

# IP in Fashion

MILANO

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# TRADEMARK PROTECTION IN RUSSIA

**GORODISSKY**



# TRADEMARK PROTECTION

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- Trademark protection (exclusive rights) – result of state registration
- No use requirement before filing
- “First come - first served”, first-to-file principle

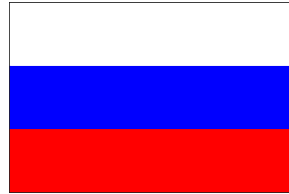
Legal Basis of Trademark System in Russia:

- Part IV of the Civil Code (2008),
- Paris Convention,
- TLT,
- STLT,
- Madrid Agreement & Protocol

# WAYS TO OBTAIN TRADEMARK PROTECTION

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- National



- International



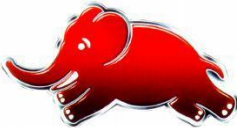


- Well-known

***Nikon***

PHOTOSHOP TIFFANY

# WHAT CAN BE REGISTERED AS A TRADEMARK?

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- word **glamourella**
- device 
- three-dimensional 
- and OTHER INDICATIONS or their combinations 

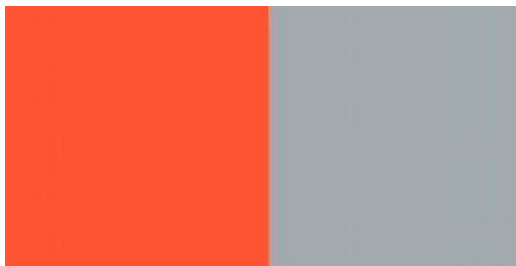
Trademark may be registered in any color or color combination

- Possibility of registration of «non-traditional» marks

# NON-TRADITIONAL TRADEMARKS

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- 3D-marks
- Color marks
- Sound marks
- Texture marks
- Smell marks
- Position marks
- Hologram marks
- Motion marks
- Taste Marks
- etc.



# LATIN, OR/AND CYRILLIC?

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- Average Russian customer easily recognizes Latin characters

BUT:

- Cyrillic registration is strongly recommendable
- Strengthening of legal protection by registration of the Cyrillic equivalent

# LATIN / CYRILLIC – DIFFERENT APPLICATIONS

**ДОЛЬЧЕ ВИТА**  
**DOLCE VITA**



**ДОЛЬЧЕ ВИТА**

**DOLCE VITA**

# WORD/ DEVICE / COMBINED – SEPARATE REGISTRATIONS

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PRADA





# FILING OF BLACK/WHITE OR CLAIMING OF COLOR

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- Is color an essential feature of a trademark?
- Does a specific color identify an applicant's business?
- Is a trademark used in one color or in different versions?

Important: description of color (golden, silver, bronze, etc.)



# BEST FILING STRATEGY

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- Separate registration in Cyrillic along with registration of original trademark in Latin
- Trademarks in black and white or a particular color (separate applications) – both versions preferable
- Word / design / label etc. – all versions to get broader coverage or as actually used

**OPPOSITION AND  
INVALIDATION  
PROCEEDINGS  
IN RUSSIA**

# OBJECTIONS AGAINST TRADEMARKS

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## Actions against pending trademark application

- Written statement filed with the Russian PTO (no opposition procedure)

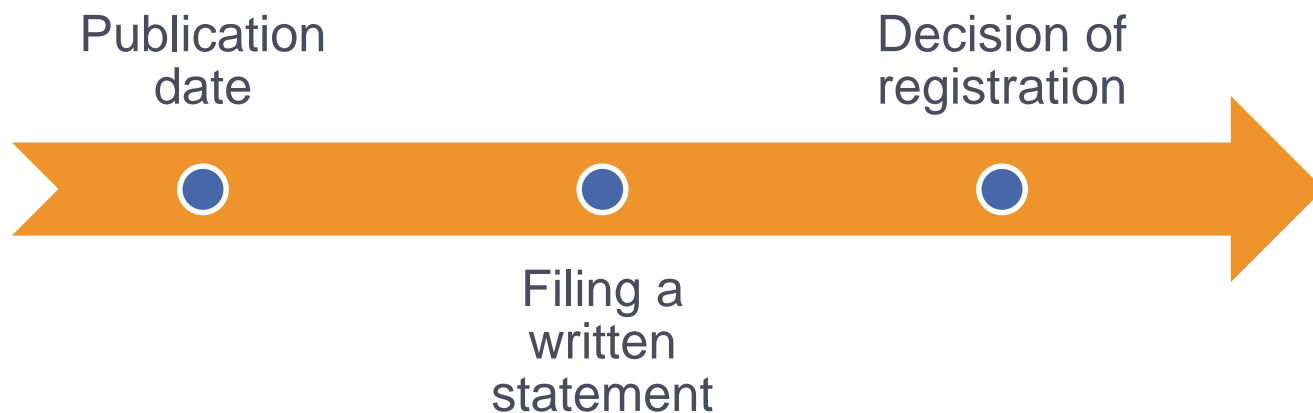
## Actions against registered trademarks

- Invalidation action based on absolute, relative and other grounds
- Cancellation action based on liquidation of trademark holder
- Cancellation action based on non-use (under jurisdiction of IP Court)

# ACTION AGAINST PENDING TRADEMARK APPLICATION

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- Trademark applications are published
- Any person may file a written statement against a pending trademark application



# GROUNDS FOR INVALIDATION

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- Capacity of a trademark to mislead the consumers, e.g. Italian names or words which sound “Italian”

# GROUNDS FOR INVALIDATION

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- designations identical or confusingly similar to:
  - Trademarks (pending/registered/well-known)
  - firm names, commercial designations, names of selection achievements
  - appellations of origin of goods
  - copyrighted objects of third parties
  - personal non-property rights of famous persons
  - industrial designs of third parties

# SIMILAR TRADEMARKS

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- registered for Class 09



- earlier registered for Class 09

**ARMANI**

ARMANI PRIVÈ

GIORGIO ARMANI PRIVÈ

AX ARMANI EXCHANGE



# SIMILAR TRADEMARKS

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PUPA  
PUPA MILANO

PUPA

pupa

○ PUPA

VS puSpa

# UNFAIR COMPETITION OR ABUSE OF RIGHT

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■ Unfair obtaining of registration of a trademark

■ The fact of unfair competition or abuse of right must be established by Anti-Monopoly authority

**TRADEMARK  
USE AND NON-  
USE  
IN RUSSIA**

# USE AND NON-USE

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- Vulnerable to non-use in 3 years after registration
- Consideration of non-use cases before IP Court
- Burden of proof by trademark owner
- Legal interest of filing party
- Evidence of non-use not required

# USE OF A MODIFIED TRADEMARK

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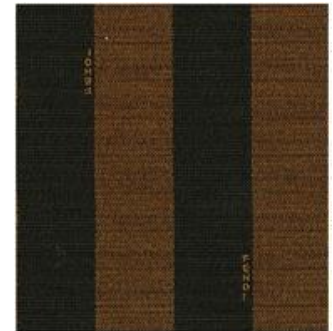
- If used with alterations, this might become a subject of dispute (up to IP Court to decide)
- Use as registered preferable

**Recommendation:** to register all versions, in which a trademark is used

**FENDI**

**F FENDI**

*Fendi*



# PROVING TRADEMARK USE

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- Shipping and customs documents
- Invoices
- Copies of agreements with indication of trademark and its owner
- Statements or evidence from local distributors
- Russian Quality Certificates
- Advertising materials in the Russian language, dated price-lists
- Extracts from Russian magazines, newspapers, TV commercials
- Samples of products

## GORODISSKY & PARTNERS

**THANK YOU  
FOR YOUR  
ATTENTION!**



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