

Kluwer Trademark Blog

Raffaello case: landmark case on registration of well-known trademarks in Russia

Ilya Khodakov, Vera Glonina (ALRUD Law Firm) · Monday, July 27th, 2020

Obtaining the status of a well-known trademark in Russia enables a right holder to prohibit any third parties from the unauthorized use of similar marks for whatever goods and services without any time limitations and makes them free from payments of renewal fees.

However, although a brand could be very popular among Russian customers and there could be strong evidence of significant marketing expenditures and intensive use, there are many peculiarities in registering of the well-known trademark in Russia.

In particular, the Russian Patent Office (“**Rospatent**”) has elaborated the following controversial criteria with regards to the registration of the well-known trademarks:

- *Obligatory consumer awareness of the applicant.* This means that the use of the claimed designation by other legal entities (not the applicant himself) is not recognized as the use of the designation by the applicant.
- *No rebranding during the period under consideration.* In other words, the use of the claimed designation with variations in design (e.g. the change of color or font) is not recognized as evidence of use of the claimed designation.

Both of these criteria were applied by Rospatent in the Raffaello case regarding registration of this very popular brand of sweets as a well-known trademark in Russia.

Specifically, the right holder of several “Raffaello” trademarks in Russia, Belgian company Soremartec S.A., filed with Rospatent an application to consider the designation “Raffaello” as a well-known trademark for sweets (30 class of Nice classification).

The company provided Rospatent with a significant amount of evidence of the intensive use and distinctiveness of the designation “Raffaello”, including mass media reports, advertisements, data on sales volumes and public surveys. Particularly, according to the public survey, 98% of respondents are aware of the designation “Raffaello”.

However, Rospatent refused to register “Raffaello” as a well-known trademark stating the following:

- There is no evidence that consumers associate designation “Raffaello” with the applicant, Soremartec S.A. (i.e. the provided materials prove only that consumers associate brand

“Raffaello” with the Russian licensee of Soremartec S.A., Ferrero Russia). Moreover, both the name of the applicant and its licensee in Russia had changed several times.

- The designation “Raffaello” was used in different variations during the period under consideration (e.g. product packages, the font and prints with the use of the “Raffaello” designations were changed during the claimed period of the use of the designation “Raffaello”).

In the meantime, the applicant disagreed with the refusal of Rospatent and filed a claim to the Intellectual Property Court (“**IP Court**”).

Specifically, the applicant stated the following:

- The Applicant is one of the companies of Ferrero Group and there is evidence that consumers attribute the designation “Raffaello” with Ferrero Russia and Ferrero Group, clearly distinguishing “Raffaello” from other brands (i.e. competitors of Ferrero Group).
- The changes of the graphic designation “Raffaello” during the period under consideration do not affect the consumers’ awareness of the brand “Raffaello” and its association with the specific goods. Moreover, the applicant provided evidence that for the last ten years the design of the designation “Raffaello” had not changed.

The IP court agreed with these arguments and obliged Rospatent to register the designation “Raffaello” as a well-known trademark in Russia. However, Rospatent decided to appeal this decision in the Supreme Court of Russia. However, in May 2020 Rospatent withdrew its appeal.

On June 18th, 2020, Rospatent agreed to register “Raffaello” as a well-known trademark.

The importance of this Raffaello case is that the restrictive approach of Rospatent towards the registration of well-known trademark has been successfully reversed.

Moreover, after this case similar argumentation was successfully used in cases concerning the marks “Avito” and “Doshirak”. In both cases, foreign companies managed to prove the well-known nature of their brands despite the lack of evidence of consumer awareness of the applicant (not the designation, but the company) and the presence of certain changes in design of the trademark.

Overall, it seems like, from now on, brands have a better chance of achieving the status of a well-known trademark in Russia.

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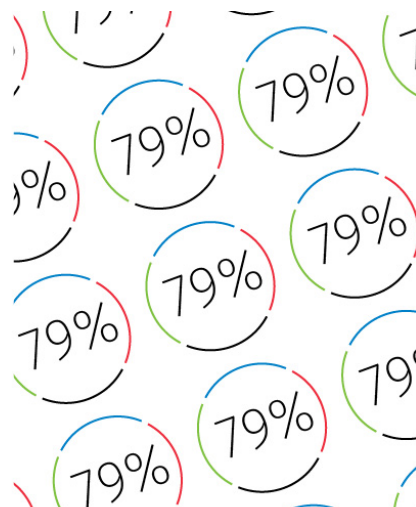
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