



## Authors

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## Legal framework

Part IV of the Civil Code of the Russian Federation incorporates all the IP laws into a single statute, with trademark legislation set out in Chapter 76 of Section VII.

Russia is party to the following multilateral international agreements:

- the Paris Convention for the Protection of Industrial Property (Stockholm Act);
- the Madrid Agreement concerning the International Registration of Marks (Stockholm Act);
- the Protocol to the Madrid Agreement concerning the International Registration of Marks;
- the Nice Agreement concerning the

International Classification of Goods and Services for the Purposes of the Registration of Marks (Geneva Act);

- the Nairobi Treaty on the Protection of the Olympic Symbol;
- the Trademark Law Treaty; and
- the Singapore Treaty on the Law of Trademarks.

## Unregistered marks

No rights exist in an unregistered mark unless it is well known according to Article 6*bis* of the Paris Convention and recognised as such according to Articles 1508 and 1509 of the Civil Code.

An unregistered mark can be protected if, due to intensive use, it has become widely known in Russia among the relevant consumers with respect to the goods of the person seeking protection of the mark.

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## “ The illegal use of a trademark entails administrative liability for the infringer. The administrative penalties for such offences are seizure of counterfeit goods and a fine ”

### Registered marks

#### Ownership

A legal person or an individual entrepreneur may apply for and own a mark.

A power of attorney can be presented after filing the application. Neither notarisation nor legalisation of a power of attorney is required.

#### Scope of protection

Verbal, pictorial, three-dimensional and other indications, including non-traditional marks (eg, motion, sound or olfactory marks), or a combination thereof, in any colour or colour combination, may be registered as trademarks.

The following cannot be protected:

- indications without distinctiveness (distinctiveness acquired through use is considered);
- indications consisting only of certain elements (eg, those generally used for the indication of certain goods or those that characterise the goods);
- indications containing elements that are false or misleading to the consumer in respect of a product or its manufacturer, or that are contrary to public interests, the

- principles of humanity and morality;
- indications identical or confusingly similar to official names and images of particularly valuable objects of the cultural heritage of the Russian people or of the worldwide cultural or natural heritage;
- indications identical or confusingly similar to the earlier trademarks of other persons protected in Russia or applied for registration with respect to the same or similar goods;
- indications identical or confusingly similar to appellations of origin protected in Russia with respect to any goods;
- indications identical or confusingly similar to a company name or a commercial designation (or their elements), or a name of an achievement in breeding registered in the State Register of the Protected Achievements of Breeding; and
- indications conflicting with the earlier copyrights of other persons, some earlier personal rights and the earlier rights to industrial design, compliance marks.

### Procedures

#### Examination

The examination procedure includes a formal examination of the application – conducted within one month of filing – and a substantive examination of the mark. During the formal examination, the application and accompanying documents shall be checked for compliance with the statutory requirements. During the substantive examination, the mark is checked for compliance with the conditions set out in the Civil Code:

- the acceptability of the applied-for subject matter as a trademark; and
- the absence of absolute and some relative grounds for refusal of registration.

#### Opposition

No opposition procedure is available in Russia.

#### Registration

Depending on the results of the substantive examination, the Patent and Trademark Office (PTO) shall make a decision about the registration of the trademark. If registration is accepted, within one month of receipt of a document certifying payment of the statutory

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**“ Any unauthorised commercial use of a protected trademark shall be considered infringing and goods, labels and packaging on which the trademark or a confusingly similar sign is unlawfully placed shall be regarded as counterfeit ”**

fee the PTO enters the trademark in the State Register of Trademarks and Service Marks. A trademark certificate is issued within one month of the date of registration.

#### **Removal from register**

**Invalidation:** Trademark protection may be contested and held invalid:

- in full or in part for the whole term, if it was granted in contravention of the requirements set forth in Article 1483(1) to (5), (8) or (9) of the Civil Code;
- in full or in part within five years of the date of the registration’s publication in the *Official Gazette*, if the protection was granted in contravention of the requirements of Articles 1483(6) and (7) of the Civil Code;
- in full within the whole term if protection was granted to someone who is neither a legal person nor an individual entrepreneur;
- in full within the whole term of protection, if protection was granted to a mark having later priority with respect to another person’s trademark that had been recognised as well known;
- in full within the whole term if protection was granted in the name of an agent or representative of a person with the exclusive right in such designation in a Paris Convention member state without permission of the rights holder; or
- in full or in part during the whole term of the protection, if the rights holder’s actions relating to registration of the trademark have been duly recognised as an abuse of rights or unfair competition.

The grant of protection to a well-known mark may be invalidated in full or in if the protection was granted unlawfully.

**Termination:** Trademark protection is terminated:

- on the expiry of the 10-year term of protection (this can be extended indefinitely for further 10-year periods);
- in the case of a collective mark, if the IP Rights Court so orders due to the use of the mark on goods without common qualitative or other general characteristics;
- if the IP Rights Court so orders based on a petition by an interested person where the trademark was not used for a continuous three-year period after registration;
- if the rights holder ceases business through liquidation (for a legal entity) or the termination of business activity (for a natural person);
- where the rights holder abandons its exclusive right to the mark; or
- if the PTO orders termination based on a petition by an interested person, where the mark has become a commonly used indication for the designation of certain goods.

#### **Timeframe**

Trademark procedures take the following periods of time:

- registration – 12 to 14 months;
- renewal – two to three months;
- registration of transactions (eg, licences, assignments) – two to three months; and
- change of name – two to three months.

#### **Searches**

The PTO conducts the following searches:

- a search from a named earliest date;
- a similar trademark search;
- an identical trademark search, but only alongside a similar trademark search;
- a search in a single class;
- a search in all classes;

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- a search including trade names and slogans (the PTO can provide searches only in its database of registered or applied trademarks);
  - a search of traditional graphical marks; and
  - a search of non-traditional graphical marks.

The fee for a word mark search in one class depends on the time taken:

- one day – \$1,200;
- three days – \$600;
- one week – \$300;
- two weeks – \$200; or
- one month – \$100.

Additional fees are payable for each additional class. The fee for a graphical mark search also depends on the time taken:

- one week – \$750;
- two weeks – \$500; and
- one month – \$250.

### Enforcement

The Civil Code stipulates that the rights holder shall have the exclusive right to use its registered or protected trademark:

- for goods, labels and packaging which are manufactured, offered for sale, sold, displayed at exhibitions and fairs or used commercially in Russia, or stored and transported or imported into Russia for this purpose;
- while performing jobs and providing services;
- on documents introducing the goods in commerce;
- while offering goods for sale; and
- on the Internet, particularly in domain names and in other forms of address.

No unauthorised person should use identical or confusingly similar signs for goods or services that are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. Hence, any unauthorised commercial use of a protected trademark shall be considered infringing and goods, labels and packaging on which the trademark or a confusingly similar sign is unlawfully placed shall be regarded as counterfeit.

Four types of legal action may be taken against trademark infringers.

### Administrative proceedings

The illegal use of a trademark entails administrative liability for the infringer. The administrative penalties for such offences are seizure of counterfeit goods and a fine as follows:

- individuals – the cost of the counterfeit goods, but no less than \$70;
- legal entities – three times the cost of the counterfeit goods, but no less than \$1,350; and
- officials – twice the cost of the counterfeit goods, but no less than \$650.

Any concerned person may file an application to the police to start administrative proceedings. The police then examine the application and decide whether to commence proceedings. If there is a case, the police complete a report on the administrative offence and transfer the administrative case to the commercial court. The commercial court's decision may be appealed to a higher court.

An administrative procedure usually takes three to four months from discovery of the offence to the first court decision.

### Civil proceedings

Civil proceedings begin with the rights holder filing a claim with the court. IP disputes fall under the jurisdiction of both common and commercial courts. Common courts are used where at least one of the parties is an individual, whereas disputes between corporate parties and private entrepreneurs are dealt with in the commercial courts.

The rights holder may claim the following remedies in civil proceedings:

- cessation of the authorised use of the trademark;
- reimbursement of damages;
- removal of all counterfeit goods from the market and their destruction;
- publication of the court's decision; and
- compensation of between \$340 and \$165,000.

The rights holder shall prepare a detailed calculation of the claimed damages. The chances of success will be higher if there is documentary proof of the claimed damages.

It may file only one claim: reimbursement of damages or unconditional compensation. A claim for unconditional compensation is preferable where there is no documentary proof of damages.

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Preliminary injunctions are available. The court may order injunctive relief preventing the defendant from performing actions related to the subject matter of the proceedings or ordering the seizure of the defendant’s property. The court may order more than one type of injunctive relief at once provided that the remedies correspond to the claims.

A petition for injunctive relief shall be considered by the court on the day of filing (in the common courts) or no later than the day after the claimant files such petition with the commercial court.

Injunctive relief may be applied for at any stage of the court proceedings if the non-application of such remedies would complicate or make enforcement of the court ruling impossible, including when the court decision is due to be enforced abroad, or would result in significant damage to the claimant.

Before ordering injunctive relief, the court may ask the claimant to provide a deposit in case of possible damages or to present the court with financial security.

A civil trademark infringement case, from filing to the first-instance court judgment, takes an average of four to six months.

### **Criminal proceedings**

The illegal use of a trademark shall entail criminal responsibility only if the infringement occurs repeatedly or causes severe damages. Damages shall be deemed severe if they exceed \$48,500.

Criminal penalties include:

- a fine of \$6,500 or 18 months’ salary or other income ;
- compulsory work for between 180 and 240 hours; and
- disciplinary work for up to two years.

If committed by an organised group, the same crime is punishable by:

- a fine of between \$15,000 and \$30,000 or between three and five years’ salary or other income; or
- compulsory work for up to five years; or
- imprisonment for up to six years and, optionally, a fine up to \$15,000 or up to three years’ salary or other income.

The rights holder may claim reimbursement of damages by the accused person(s).

Criminal proceedings consist of two stages: preliminary investigation and court hearings. A concerned person can file an application with the police to begin criminal proceedings, which end with the first-instance court pronouncing sentence. This may be appealed to the court of higher instance. Criminal proceedings last an average of two years.

### **Special administrative procedures**

The illegal use of a trademark may be classed as an act of unfair competition. The Russian Anti-monopoly Service is empowered to consider unfair competition cases in special administrative procedures. Such procedures start on the basis of an application filed by any person concerned and terminate with the decision of the Russian Anti-monopoly Service. The decision may be appealed to the IP Rights Court.

### **Costs**

The total costs of filing and trying an infringement suit comprise state fees, attorneys’ fees and other expenses.

State fees shall be paid upon filing of a claim based on the amount of claim, from \$65

to \$6,500. The amount of the claim shall be determined by the claimant in accordance with the amount claimed, including corresponding penalties and interest. The state fee for an immaterial claim for recognition of right is about \$130.

The costs of proceedings may include payments to experts and other persons involved in proceedings.

### Customs actions

In order to prevent the import of counterfeit goods, a rights holder may file an application with the Russian Customs Service requesting that its trademark be entered into the Customs Register of IP Objects.

Customs pays special attention to goods carried across the border which are marked with trademarks entered on the register. If it suspects that these are counterfeit, Customs shall suspend release of those goods and immediately inform the rights holder or its representative. During the prescribed term, the rights holder (or its representative) has the right to inspect the goods suspended from release and to take legal action, if necessary.

### Specialised court

Established in 2013, the IP Rights Court is a specialised commercial court with jurisdiction over cases concerning IP disputes. As a first-instance court the IP Rights Court shall consider:

- appeals against the decisions and actions/failure of actions of the PTO;
- patent invalidation suits for reason of wrong ownership or inventorship; and
- cancellation actions for non-use.

As a court of cassation the IP Rights Court shall consider cases considered by the IP Rights Court at first instance and IP infringement cases considered by first instance commercial courts and commercial appeal court.

All cases are heard by a panel of at least three judges. The court may engage experts to clarify specific questions on the matter of dispute; and, for these purposes, it may send a binding order to any authority, organisation or person.

### Time limits

The statutory limitation for initiating a civil court action is three years. An action based

on prior rights against a trademark registered in good faith may be filed, depending on the grounds, within five years of registration or within the term of the mark's validity. Actions against trademarks registered in bad faith may be contested and annulled during the whole term of the trademark's validity.

### Ownership changes and rights transfers

A rights holder can freely dispose of its exclusive right to the trademark, particularly by assignment or a licence contract.

A transfer of the exclusive right without a contract is also allowed, particularly in case of universal succession in title and a charge on the rights holder's property.

Under an assignment, the rights holder can assign its exclusive right to another person in respect of all or part of the goods for which it has been registered.

Some restrictions apply to assignment and licensing. In particular, assignment is not allowed where it may mislead consumers with regard to the goods or the manufacturer. In addition, assignment of a trademark that contains an appellation of origin protected in Russia is allowed only when the assignee owns an exclusive right to such an appellation. A licence in respect of a trademark that contains an appellation of origin protected in Russia shall be allowed only when a licensee has the right to use this appellation.

In case of a licence, the licensee must ensure that the goods which it manufactures and sells bearing the licensed trademark match the quality requirements prescribed by the licensor. The licensor shall have the right to control compliance with those requirements.

A licence contract shall specify where use of the trademark is allowed. If this is not specified, the licensee may use it throughout the Russian Federation. The term of a licence contract shall not exceed the term of the exclusive right to the trademark. If no term is specified in the contract, it is considered to be made for five years.

For the purposes of maintaining trademark protection, the licensee's use can be attributed to the rights holder and considered as proper use of the trademark. Thus, in case of a cancellation action for non-use, the owner can prove use by submitting the documents proving use by the licensee or another person

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under the owner's control.

Assignment contracts, licence contracts and other contracts that allow use of exclusive trademark rights must be made in writing, signed by the authorised persons and sealed where possible, and are subject to registration with the PTO. Failure to comply with this provision shall lead to invalidity of the contracts. No notarisation or legalisation of the contracts is required.

### **Related rights**

A sign, whether word, graphical, three-dimensional or any other kind, that is registered as a trademark can also be protected by other laws, such as under copyright law as an original work or as a registered design right.

### **Online issues**

The rights holder's exclusive rights cover the right to use the trademark in a domain name or in other online use. Thus, it can prevent third parties from using the mark in domain names that are identical or confusingly similar to its own mark where such use would result in a likelihood of confusion.

Disputes between rights holders and domain administrators shall be resolved by the courts. In case of cybersquatting, the court usually decides in favour of the earlier rights holder. [WTR](#)

Examination/registration		
<b>Representative requires a power of attorney when filing? Legalised/notarised?</b>	<b>Examination for relative grounds for refusal based on earlier rights?</b>	<b>Non-traditional marks registrable?</b>
Yes/No ✓ / ✓ / ✗	Yes ✓	3D; colours; holograms; motion marks; olfactory marks; sounds. ✓

Unregistered rights		Opposition
<b>Protection for unregistered rights?</b>	<b>Specific/increased protection for well-known marks?</b>	<b>Can a registration be removed for non-use? Term and start date?</b>
Yes: well-known marks or commercial designations. ✓	Yes ✓	No ✗

Removal from register		
<b>Can a registration be removed for non-use? Term and start date?</b>	<b>Are proceedings available to remove a mark that has become generic?</b>	<b>Are proceedings available to remove a mark that was incorrectly registered?</b>
Yes: any three-year period of non-use after registration. ✓	Yes ✓	Yes ✓

Enforcement		
<b>Specialist IP/trademark court?</b>	<b>Punitive damages available?</b>	<b>Interim injunctions available? Time limit?</b>
Yes ✓	No ✗	Yes: at any stage of the court proceedings. ✓

Ownership changes	Online issues	
<b>Mandatory registration for assignment/licensing documents?</b>	<b>National anti-cybersquatting provisions?</b>	<b>National alternative dispute resolution policy (DRP) for local ccTLD available?</b>
Yes/Yes ✓ / ✓ / ✓	No ✗	No ✗

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Vladimir I Biriulin graduated from the Moscow University of Law and later attended the Central Institute of Intellectual Property in Moscow. From 1973 to 1998 he worked in a major IP firm. Mr Biriulin joined Gorodissky & Partners in 1998 and became a partner in 2001.

He counsels clients on Russian and IP legislation, international IP treaties, conventions and agreements, technology transfer and licensing, the infringement of IP rights, unfair competition and copyright. He is a regular speaker at IP conferences and seminars in Russia and abroad, and is the author of numerous publications on Russian and foreign IP issues. He speaks Russian, English, French and Spanish.



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