, the examiner cannot rely on any official records, and the materials provided by the party filing the observations will be critical for the examiner's assessment.

10. The trade name is protected only if it is distinctive, as it cannot otherwise identify the entity on the market. If the examiner considers that the trade name referred in the observation letter lacks distinctiveness, all other facts and documents become irrelevant.

11. As a next step, the examiner will verify if the legal entity has provided evidence of having an operating enterprise in Russia with an existing location. Only after this, will be proceed to reviewing the evidence of local the renown of the trade name in connection with a specified business in a specified territory of Russia. The renown of the trade name may be proved by evidence of long and/or intense use, consumer sociological surveys or advertising investments.

12. In accordance with Russian law, the trade name right is extinguished if it is not used during a one year period; as a result, the holder should provide evidence of existence of the trade name at the time of filing of the observations and during the preceding year.

13. The examiner reviews the information and documents provided with the observations and may reject the application, if the materials are sufficient and well grounded. Otherwise, the examiner will disregard the observations and decide the application. The examiner does not correspond with the opposing party or request from it missing information or further explanations.

14. Similarly, as a result of his review of the evidence provided, the examiner may register the trademark without providing explanations or information to the company/trade name rightholder. If the latter considers that the trademark registration infringes its right, it may challenge the Rospatent grant decision before the Chamber for Patent and

Trademark Disputes, and thereafter before the Intellectual Property Court.

15. To sum up, in order to protect its company name or trade name a foreign entity should

-monitor potentially infringing trademark applications;

-file a letter of observations before the decision of the Rospatent on the application;

-file together with the observations: documents confirming the registered name of the company with a priority earlier than the trademark application date, evidence of use of the company name in Russia in connection with similar goods and/or services (e.g. in the Internet, on goods, on street signs, in advertising) or;

documents confirming having an operating enterprise in Russia at an existing location, proving the renown of the trade name for the corresponding operations, and evidencing its existence at the time of filing the observations letter and during the preceding year.



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