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Russian update: Supreme Court criticized Customs' approach to keeping its IP register

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Russian law provides an effective instrument for preventing and detecting import of counterfeit goods and parallel import – the Customs Register of Intellectual Property (“**Customs IP Register**”). The Customs IP Register is kept by the Russian Federal Customs Service (“**Customs**”). According to the official information, at the beginning of 2020 there are more than 3200 intellectual property objects (mostly, trademarks) included in the Customs IP Register.

It can be useful against the counterfeit goods and parallel import of original goods as well, as all goods marked with trademarks and included in the Customs IP Register are subject to the control on the customs border of Russia. Unless an importer is indicated in the Customs IP Register as an authorized importer by a right holder, illegally imported goods are suspended at the customs border and Customs shall notify a right holder on the suspension of goods.

In order to include a trademark in the Customs IP Register, the right holder shall submit an application to Customs with regard to each trademark and provide Customs with detailed information, which includes, *inter alia*, a description of the original goods as well as a description of counterfeit goods.

In this regard, Customs frequently requests right holders not only to indicate the distinctive features of counterfeit goods but also to provide evidence of existing trademark infringement.

In practice, when the right holder failed to provide required information about trademark infringements in Russia, Customs refuses to include the trademark in the Customs IP Register. Such a situation has been widely criticized by Russian IP practitioners.

On January 22, 2020, the Russian Supreme Court passed a ruling in case No. A40-241863/2018, which cancelled the decision of lower court confirming Customs' approach.

The Russian company Trivium-XXI decided to include its trademark “Trivium” (No. 465837) in the Customs IP Register. However, the Customs refused to include the

trademark based on the lack of information about the goods with illegal use of trademarks imported to Russia.

The company sought to challenge the decision in courts. The courts of the first, appeal and cassation instances did not find any violation in the decision of the Customs. Russian courts justified the Customs' decision by the obligation of right holders to provide the Customs with the information about the infringing goods.

In the meantime, the Supreme Court reversed the decisions of lower courts and remitted the case for a new examination.

The Supreme Court made a precedential ruling and held that in order to include a trademark in the Customs IP Register it is required to provide Customs with information about the counterfeit goods in the declarative form (i.e. detailed description of such goods, customs codes, places of possible import of infringing goods), but Russian law does not establish the obligation to prove earlier trademark infringements. The Supreme Court pointed out that any other interpretation would contradict the prevention function of the Customs IP Register and makes the Customs IP Register ineffective for purposes of detecting and terminating trademark infringements.

Overall, the decision of the Supreme Court seems to establish a balanced approach towards the necessary information for inclusion of a trademark in the Customs IP Register.

Currently, right holders may have more chances for successful inclusion of their trademarks, inter alia, recently registered trademarks, in the Customs IP Register.

We believe that the recent clarification of the Supreme Court will bring a positive impulse for the Customs IP Register and the controversial practice of Customs will be left in the past. It will hopefully allow brand owners to use Customs more effectively to restrict movement of counterfeit goods in and out of Russia, without first carrying out detailed investigations or having had proven infringement problems.

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