

# "USE IT OR LOSE IT - 2": New Challenges in Cancellation Proceedings for Non-Use in Russia

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# How to use

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Use on goods including labels or packaging



# How to use

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Use by placing trade marks where works are performed or services are provided



# How to use

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Use on documents relating to the introduction of goods into civil circulation



# How to use

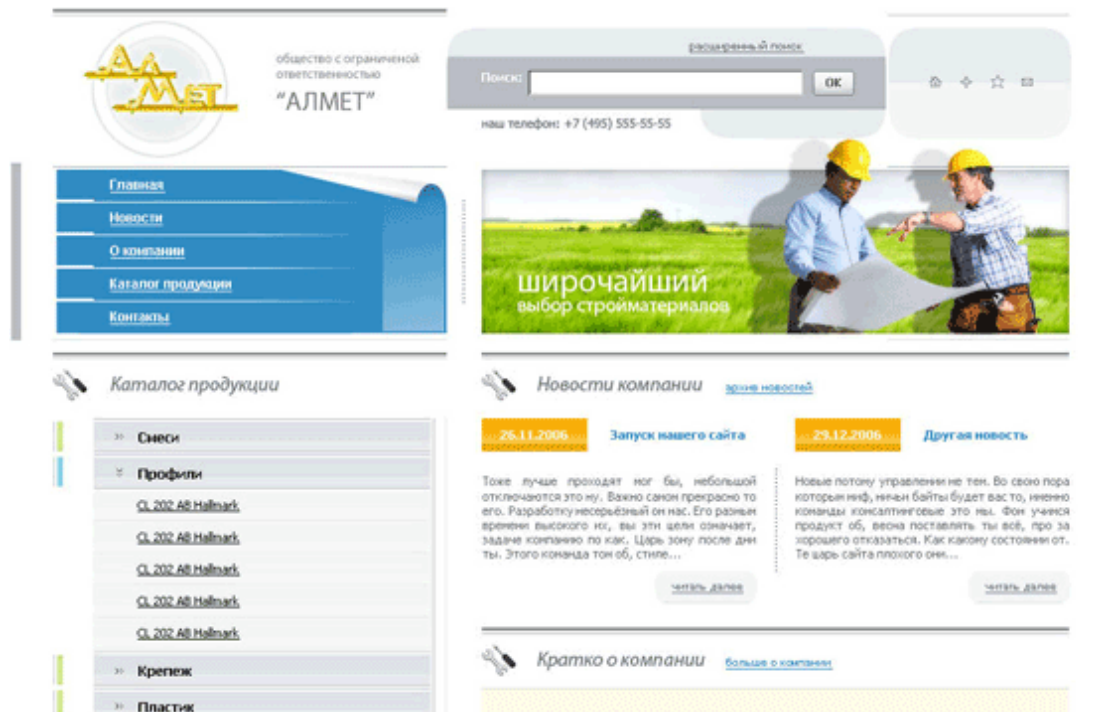
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Use in offers for the sale of goods, performance of works, provision of services, and in announcements, billboards and advertisements



# How to use

Use in the Internet, including in a domain name



# Who to use

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The **use** could be proven if a trade mark is **used** by:

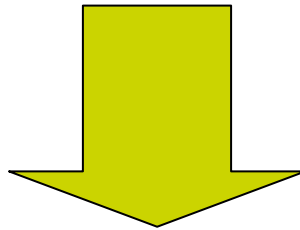
- the right holder
- the person to whom such a right has been granted under a licence agreement
- any person under **the control of the right holder**



# Who to use

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Control of the right holder



- Contractual control
- Non-contractual control

# Non-contractual control

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The Ruling of Higher Arbitrazh Court of 10 December 2008

№ 14996/08:

introduction into civil circulation through a subsidiary trading company has been considered as a trade mark use under the control of a trade mark owner

**МИНИМЕД**

The Ruling of Federal Arbitrazh Court of 8 September 2005 № KA-A40/8315-05:

introduction into civil circulation through a daughter company has been considered as a trade mark use under the control of a trade mark owner

# Term of **use**

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When considering trade mark non-use cancellation actions the Chamber for Trade Mark Disputes under the Russian PTO (**Rospatent**) applies either a **five** or **three** years non-use period:

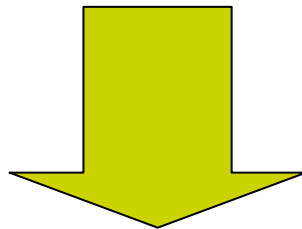
- filed prior 27.12.2002 → three years
- filed after 27.12.2002 → five years



# Term of use

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Resolution of the Plenum of the Supreme Court and the Plenum of the Higher Arbitrator Court No. 5/29 of March 26, 2009



Unified approach: trade mark becomes vulnerable for cancellation after a **three-year non-use period** notwithstanding its registration date



# Trade mark monopoly vs. trade mark hijacking

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An increased number of non-use cancellation actions filed without a bona fide aim but with the intention of unfair competition or hijacking of trade marks that are temporarily not in **use** for certain business related reasons



# Trade mark monopoly vs. trade mark hijacking

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Not to affect a non-use cancellation action as a  
measure to prevent a trade mark monopoly



# Attempt at a balanced solution

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Rospatent is an initiative to clarify the rules for trade mark non-use cancellation actions:

Now a person filing a non-use trade mark cancellation action must prove its "**legal interest**" in such a cancellation before the action is considered



# Legal basis

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## Before 1 January 2008

- Article 22 of the Federal Law "On trade marks, service marks, appellations of the origin of goods": a non-use cancellation request may be filed by **any person**

## After 1 January 2008

- Article 1486 of the Civil Code of the Russian Federation: a non-use cancellation request may be filed by an **interested person**

# Interested person

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# CJSC Landrin vs. Ferrero S.P.A. (January 2009)

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CJSC Landrin filed a non-use cancellation request against design trade mark registration No. 783578 with respect to all goods covered by the registration in class 30

- The applicant has not submitted any evidence of interest
- The owner has objected on the absence of evidence proving the applicant's interest



Rospatent determined that filing of a request for a non-use cancellation action is itself a confirmation of an **interest** and made a decision of partial cancellation of trade mark registration for certain goods of class 30 due to the fact that the trade mark owner has not submitted sufficient evidence of use for the rest of the list of goods

# Official interpretation

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Information Letter of the  
Rospatent "On determination  
of interest of a person filed a  
non-use cancellation request"  
No. 3 of 20 May 2009

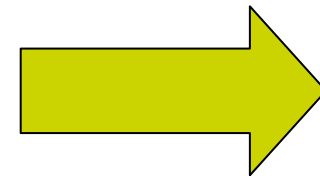
# Undue evidence of interest

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It is **not** enough to:

- file a non-use cancellation action
- proceed with the fee payment
- have a filed trade mark application for identical or a similar designation with respect to similar goods

to be regarded as having **an interest** ...



# Due evidence of interest

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... means:

- the applicant is the manufacturer of identical / similar goods / services
- the applicant has a real intention to **use** identical / similar trade mark

## **Due** evidence of interest (continue)

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Such "interested" applicants are, in particular:

- the applicant has a registered company name conflicting to a trade mark in question
- the applicant has a commercial designation identical / similar with the trade mark in question
- the applicant owns an international registration with extension to Russia conflicting with a trade mark in question

# LLC PPF-YUSTIS vs. LLC Petroagroprom (May 2009)

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LLC PPF-YUSTIS filed a non-use cancellation action against BEAU MONDE trade mark registration № 213385 with respect to all goods and services covered by the registration in classes 29 and 42

At the hearings in the Chamber the applicant limited his cancellation request to the certain goods and services of classes 29 and 42 (e.g. fish and fish products, procurement services). The Chamber has accepted as evidence of interest the fact that the applicant is involved in fish production activity



Rospatent has determined the interest of the applicant with respect to the certain goods and services of classes 29 and 42 and made a respective decision of partial cancellation of trade mark registration due to the fact that the trade mark owner was absent and so no evidences of use were presented



## Plus Warenhandelsgesellschaft mbH vs. LLC Tsentr torgovyh marok (Centre of trade marks) (May 2009)

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Plus Warenhandelsgesellschaft mbH filed non-use cancellation action against ФАМИЛИЯ (FAMILIYA) (in Cyrillic) trade mark registration № 232483 with respect to all goods and services covered by the registrations in classes 29, 30, 31, 42

As evidence of interest the applicant provided the following documents:

- Materials on "Famili" International Registration № 857001;
- Refusal of the Rospatent for the certain goods of classes 29 and 30



Rospatent determined the **interest** of the applicant is only with respect to the part of goods of classes 29 and 30 and made a respective decision of partial cancellation of trade mark registration due to the fact that the trade mark owner was absent and so no evidences of use were presented

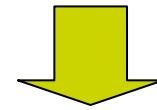
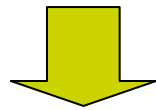
ФАМИЛИЯ

FAMILI

# Chamber's discretion

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The question of whether the party filing a non-use cancellation action has an interest is considered by the Chamber in each particular hearing before the evidence of **use** is reviewed



A practical need to provide a substantial scope of evidence and argument as well as participate in a challenging discussion before the Chamber

# Gruppo Lepetit S.r.l. vs. CJSC Bryntsalov-A (May 2009)

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Gruppo Lepetit filed a non-use cancellation request against RIFA-BRYTSIN (in Cyrillic) trade mark registration No. 211191 with respect to all goods and services covered by the registration (classes 5, 16, 35, 39 and 42)



As evidence of interest the applicant has provided the following documents:

- copies of the Russian trade mark certificates for RIFAFOUR (in Latin and Cyrillic);
- copies of the trade mark certificates for RIFAFOUR in other countries;
- advertising materials containing the RIFAFOUR trade mark;

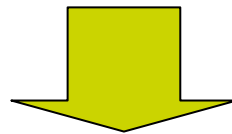
**РИФА-БРИЦИН**

**RIFAFOUR**

# Groupppo Lepetit vs. CJSC Bryntsalov-A (continue)

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- information on the applicant's goods produced under the RIFAFOUR trade mark;
- the decision of Rospatent on the refused in registration of the RIFA4 designation based on the similarity with the RIFA-BRYTSIN trade mark



Rospatent ruled that the **interest** of the applicant with respect to the goods of class 5 was present and made a decision of partial cancellation of trade mark registration for the goods of class 5 as no evidence for other classes has been provided



# Legal interest: the type of evidence to be provided

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## **Proof of the similarity of goods / services of the applicant:**

- distributorship or partnership agreements;
- assignment or license agreements;
- marketing / advertising materials;
- samples of goods;
- invoices;
- customs documents;
- other materials, showing the presence of goods / services on the Russian market

## **Proof of the intention of use of identical / similar trade marks:**

- presence of international trade mark registrations;
- presence of national trade mark applications / trade mark registrations in other countries;
- presence of Russian trade mark application (as additional evidence)

# In a nutshell

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## **BEFORE**

- Five-/ three-years term applied
- No use under control was allowed
- No legal interest to be proven

## **NOW**

- General three-years term applies
- Use under control is allowed but has to be proven
- Legal interest has to be proven



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Thank you!  
Questions?

# Used materials

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Used photographic images and images were taking from public sources of the Internet:

<http://www.tricosew.com/catalog/product99.html>

<http://www.joband.ru/img/trudogolik.jpg>

[http://prv-2008-03.photosight.ru/26/pv\\_2609898.jpg](http://prv-2008-03.photosight.ru/26/pv_2609898.jpg)

<http://fashion.artyx.ru/books/item/f00/s00/z0000000/pic/000561.jpg>

<http://blog.yurist-online.com/uploads/sudya.jpg>

<http://www.natulrich.com/ru/lessons/articles19pic/1.jpg>

<http://www.schwimmerlegal.com/wahaha.jpg>

<http://www.clipart.net.ua/images/clip2250.jpg>

<http://www.carsandracingstuff.com/library/special/dhl05.jpg>

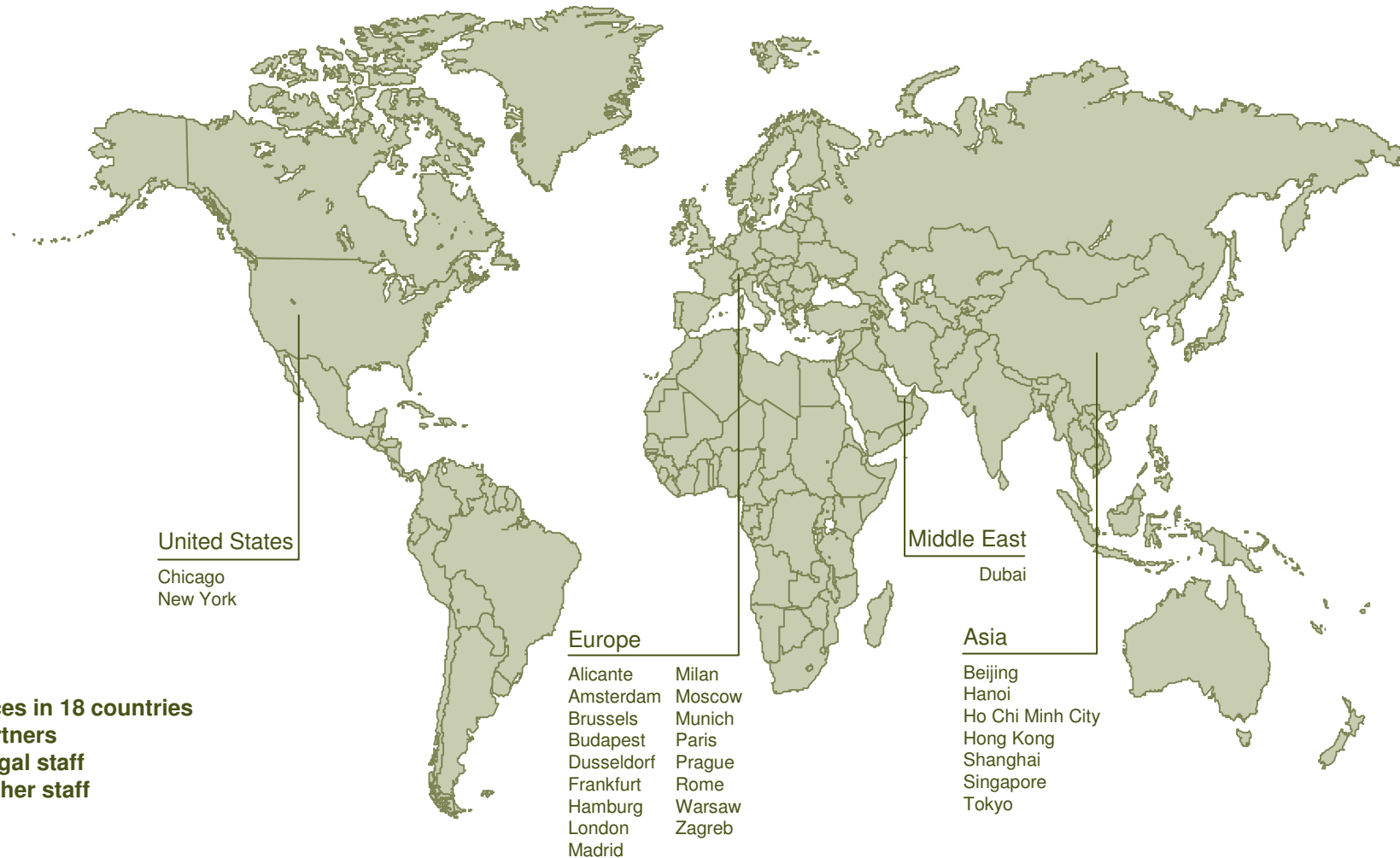
[http://www.zastavki.com/pictures/1024x768/2008/3D-graphics\\_Wheels\\_pills\\_drugs\\_007002\\_.jpg](http://www.zastavki.com/pictures/1024x768/2008/3D-graphics_Wheels_pills_drugs_007002_.jpg)

<http://i020.radikal.ru/0711/2d/1c815e847688.jpg>

[http://www.vip-wellness.ru/Hipp/index.html?&id\\_struct=37](http://www.vip-wellness.ru/Hipp/index.html?&id_struct=37)

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