

Trademark Coexistence and its Effects on Rights in Russia

**Marina Grineva
EUROMARKPAT**

**FICPI
St Petersburg 2016**

OVERVIEW



- Introduction
- Letters of consent
- Coexistence / Settlement Agreements:
 - Core obligations
 - Additional provisions
 - Coexistence in different countries

INTRODUCTION



DISPUTE SETTLEMENT

- Prior to market entry
- At the time the trademark is examined at the PTO
- During cancellation proceedings at the PTO
- In court proceedings

INTRODUCTION



STATISTICS ON SETTLEMENTS

- **ROSPATENT** – no statistical data available
- **IP Court** - about 15% of claims result in settlement agreements

INTRODUCTION

- **FACTORS TO BE TAKEN INTO ACCOUNT FOR COEXISTENCE OR SETTLEMENT AGREEMENTS**

- Who owns earlier rights
- Trademark in question
- List of goods / services in question
- Countries, except Russia, where trademark is registered
- Whether the mark is used in Russia or not
- Future business expansion (additional territorial coverage)
- Plans to register similar marks in the future in Russia
- Possible dilution of the senior mark

LETTERS OF CONSENT



- Rospatent examines trademarks on both absolute and relative grounds

Para.6 Art.1483 of the Russian Civil Code allows for consent from the owner of senior rights to overcome refusal of registration

LETTERS OF CONSENT



MAIN REQUIREMENTS

- Image of the trademark (a mere application number is not enough !)
- Indication of the list of goods/services
- Indication that the consent is irrevocable
- Original document must be provided, notarization or legalization is not required
- Russian translation

LETTERS OF CONSENT



Letters of consent are not accepted

- For identical marks (marks in Latin and Cyrillic are considered similar)
- If the registration obtained on the basis of the letter of consent can mislead consumers (to be determined by the examiner = an area of uncertainty)
- Pharmaceuticals (potential difficulties)

COEXISTENCE AGREEMENTS / SETTLEMENT AGREEMENTS



THE CORE OBLIGATIONS OF THE OWNER OF SENIOR RIGHTS

- **Withdrawal of cancellation action / claim**
- **Obligation to issue a letter of consent**
- **Refrain from attacking the younger mark if the owner of the younger mark complies with specific obligations stipulated by the agreement (limit list of goods, limit use to certain countries, etc.)**

COEXISTENCE AGREEMENT / SETTLEMENT AGREEMENT



THE CORE OBLIGATIONS OF THE OWNER OF THE YOUNGER MARK

- **Recognition of prior rights**
- **Obligation to discontinue the infringement**
- **Refrain from attacking the earlier mark**

COEXISTENCE AGREEMENTS / SETTLEMENT AGREEMENTS



SETTLEMENT AGREEMENT IN COURT PROCEEDINGS

- **Can be approved at any stage of the judicial proceedings**
- **Can contain any additional provisions**
- **Court reviews the proposed terms and conditions of the agreement for legal compliance and potential infringement of the rights of other parties**

COEXISTENCE AGREEMENTS / SETTLEMENT AGREEMENTS



SETTLEMENT AGREEMENT IN COURT PROCEEDINGS MUST INCLUDE

- 1. The obligations of the claimant and defendant approved by the parties**
- 2. The procedure for fulfilling the provisions of the agreement**
- 3. The allocation of expenses agreed upon (monetary compensation / each party bears its own expenses)**

COEXISTENCE AGREEMENTS / SETTLEMENT AGREEMENTS



ADDITIONAL PROVISIONS

- **Limitation of the list of goods / services**
- **Obligation to assign the rights to a trademark**
- **Obligation to use the mark without any modification**
- **Obligation to issue mutual letters of consent**
- **Entering into additional agreements**
- **Geographical coverage of the agreement**
- **Applicability of the contractual provisions to assignees and affiliates**
- **Governing law**
- **Prevailing language for bilateral agreements**
- **Confidentiality provisions**

COEXISTENCE AGREEMENTS / SETTLEMENT AGREEMENTS



Coexistence in other countries

≠

**Possibility of trademark
registration in Russia**

**Thank you very much for
your attention !**

**Marina Grineva
Patent Attorney**

EUROMARKPAT

**Spartakovskiy Pereulok, 2,
Build. 1, Section 1
105082 Moscow, Russia**

Tel. +7 495 627 54 30

Fax +7 495 627 54 40

mgrineva@euromarkpat.com