

# WELL-KNOWN TRADEMARKS: DEFINITION AND SCOPE OF PROTECTION UNDER RUSSIAN LAW

23 April 2019

This article was [originally published by IAM](#) and has been republished with permission.

Legal protection for well-known trademarks in Russia rests on the provisions of the Agreement on Trade-Related Aspects of Intellectual Property Rights, the Paris Convention, the Russian Civil Code and the governing regulations applied by the Russia Patent and Trademark Office (Rospatent).

According to the Russian Civil Code, a registered trademark or a non-registered designation can be recognised as a well-known trademark at the request of the brand owner. However, Rospatent cannot accord well-known status to a trademark if the mark gained recognition only after the priority date of a third party's identical or confusingly similar trademark.

Unlike traditional trademarks, the scope of protection for a well-known trademark extends beyond the goods and services covered by its registration. In particular, a trademark owner can assert its rights even in cases where the alleged infringer has applied the trademark to a different class of goods or services and in cases where the impugned trademark creates a false association with the owner of a well-known trademark. The term of protection for a well-known trademark is unlimited and there are no renewal fees as there are with conventional trademark registrations.

There are approximately 200 trademarks that have been accorded well-known status in Russia. The most famous examples are: Coca-Cola (5), Lipton (21), Intel (22 and 25), Nestle (41 and 42) and Tiffany (56).

## Evidentiary requirements

The process of registering a well-known trademark begins long before an application is

actually filed. From a policy point of view, Rospatent is very receptive to the idea of according special status. However, it imposes a relatively high evidentiary burden upon the applicant. The success of an application largely depends on the applicant's ability to assemble a comprehensive file of persuasive material.

The process of preparing an application starts with a decision as to the precise trademark for which special status will be sought. In practical terms, the decision is made according to the version of the mark, be it a word, a design or a combination of the two. There must be sufficient documentary proof of use and notoriety.

Well-known status is typically established with the following types of evidence:

- intensive use of the trademark, in particular, within Russia (date of first use, sales locations, volume of sales, average annual number of consumers and position of the manufacturer in a certain market sector);
- significant advertising and marketing expenditures;
- the trademark's value according to annual financial statements (independent public ratings can also be helpful);
- social awareness surveys conducted by an independent organisation in Russia; and
- extensive use outside of Russia and recognition as a widely known trademark in other countries.

This represents the basics and any evidence that serves to establish the notoriety of the trademark is allowed. Further, it can be useful to produce sample invoices, customs declarations, samples of advertising materials and contracts for marketing and advertising services, all of which can strengthen the case.

## Practical tips

A review of earlier applications suggests that the following additional considerations be taken into account.

**The connection between the trademark owner and all other entities in the supply chain** In a recent case, Rospatent refused to recognise the trademark 'Lay's' as well known because the applicant failed to demonstrate a connection between the entities responsible for use, sales and advertising and the trademark owner (PepsiCo, Inc).

A brand owner should provide sufficient evidence that it is the entity that controls the presence of the goods in the Russian market and outline the supply chain.

**Multiple social awareness market studies** It is advisable to provide several results of social awareness market studies dating back to the year that the mark was claimed to support the assertion that the brand is well known. The studies should conform to Rospatent recommendations.

**Rebranding** In the case that branding has evolved, it is prudent to decide which version of the trademark should be claimed as well known.

**A colour or black and white trademark?** The best approach is to claim the version that is most frequently used. This allows the applicant to collect the most relevant and persuasive materials.

A similar rule applies when choosing a version of a well-known word mark. If a stylised mark is used, then this version would be a better option for well-known status recognition.

## Conclusion

Russian law prescribes a legal process for obtaining well-known status. The process tends to be somewhat tedious and costly, with a significant amount of pre-filing administrative work required. The jurisprudence suggests that the most critical piece of collected evidence is the public opinion survey, keeping in mind that other evidence is also necessary. However, these arduous procedural requirements are counterbalanced by the benefits received once the well-known trademark is put on the register – a broadened scope of protection strengthens the trademark's position against infringements. Registration of a well-known trademark can be an important element of brand protection and enforcement strategy.

---

NOT LEGAL ADVICE. Information made available on this website in any form is for information purposes only. It is not, and should not be taken as, legal advice. You should not rely on, or take or fail to take any action based upon this information. Never disregard professional legal advice or delay in seeking legal advice because of something you have read on this website. Gowling WLG professionals will be pleased to discuss resolutions to specific legal concerns you may have.

---

**Related** Intellectual Property, Trademarks, Brands & Designs

## Authors

**Maria Aronikova**

Partner - [Moscow](#)

 [Email](#)

maria.aronikova@gowlingwlg.com

 Phone

+7 495 502 1251

 vCard

Maria Aronikova

## **Elizaveta Osipchuk**

Associate - Moscow

 Email

elizaveta.osipchuk@gowlingwlg.com

 Phone

+7 495 787 2070 Ext 18120

 vCard

Elizaveta Osipchuk