

GETTING THE DEAL THROUGH

# Trademarks

in 51 jurisdictions worldwide

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# Russia

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ARS Patent

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## 1 Ownership of marks

Who may apply?

Any legal entity or an individual entrepreneur may apply to register a trademark.

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## 2 Scope of trademark

What may and may not be protected and registered as a trademark?

Any words, designs, three-dimensional designs or combinations of words and such designs may be registered and protected as trademarks. A trademark may be registered in any colour or combination of colours. Designations may not be registered as trademarks if they do not have a distinguishing capacity or consist only of elements:

- that have gone into general use as the common name of goods of the specific type;
- that are generally accepted symbols and terms for the goods or services;
- that are descriptive of the goods or services, including indicating their type, quality, quantity, nature, purpose, or value, and also the time, place, or means of their manufacture or sale; or
- that represent a configuration of goods that is determined exclusively or mainly by the function of the goods.

These unregistrable elements may be incorporated as non-protected components of a trademark if they do not occupy a dominant position in it.

If the designation or symbol has obtained a distinguishing capacity as the result of their use, the designation or symbol may be registered and protected. However, the designation or symbol may not be registered if it consists only of elements that are:

- state or national coats of arms, flags, or other state symbols and marks or confusingly similar indications;
- abbreviated or full names or titles of international and inter-governmental organisations, their coats of arms, flags, or other symbols and marks or confusingly similar indications; or
- official verification, guarantee or sample seals, stamps, awards, and other marks of distinction or confusingly similar designations.

Such elements may be included in trademarks as non-protected elements if there is consent from an appropriate authority.

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## 3 Common law trademarks

Can trademark rights be established without registration?

Yes, trademark rights can be established without registration if a trademark has been recognised to be a well-known trademark in the Russian Federation with respect to goods of the same type. Registration also extends to goods not of the same kind as those with respect to which it was recognised as well-known if the use by another person if this trademark with respect to the aforesaid goods

will be associated by consumers with the holder of the exclusive right to the well-known trademark and may impair the legitimate interests of such holder.

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## 4 Registration time frame and cost

How long does it typically take, and how much does it typically cost, to obtain a trademark registration?

It typically takes between 12 and 14 months from the filing date to the date of issuing a trademark registration certificate, if no official action is needed.

The typical cost is about €1,900 for the first class plus €100 for each additional class, inclusive of both attorneys' and official fees.

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## 5 Classification system

What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed?

The Russian Federation follows the current edition of the Nice International Classification of Goods and Service. Since 2007, the Russian Federation has used the ninth edition of the International Classification System. It does not differ from it.

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## 6 Examination procedure

What procedure does the trademark office follow when determining whether to grant a registration? Are applications examined for potential conflicts with other trademarks? May applicants respond to rejections by the trademark office?

Examination of a trademark application shall be conducted by the federal agency of executive authority for intellectual property. Examination of an application shall include formal examination of the indication applied for as a trademark.

During the period of examination (which takes about 13 months from the filing date) the applicant shall have the right, until the adoption of a decision, to supplement, clarify or correct the material of the application, including by the submission of supplementary materials.

The applications are examined for conflicts with trademark applications that have already been filed. The Russian Patent and Trademark Office (Rospatent) conducts a trademark search in relation to the mark and the goods and services for which it has applied to be registered. If the search reveals a conflict, Rospatent issues an action addressed to the applicant citing the relevant mark or marks. If the action contains a preliminary rejection, the applicant has six months from the date that the action was issued to respond to the action by providing its own opinion on the citation or a letter of consent from the owner of the cited trademark.

**7 Use of a trademark and registration**

Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? Are foreign registrations granted any rights of priority? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a third-party challenge on grounds of non-use?

No, use of a trademark or service mark need not be claimed before registration is granted; nor does proof of use need to be filed with Rospatent. The trademark owner has three years from the date of registration to start to use a trademark. If no use is made of the trademark within three years, the registration may be subject to early termination on the grounds of non-use.

**8 Appealing a denied application**

Is there an appeal process if the application is denied?

Yes. An appeal may be filed against the following actions of the Rospatent by the applicant by filing an objection with the Chamber for Patent Disputes:

- refusal to accept a trademark application for consideration;
- refusal based on likelihood of confusion with a state registration of a trademark;
- refusal of state registration of a trademark; or
- recognition of a trademark application being withdrawn.

An objection may be filed within three months of the date of receipt of the decision from Rospatent.

**9 Third-party opposition**

May a third party oppose registration, or seek cancellation of a trademark or service mark? What are the primary bases of such challenges, and what are the procedures?

Yes, a third party may oppose registration or seek cancellation of a trademark or service mark registration. Trademark registrations may be contested and recognised as invalid:

- in full or in part, in the course of the whole time period of validity of the exclusive right to a trademark, if legal protection was granted in violation of any of the absolute bases upon which registration of state trademark registration could be refused;
- in full or in part, in the course of five years from the date of publication of information on the state registration of the trademark in the Official Gazette, if legal protection was granted in violation of novelty grounds for rejection of registration;
- in full, in the course of the whole time period of validity of the exclusive right to a trademark, if legal protection was granted in the name of an owner that is not a legal entity or an individual entrepreneur;
- in full, in the course of the whole time period of validity, if the priority of the trademark was later than the date of recognition of another registered trademark as a well-known mark;
- in full, in the course of the whole time period of validity of the exclusive right to a trademark, if registration was granted to an agent or a representative of a person who is the holder of this trademark in one of the member states of the Paris Convention;
- in full or in part, in the course of the whole time period of validity if any actions of the rightholder connected with the state registration of the trademark constitute an abuse of right or unfair competition; or
- in full or in part, in the course of the whole time period of validity of the exclusive right to the well-known trademark, if the registration was granted in violation of the requirements settled for well-known trademarks.

The granting of legal protection to a trademark may be contested by any interested party on the bases mentioned above by the filing

of an objection against such a grant with the Chamber of Patent Disputes or with Rospatent. Decisions of Rospatent may be disputed in a court.

If the registration is recognised as invalid in full, the trademark certificate and the record in the state register of trademarks shall be annulled.

**10 Duration and maintenance of registration**

How long does a registration remain in effect and what is required to maintain a registration? Is use of the trademark required for its maintenance? If so, what proof of use is required?

Registration and the exclusive right to use a trademark are valid for 10 years from the date of filing the application.

Registrations may be extended for additional 10-year periods if the owner files a request during the last year of validity of the right.

Use of the trademark is not required for its maintenance.

**11 The benefits of registration**

What are the benefits of registration?

Registration of a trademark provides the following rights and possibilities:

- identification of infringers or grey market players;
- increased remedies for infringement;
- registration of a trademark in the Custom Register;
- control of unauthorised distribution channels and shipments;
- prevention of infringements taking place through imports or exports in or out of Russia;
- extension of the market in Russia;
- stopping competitors from benefiting from the owner's good reputation;
- identification of underpayment of royalties from licensees;
- maximising revenue from use of the trademark in Russia; or
- creation of a strong image and reputation of the intellectual property, enabling Russian consumers to enjoy benefits derived from the quality of the goods or services earned through the holder's good reputation in Russia.

**12 Assignment**

What can be assigned?

An exclusive right to a trademark, in respect of all or some of the goods for which it has been registered, may be assigned to a legal entity or to an individual entrepreneur under an assignment deed.

A trademark assignment can refer not only to a trademark, but also to trademarks with goodwill. This is not obligatory; it is a matter of agreement between the parties to a contract.

If a trademark assignment includes a trademark that contains as an unprotected element designation of a place or origin of goods for which legal protection is provided within the Russian Federation, the assignment shall be allowed only if the assignee has the exclusive right to such designation.

A trademark assignment shall not be allowed if it may lead consumers to be confused with regard to goods or their manufacturer.

**13 Assignment documentation**

What documents are required for assignment and what form must they take?

To register an assignment with Rospatent, the following documentation must be provided:

- three original assignment deeds (numbered and stapled together, and the copies should be duly notarised);
- power of attorney signed by the assignor or assignee; and
- a payment document amounting to the official fee (about €230 per trademark included in the assignment).

The form of assignment is not strictly regulated; however, one of the assignment articles should be related to monetary compensation, otherwise it might be deemed as the deed of a gift and therefore will be considered invalid in accordance with Russian legislation.

#### 14 Validity of assignment

Must the assignment be recorded for purposes of its validity?

Yes, the assignment deed must be registered with Rospatent. Without such registration it shall be deemed invalid.

#### 15 Security interests

Are security interests recognised and what form must they take?

Must the security interest be recorded for purposes of its validity or enforceability?

Yes, security interests are recognised but must be registered with Rospatent. Without such registration they shall be deemed invalid.

To register a security interest deed with Rospatent, the following documentation shall be provided:

- three original assignment deeds (numbered and stapled together, and the copies should be duly notarised);
- power of attorney; and
- a payment document amounting to the official fee (about €230 per trademark included in the deed).

#### 16 Markings

What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?

Trademark owners have the right to use the '®' or 'R' symbol of protection or the verbal indication 'trademark', but it is not mandatory. Any of these symbols denotes that the designation with which it is used is a trademark protected in the Russian territory.

Use of the registration with non-registered marks is considered to be misleading to potential customers. Punishments for such misleading use range from a fine (maximum €600) to imprisonment for up to two months, in accordance with criminal law.

#### 17 Trademark enforcement proceedings

What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?

Any infringement or illegal use of a trademark may be challenged in civil, administrative or criminal proceedings under the law.

To enforce trademark rights against an infringer, the following remedies are available in Russia:

##### Civil law

- Recognition of trademark rights;
- Damages awards, including lost profits or compensatory payment, amounting to 10,000 to 5 million roubles;
- Removal from circulation and destruction of infringing articles at the expense of the infringer of counterfeit goods;
- Compensation for losses of an amount of 10,000–5 million roubles.

##### Administrative law

The illegal use of a trademark may be qualified as act of unfair competition and may be prohibited administratively by the Federal Antimonopoly Services and punished with a fine of 30,000 to 40,000 roubles (for legal entities).

##### Customs law

Prohibition of imported or exported counterfeit or parallel import goods.

##### Criminal law

The illegal use of a trademark or a confusingly similar mark may be prosecuted if the violation has been ongoing or repetitive or has caused major damage, and may be punished by a fine of 200,000 roubles or five years' imprisonment.

In the Russian Federation, there are no specialised courts or tribunals for trademark infringement.

#### 18 Procedural format and timing

What is the format of the infringement proceeding?

In most cases relating to trademark infringements, disputes will be handled in the arbitrage court (a type of commercial court in Russia). There is a time limit of no more than three months for the first stage of proceedings. First-instance decisions may be appealed to a higher commercial court. The third stage is an appeal to the Court of Cassation, and the final stage is an appeal to the High Arbitration Court.

Depending on the circumstances of the case, all stages of the full proceeding can take between six months and two years to complete.

Before and during the hearing, discovery is allowed in order to provide as much evidence as possible to prove the party's position. Live testimony may also be introduced. Expert review and testimony may also be initiated by both parties, but it must be ordered by the judge.

Criminal proceedings are the most powerful method by which to address trademark infringement. The stages of a criminal investigation are: preliminary investigation; commencement of a proceeding; inquiry by the Prosecutor's Office or interior ministry agencies (Militaria); investigating action; arraignment and description of indictment; and preparation of case materials for transfer to the court.

#### 19 Burden of proof

What is the burden of proof to establish infringement or dilution?

The plaintiff has the initial burden of proof to establish infringement under Russian trademark law. The plaintiff has the burden of proving:

- the validity and ownership of trademark rights;
- prior rights in the trademark; and
- the existence of a likelihood of confusion between the marks.

Regarding establishment of an infringement, the following facts and documents should be taken into consideration:

- any exclusive right to a trademark proved by the trademark certificate issued in the name of the trademark owner;
- the inability of a potential infringer to provide ('juridical' feature of infringement) documents confirming its right to use the trademark (assignment deed or licence agreement properly registered with Rospatent);
- the identity or similarity of a registered trademark with the infringer's mark;
- similarity of goods or services on which the infringer's mark is used; and
- differences between goods produced by the alleged infringer and by the trademark owner ('technical' feature of counterfeiting).

There is no cause of action for dilution under Russian law.

**20 Standing**

Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?

A trademark owner or a licensee may seek a remedy in civil proceedings. The plaintiff must submit evidence that it is the real owner of the exclusive trademark rights.

A trademark owner or a licensee, as well as a third party (for example, a competitor or customer), may have standing to bring a criminal complaint.

**21 Foreign activities**

Can activities that take place outside the country of registration support a charge of infringement or dilution?

No. A charge of infringement cannot be supported by activity that took place outside Russia. It might, however, serve as indirect evidence of the good reputation of the mark outside the country in support of well-known trademark cases.

**22 Discovery**

What discovery devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?

The following discovery devices are available for obtaining evidence from parties other than the trademark owner or licensee:

- petition to the court for an order for evidence;
- interrogation (in criminal proceedings); and
- operative search activity (in criminal proceedings).

**23 Timing**

What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?

It takes three months to one year to obtain a decision from the first instance court. The appeal stages (appeal and cassation) also take about one year. Altogether, the three court stages may take about two years.

**24 Litigation costs**

What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?

Costs associated with an infringement action typically range from €7,000 to €15,000 per case, depending on the complexity of a particular case.

In accordance with the Russian Code of Civil Procedure (articles 98 to 100), the successful party in the legal case can recover costs such as the costs for experts, witnesses, translators and lawyers. However the court estimates lawyers' fees within 'reasonable limits', which are usually much less than they actually cost.

**25 Appeals**

What avenues of appeal are available?

Decisions of the first stage of trial can be appealed at two separate levels. The first appeal should be filed within one month of the date of the final decision at trial. The appeal stage must be completed within a month of the date when the appeal is filed.

An appeal to the Court of Cassation, which is the third stage of commercial court proceedings, should be filed within two months of the hearing on appeal. This stage is supposed to be final; however, the case might also be reviewed by the Supreme Arbitrage Court. Proceedings of the Supreme Arbitrage Court last about six months.

**26 Defences**

What defences are available to a charge of infringement or dilution, or any related action?

The following defences are available to a charge of infringement:

- the plaintiff does not own valid rights in the trademark;
- the claimed mark is merely descriptive;
- no likelihood of confusion exists between the marks; and
- the defendant has prior rights in the mark.



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**27 Remedies**

What remedies are available to a successful party in an action for infringement or dilution, etc? What criminal remedies exist?

See question 17.

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**28 ADR**

Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?

Theoretically, trademark cases may be resolved through commercial mediation. However, trademark disputes are seldom resolved through ADR techniques because submission to ADR should be

based on contracts where a commercial mediation or international arbitration provision was signed by both parties; it is, however, extremely rare.

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**29 Famous foreign trademarks**

Is a famous foreign trademark afforded protection even if not used domestically? If so, must the foreign trademark be famous domestically? What protection is provided?

No, a famous foreign trademark is not afforded protection without its domestic use. The foreign trademark has to become widely known in the Russian Federation among consumers as a result of intensive use.