

WELL-KNOWN TRADEMARKS: JUST A DREAM IN RUSSIA?

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It may be difficult to believe that there are only 112 trademarks recognised as well-known in Russia when, at the same time, there are almost 400,000 valid trademarks registered at the patent office and more than 143 million consumers in the Russian market. There may be different reasons for this low number but at least this proves the strictness of the registration process at the patent office.

Indeed, one of the most challenging tasks for trademark owners is the process for obtaining well-known status for a trademark in Russia. The reason for this is not legislative but, rather, political. Russia has had proper international and national regulations for the matter since July 1, 1965, when Russia became a member of the Paris Convention, but the lack until the beginning of 1998 of a competent authority to handle these cases simply made the process impossible. The 1998 appointment of the Higher Patent Chamber made the registration process possible, but still far from easy.

Tough requirements and strict process

The requirements and regulations for registering a trademark as well-known are pretty simple and clear. However, the problem is that there are far too many requirements to fulfil before getting even close to registration.

The most important step in the process is to determine the date from which the trademark can be considered to have been well-known. To prove the date and intensive use of the mark different kinds of documentation are required, namely (i) a list of places at which the goods have been sold; (ii) the volume of goods sold; (iii) the ways in which the mark has been used; (iv) annual advertising costs; (v) annual average number of consumers; (vi) an estimate of the value of the trademark; (vii) a list of countries in which the mark has become well-known; and (viii) the results of a consumer poll.

The results of the consumer poll are the most relevant documentation for the process. The poll even has its own set of rules, which require that the poll must be conducted by a specialised independent organisation. Further, the poll must be conducted in no fewer than six of Russia's largest cities, preferably including Moscow and St Petersburg. It is worth noting also that the consumer poll is not optional but is a required step in the process.

After collecting the required documentation and paying a lot of money (thousands of US dollars) for the consumer poll, the applicant can only cross his fingers and hope for the best. After filing the application the registration process is straightforward—the application is either accepted or refused.

If the application is rejected the patent office will consider no further evidence. A new application can be filed but the process does not allow the applicant to change the date from which the well-known status is requested. This means that the application should be well prepared before filing it at the patent office.

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The lucky ones

The statistics are excellent proof of the strictness of the process. According to the records of the patent office, 24 well-known applications were filed at the patent office in 2010; 14 of them were accepted and 10 rejected. The same figures in 2009 were 16 applications, from which nine were accepted and seven rejected.

Although the requirements are the same for Russian and foreign applicants it seems that the process is even harder for foreigners. Out of 112 well-known marks, 80 are registered in the name of locals (73 percent). This may be explained by the fact that it might be easier for locals to prove the strict use requirements.

However, some lucky ones have succeeded in the process. The first registered well-known trademark is the newspaper *Izvestiya*, registered on April 7, 2000, and recognised as well-known since December 31, 1992. Coca-Cola was the first of the foreigner trademarks. It was registered on December 18, 2001 and has been well-known since January 1, 1996. The most recent well-known trademarks are Reebok, Adidas, Husqvarna and Disney. Lipton, Maggi, Nike, Heineken, Bridgestone, Absolut, Smirnoff, Intel and Cartier are also recognised as well-known.

Despite the difficult process, companies should not give up trying. It requires time, work, money and a bit of luck but after succeeding you will feel like a real winner. ■

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