



Intellectual Property Court considers protection afforded to unregistered marks and limits of letters of consent

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08 February 2022



RUSSIAN FEDERATION

Legal updates: case law analysis and intelligence

- The presence of an absolute ground for refusal cannot be remedied by a letter of consent if a likelihood of confusion still exists
- This is the first court opinion ever to be issued on this issue
- The decision also clarifies when an unregistered mark will be protected in Russia

On 12 January 2022 the Russian Intellectual Property Court issued its decision in Case SIP-897/2021, in which it:

- gave additional explanations as to when unregistered marks have some level of protection in Russia; and
- provided an opinion as to when a letter of consent will not help to obtain trademark protection in the country.

Background

An individual entrepreneur filed a trademark application for certain goods in Classes 5, 32 and 35. The Russian Patent and Trademark Office (RUPTO) refused to register the mark based on:

- Article 1483, Paragraph 6, Subparagraph 2 of the Civil Code (confusing similarity with an earlier trademark); and
- Article 1483, Paragraph 3 of the Civil Code (misleading consumers due to the existence of products bearing the same unregistered mark on the market).

After an unsuccessful appeal before RUPTO to challenge the refusal, the entrepreneur applied to the Intellectual Property Court, providing a letter of consent by the owner of earlier registered trademarks - and thus defeating the refusal based on Article 1483, Paragraph 6, Subparagraph 2.

Intellectual Property Court decision

The Intellectual Property Court therefore focused on the issue of when the existence of earlier products bearing similar or identical unregistered marks on the market could be a bar to trademark registration.

The court stated that:

- where a company uses a specific unregistered mark (name or logo) in the Russian Federation;
- where such mark is at least known to the average Russian consumer; and
- if the mark is not used in the Russian Federation, but is used on the territory of other states in such a way as to be known to the average Russian consumer;

registration of the same mark in the name of an entity that is not connected to the manufacturer of the goods will mislead consumers. Therefore, it is prohibited under Article 1483, Paragraph 3 of the Civil Code.

As this constitutes an absolute ground for refusal, it cannot be remedied by a letter of consent if a likelihood of confusion still exists. This is a crucial part of the decision as it is the first court opinion ever to be issued on this point.

The court mentioned that, where the earlier unregistered mark is unknown to the average Russian consumer, then the probability of any association being made between this mark and the manufacturer of the product bearing this mark tends to be negligible. Therefore, it cannot be a ground for refusal of a later trademark application. In the present case, the court considered that the evidence of awareness of the earlier unregistered mark among Russian consumers was very scarce and unpersuasive.

The decision of RUPTO was thus invalidated and the case was sent back to it for reconsideration.

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