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REPORT

TRADEMARK REGULATIONS IN THE EUROPEAN UNION AND RUSSIAN FEDERATION. COMPARATIVE ANALYSIS

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ABSTRACT

Trademark regulations in the European Union and Russian Federation. Comparative analysis

Continental law (also known as Romano-Germanic law) is one of the most popular legal systems in the world. One of the most populous and influential jurisdictions in the world use either the mixed legal system (mainly Romano-Germanic law mixed with common law or customary law) or the pure variation of continental law. Civil (or continental) law is a dominant system in Russia, which is a great representative of this legal system, and in most domestic laws of European Union Member States, when the supranational European Union law is governed by a distinct set of institutions and processes[1]. European Union law has generally harmonized Intellectual Property law in the Union, while Russian Federation Intellectual Property law is mainly regulated by national law and international treaties. However, at the same time, the World Intellectual Property Organization has generally harmonized the basics of Intellectual Property law worldwide. Therefore, trademarks being an integral and more or less conventional part of any person's daily life developed many different rules and regulations in their own specific way around the globe. This paper provides a comparison of the trademark regulations between two major world political and economic powers, namely European Union and Russian Federation and it will consider possible means of aiding further development.

[1] Paolo Carozza. European Law. Foundations < https://www.britannica.com/topic/European-law > accessed on 25.03.2020.

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Trademark regulations in the European Union and Russian Federation. Comparative analysis

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Introduction

Specialized production and use of special information about the range of goods, works, services and their producers, which are intended for the consumer community, is one of the most important directions in the activities of economic entities, especially in a market economy. This area of activity of economic entities needs special tools and legal mechanisms that meet its specific requirements and can ensure the interests of all participants in the market process, including the state, entrepreneurs and consumers of products. The significant role of one of those special tools is performed by trademarks[1].

When covering the trademark topic, it is impossible not to mention its relevance to date, due to the increased attention towards the process of creating a trademark as a means of visual impact on the consumer[2]. Many companies are currently trying to develop their own trademark that provides them with a bright and well-remembered image on the market, but not all do it efficiently and professionally. After all, in order for a product to be really effective, its development must be approached very seriously and, above all, it must be taken into account how it will be perceived by the target audience, what emotions, associations it will cause, whether it will correspond to the main direction of the company's activity[3]. When buying a product, we always pay attention to the trademark. It is trademarks that allow consumers to navigate among a huge mass of homogeneous products from different manufacturers. In a market economy, in a competitive environment, a firm that produces high-quality products naturally wants the consumer to distinguish its products from the similar products of competitors[4]. This is one of the purposes of what trademarks are for. A trademark, being a kind of link between the manufacturer and the potential consumer, serves as an active means of attracting the attention of buyers to the marketed goods and allows consumers to choose the

[1] Zharova Anna Konstantinovna. Intellectual property protection. 4th edition (2018). "Urait" Publishing house. p.164 [in Russian] (Жарова Анна Константиновна. Защита интеллектуальной собственности. 4-е изд. (2018). Издательство «Юрайт». стр. 164.

[2] Xiuwen Feng. On Aesthetic and Cultural Issues in Pragmatic Translation. Based on the Translation of Brand Names. Shanghai Jiao Tong University Press (2017). Chapter 2, section 1.

[3] Colin Mitchell. Selling the Brand Inside. January 2002 Issue. Issue of Harvard Business Review. Can be found on: <https://hbr.org/2002/01/selling-the-brand-inside> accessed on 22.04.2020.

[4] Understanding Industrial Property.WIPO,2016.p.18 Can be found on: < https://www.wipo.int/edocs/pubdocs/en/wipo_pub_895_2016.pdf> accessed on 22.04.2020.

products they need from a certain manufacturer[5]. A trademark is the face of a company, a visual representation of its activity, status, mission, spirit, and in many ways determines the initial attitude of consumers to it[6]. The trademark intends to emphasize the individuality of the company, to form its favorable image, to promote the growth of the company's reputation and popularity in the market, to enhance the effectiveness of advertising contacts with the audience, and to inspire confidence in partners[7]. The image that marks have is very important, since they must carry information about the product, the company and its profile[8]. One brand can own one or a whole family of products. Since the more business expands and improves, so does the value of the brand[9]. Business begins to use their trademarks in advertising, on product packaging, and when dealing with customers. Therefore, owning a trademark is urgent for every company. After all, it helps the manufacturer themselves to distinguish their product from the mass of homogeneous ones, to contrast it with the products of competitors, and the customer to find their product among others and buy it. Therefore, the trademark actively plays the role of the seller and brings the company profit[10].

The aim of this paper is to analyze the trademark regulations in the European Union and Russian Federation by comparing approaches of their respective legislations. Structurally, the paper consists of the history of trademark law in European Union and Russian Federation. The European Union, as a political and economic phenomenon, has a very interesting historical background of trademark law development, as well as Russia, which also has quite a rich history of this legal sphere. The next part of the paper will concern the economic aspects of trademarks, following by the concept of "trademark" and its use and functions in the European Union, as well as in the Russian Federation. In the end, the regulations concerning trademark protection will be analyzed and the conclusion will be drawn.

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[5] Zaichkowsky J.L. The Psychology Behind Trademark Infringement and Counterfeiting. Published by Routledge. (2016) Ch.4.Competing products.

[6] Sergeev V. M. Examination of trademarks L., LSU publishing house (1981). p. 10. [in Russian] (Сергеев В.М. Экспертиза товарных знаков Л., Издательство ЛГУ (1981). стр 10.)

[7] Lebringer Otto. Corporate Communication: An International and Management Perspective. Published by John Wiley & Sons (2019). p. 204.

[8] Duane E. Knapp. The Brand Mindset: Five Essential Strategies for Building Brand Advantage Throughout Your Company. McGraw-Hill (1999). p. 15.

[9] Louis E. Boone and David L. Kurtz. Contemporary Marketing. Cengage Learning; 14th edition (2009). pp. 381-382.

[10] Tesakova Natalia,Tesakov Vladimir.Brand and trademark. Russian blave. Publisheb by "Izdatelskoye resheniye" 2 nd edition (2018). pp 110-111 [in Russian] (Тесакова Наталия, Тесаков Владимир. Бренд и товарная марка. Развод по-русски. Издательство «Издательское решение». 2-е издание (2018). стр. 110-111).

1. The modern system and history of the trademark law in the European Union and the Russian Federation

Today's trademark law in the European Union is based on the coexistence of national trademarks and European Union trademarks[11]. This interplay has created several approaches for the trademark protection in the European Union. The first approach is the traditional approach or the national level registration, it allows the trademark owner to protect their exclusive rights on the mark only on the territory of one state. Trademark should be applied for each state where protection is needed in this case. If one wants to register their trademark in a foreign country as a national mark, an application for registration of their trademark should be filed with the trademark office of the relevant country. That means that the trademark will be protected on the territory of this particular country or union of countries, such as, for instance, the Benelux Office for Intellectual Property. Via the Benelux Office for Intellectual Property, one may register their trademark and trade in Belgium, the Netherlands and Luxembourg, this way assuring protection in all three countries[12]. This way of registration is complicated due to some possible problems, such as the language barrier, different processing norms of the offices and a requirement to employ a local representative for the communication with the national offices of some countries[13]. However, it might be beneficial at one point if one wants to register the trademark in a particular country and has no intention of trading abroad. Sometimes, the national registration may be the most rational way for registration, for example if protection is only needed in one neighboring country, or if there is a need to adjust your trademark according to the local market. For example, registration of a trademark in Cyrillic characters in the

[11] Rafał Mańko. Trademark law in the European Union Current legal framework and proposals for reform. Library Briefing. (2013) 130592REV2. pp.1-2. Can be found on: < https://www.europarl.europa.eu/RegData/bibliotheque/briefing/2013/130592/LDM_BRI(2013)130592_REV2_EN.pdf> accessed on 23.04.2020.

[12] Commission staff working paper impact assessment accompanying document to the Proposal for a Regulation of the European Parliament and of the Council amending Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark and the Proposal for a Directive of the European Parliament and of he Council to approximate the laws of the Member States relating to trade marks (recast) [2009] Document 52013SC0095. 1.1. (a). Can be found on: < https://eur-lex.europa.eu/legal-content/SL/TXT/?uri=CELEX%3A52013SC0095> accessed on 23.04.2020.

[13] U.S. Department of Commerce. Commerce today. (Journal, Magazine; April 1971). Publisher: Washington, D.C.: U.S. Dept. of Commerce, 1970-1975. p. 5.

European Union may be necessary for some particular products only in the Republic of Bulgaria.

"*The Bulgarian Law on Marks and GIs does not require the filing of trademarks in Cyrillic. The only requirement concerning inscription of names of products in Cyrillic is with regard to pharmaceuticals, in accordance with the Bulgarian Drug Agency, before which drugs distributed for the territory of Bulgaria shall be registered, the names of the same has to be also registered in Cyrillic. Therefore, trademark owners usually register TM under one word application including the Cyrillic transliteration for example AULIN/АУЛИН*"[14].

The second approach is created for international protection including members of the European Union. One can register their trademark with the World Intellectual Property Organization (WIPO)[15]. All European Union Member States have acceded to the international treaties[16], such as Madrid Agreement [1891][17] and Madrid Protocol [1989][18], enabling international registration of a trademark by a single application in many different countries all over the world. The Madrid system is administered by the WIPO and is located in Geneva, Switzerland. The Madrid system provides an opportunity to protect one's trademark in several countries by filing one application via the office of one's country of residence. This office is usually referred to as the office of origin[19]. The protection of the mark in each of the countries is the same as if the mark had been registered directly with the office of that country[20]. Later management of the registration gets easier, because it is possible to make changes or renew the registration, using one procedure in all countries where the mark has acquired legal protection[21]. Protection can

[14] Elena Miller. Bulgaria/Europe - trademark practice-trademarks in Cyrillic. page 2. Can be found on:<https://ficpi.org/_/uploads/files/4.2_Outline_of_Presentation_Elena_Miller_18_08_2016.pdf> accessed on 25.02.2020.

[15] Who can use the Madrid System? < https://www.wipo.int/madrid/en/> accessed on 25.04.2020

[16] Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks. Status on January 15, 2020 <https://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf> accessed on 25.04.2020.

[17] Madrid agreement concerning the international registration of marks April 14, 1891. Can be found on < https://www.wipo.int/edocs/lexdocs/treaties/en/madrid-gp/trt_madrid_gp_001en.pdf> accessed on 23.04.2020.

[18] Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks Adopted at Madrid on June 27, 1989 < https://www.wipo.int/edocs/lexdocs/treaties/en/madridp-gp/trt_madridp_gp_004en.pdf> accessed on 23.04.2020.

[19] Madrid agreement concerning the international registration of marks April 14, 1891. Article 1 (2). Can be found on < https://www.wipo.int/edocs/lexdocs/treaties/en/madrid-gp/trt_madrid_gp_001en.pdf > accessed on 16.04.2020

[20] Ibid. Art 15 (5).

[21] How to Manage your International Registration <https://www.wipo.int/madrid/en/how_to/manage/renewal.html > accessed on 16.04.2020.

be acquired in new countries by their subsequent designation[22]. The application usually has to be filed with the WIPO via the Office of origin – National Patent Office or European Union Intellectual Property Office[23]. In order to do that, it is necessary to have an application or a registration of the same trademark (the basic application or registration) in the Office of origin[24]. The main disadvantage of the international registration is so-called "central attack". Accordingly, if the home filing is abandoned or cancelled during this dependency period, the international registration will also be automatically cancelled[25]. At the same time, it is possible to 'transform' the designations of a centrally attacked international registration back to national applications; however, this will eliminate all the cost savings made by using the system[26]. In addition, trademark offices of Madrid Protocol member countries benefit from the international registration. Firstly, trademark offices do not need to examine for compliance with formal requirements. Secondly, they do not need to classify the goods or services or publish the marks. Thirdly, they are compensated for the procedures that they take. Compensation occurs as follows : *"the individual fees collected by the International Bureau are transferred to the Contracting Parties in respect of which they have been paid, while the complementary and supplementary fees are distributed annually among the Contracting Parties not receiving individual fees, in proportion of the number of designations made of each of them"*[27]. Moreover, a single international registration is equivalent to a bundle of national registrations[28]. Although, it is a single registration, protection may be refused by some or all intellectual property offices of the designated countries[29].

[22] Guide to the international registration of marks under the Madrid agreement and the Madrid protocol (updated 2018) provision 02.11 < https://www.wipo.int/edocs/pubdocs/en/wipo_pub_455_2018.pdf > accessed on 16.04.2020

[23] Apply for an International Application. < https://euipo.europa.eu/ohimportal/apply-for-an-international-application> accessed on 16.04.2020.

[24] Monitor your International Application and Registration < https://www.wipo.int/madrid/en/how_to/monitor/process.html> accessed on 16.04.2020.

[25] Przygoda, Agniezka. (2019). The International Registration of Trade Marks under the Madrid System: Advantages and Disadvantages. Eastern European Journal of Transnational Relations. 3. 67-79. 10.15290/eejtr.2019.03.01.05. p. 73.

[26] WIPO Guide to the international registration of marks B.II.95 § 84.03. Can be found on < https://www.wipo.int/edocs/pubdocs/en/wipo_pub_455_2018.pdf> accessed on 16.04.2020.

[27] The Madrid Agreement Concerning the International Registration of Marks. Objectives, Main Features, Advantages. Can be found on: <https://www.wipo.int/edocs/pubdocs/en/wipo_pub_418_2016.pdf > accessed on 16.04.2020. p. 12.

[28] Ibid. p. 3.

[29] Ibid.p. 8.

The third approach is the protection of the trademark via the European Union trademark system. With the filing of a single application, the European Union trademark system offers trademark owners a unitary protection throughout the Union[30]. Legal protection will be valid in all Member States of the European Union[31]. In case of the extension of the European Union, legal protection of the trademark extends automatically to the new Member States[32]. One can file their European Union trademark application with the European Union Intellectual Property Office located in Alicante, Spain[33].

"*An EU trade mark shall have a unitary character. It shall have equal effect throughout the Union: it shall not be registered, transferred or surrendered or be the subject of a decision revoking the rights of the proprietor or declaring it invalid, nor shall its use be prohibited, save in respect of the whole Union*"[34]. All rights valid earlier in the Member States are considered as prior rights, including earlier national trademarks, the owners of which can contest registration of the European Union trademark[35]. Although, for a natural or legal persons having their domicile or their principal place of business or a real and effective industrial or commercial establishment in the European Economic Area may be represented before the European Union Intellectual Property Office by an employee[36]. In addition, an employee of such a legal person may also represent other legal persons which have economic connections with the first legal person, even if those other legal persons have neither their domicile nor their principal place of

[30] Trade mark protection in the EU - Internal Market, Industry, Entrepreneurship and SMEs - European Commission < https://ec.europa.eu/growth/industry/policy/intellectual-property/trade-mark-protection_en> accessed on 16.04.2020.

[31] International Trademark Rights < http://www.inta.org/TrademarkBasics/FactSheets/Pages/InternationalTrademarkRightsFactSheet.aspx> accessed on 16.04.2020.

[32] Guidelines for Examination in the Office, Part A, General Rules Section 9 Enlargement. 2.1. Can be found on < https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/trade_marks_practice_manual/WP_2_2017/Part-A/09-part_a_general_rules_section_9_enlargement/part_a_general_rules_section_9_enlargement_en.pdf> accessed on 16.04.2020.

[33] Regulation (EU) 2017/1001 of 14 June 2017on the European Union trade mark [2017] OJ L 154/1.Article 30 < https://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:32017R1001&from=EN> accessed on 16.04.2020.

[34] Ibid. Art. 1 (2).

[35] Ibid. Art. 138.

[36] Ibid. Art. 119 (3).

business nor a real and effective industrial or commercial establishment within the European Union[37].

There are in general plenty of benefits for the person who wants to trade on the territory of the European Union. Firstly, a single request for renewal may be submitted for two or more marks, upon payment of the required fees for each of the marks, provided that the proprietors or the representatives are the same in each case[38]. Secondly, the basic registration part of the European Trademark is independent of the national trademark, in comparison with WIPO, where the mark remains dependent on the basic registration of the trademark in the office of origin for a period of five years[39]. Under the Madrid Protocol 1989, there is an increased risk for the trademark holder who chooses to base his international registration on an application with the Office of origin[40]. The protection can cease to have effect as a result of the basic application. The disadvantages of the European Union trademark are not too significant to be highlighted. However, "*An EUTM is "unitary" in nature. Therefore, if another trademark proprietor has a national right in an EU country, they may be able to attack your EUTM in its entirety. However, in such circumstances, it is possible to "convert" your application to national trade mark applications in those countries where the prior right does not exist*." [41], and "*EUTMs may be opposed in the same way as national applications, and there is a larger pool of potential opponents. Such parties may consider your trademark to be similar to their own under their usual rules of comparison, which may be different from those of the UK*."[42] Concerning United Kingdom, the European Intellectual Property Office states the following : "*In accordance with the Withdrawal Agreement concluded between the EU and the UK , the UK left the EU on 1 February 2020. However, the Withdrawal Agreement stipulates that during a transition period that will last until 31 December 2020, EU law remains applicable to and in the UK. This extends to the EUTM and RCD Regulations and their implementing instruments.*

[37] T-512/15 - Sun Cali v EUIPO - Abercrombie & Fitch Europe (SUN CALI).§ 21. Can be found on < http://curia.europa.eu/juris/document/document.jsf?docid=183685&doclang=en> 16.04.2020.
[38] Regulation (EU) 2017/1001 of 14 June 2017on the European Union trade mark [2017] OJ L 154/1. Art. 53 (9). Can be found on: < https://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:32017R1001&from=EN> accessed on 16.04.2020.
[39] Lally Ramage. Intellectual Property Law for Designers. iUniverse, Inc. 2008 copyright by Sally Ramage pp.85
[40] Guide to the international registration of marks under the Madrid agreement and the Madrid protocol. B.II.2. can be found on: < https://www.wipo.int/edocs/pubdocs/en/wipo_pub_455_2018.pdf> accessed on 25.04.2020
[41]Rachael Ward. Pros and Cons of EU Trade Mark Registration. Cons to consider. (01.31.2017) < https://www.wardtrademarks.com/pros-and-cons-of-eu-trade-mark-registration/> accessed on 25.02.2020.
[42] *Ibid.*

This continued application of the EUTM Regulations and the RCD Regulations during the transition period includes, in particular, all substantive and procedural provisions as well as the rules concerning representation in proceedings before the EUIPO.

In consequence, all proceedings before the Office that involve grounds of refusal pertaining to the territory of the UK, earlier rights originating from the UK, or parties/representatives domiciled in the UK will run as they did previously, until the end of the transition period"[43]. *That means, for now United Kingdom will be the part of the European Union trademark and Registered Community Design regulations.*

The history of the European Union trademark law is relatively new. The European Union trademark takes its roots back from the "Preliminary Draft Convention for a European trade mark" dating from 1964 (hereafter referred to as the 1964 Draft)[44]. However, the 1964 Draft was published later in 1973. The follow-up of its publication has been made in 1976, when the European Economic Community (EEC) Commission published a "Memorandum on the creation of an EEC trade mark"[45] (hereinafter 1967 Memorandum). The exact 1976 Memorandum fostered first towards the creation of a European Economic Community trademark and the European Union trademark in the future. Around the beginning of the 1980s in a very first reading a European Union Commission Proposal for a Community trademark system was approved by the European Parliament. However, after the amendment proposal in 1984 and after the proposal was sent to the European Parliament for a second reading, the Community Trade Mark Regulation (the CTMR (40/94/EEC) came into force with several amendments being made under the administration of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) and was codified by Council Regulation No. 207/2009[46]. The Community trademark system was quite popular and allowed the Community trademark proprietor to enjoy exclusive rights throughout the Member States. A Community

[43] Impact of the UK's withdrawal from the EU EUTMs and RCDs: updated information. <https://euipo.europa.eu/ohimportal/en/Brexit-q-and-a > accessed on 25.02.2020

[44] EEC Working Party on Trade Marks., & Great Britain. (1973). Proposed European trade mark: Unofficial translation of a preliminary draft of a Convention for a European Trade Mark. London: H.M.S.O.

[45]Memorandum on the creation of an EEC trade mark adopted by the Commission on 6 July 1976 Bulletin of the European Communities Supplement 8/76 [1976] SEC (76) 2462. Can be found < http://aei.pitt.edu/5363/1/5363.pdf> accessed on 25.02.2020.

[46]Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark [2009] OJ L 78/1 . Can be found on: < https://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:32009R0207&from=en> accessed on 26.04.2020.

trademark registration was enforceable in all Member States[47]. The first Community trademark registration was received in April 1996 and by the end of 1996, 46 700 trademark applications had been received[48].

An increase in the number of Community trademark system's trademark applications has occurred over a decade. For example, in 2001, the number of the CTM trademark applications was reported to be 49 606, whilst by 2014, the number of applications reached 117 464[49]. As the development and popularity of the Community trademark system has shown that a supra-national European Union law seemed to be welcome and may impulse for the future integration of trademark law. Nevertheless, in the early 2000s, some legal scholars noted the potential conflict between national trademark rights and the establishment of a common market without national frontiers and the system should have gone some way to address this[50].

The Office for Harmonisation in the Internal Market (OHIM) was one of six agencies set up under the 1993 Treaty on the European Union (Maastricht Treaty)[51]. With administrative and financial autonomy, the new agency had as its task the management of a new European Union-wide intellectual property right, the European Union trade mark (then known as the Community trade mark)[52], and it had heavily contributed to the further harmonization of the trademark law in the European Union. As it is declared by European Union Intellectual Property Office : "*The Office was starting from scratch. Everything – from computers to chairs – had to be sourced, purchased and made ready ahead of the all-important first filling date*."[53], that means the whole system was just built from scratch and the success was not far from being reached. Nevertheless,

[47] R. Mallinson 'Trade Marks in the EU: One Right, One Law, One Decision – or Not?' European Intellectual Property Review, 29, 2007, 432-7, p. 432.
[48] EUIPO – 25 years protecting innovation; 1996: first CTM registration received <https://euipo.europa.eu/ohimportal/sl/our-history> accessed on 26.02.2020.
[49] European Commission Annual report 2001 Luxembourg: Office for Official Publications of the European Communities 2002 — 58 pp. — 21 x 29.7 cm ISBN 92-9156-061-8; Office for Harmonisation in the Internal Market Annual Report 2014 Alicante, Spain ISBN 9789291561957. Can be found on: < https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_ohim/annual_report/ar2001_en.pdf> accessed on 26.02.2020.
[50] Tom Maniatis 'Arsenal & Davidoff: The Creative Disorder Stage', Marques Intellectual Property Law Review, 7,2003,99-148 p. 99.
[51] The EUIPO then and now – a timeline 1994 – 1998 The beginnings < https://euipo.europa.eu/ohimportal/sl/our-history> accessed on 26.02.2020.
[52] *Ibid*.
[53] *Ibid*.

in 2015, the long-awaited trademark reform package[54] was published and enforced in 2016. This wave of reforms was followed by a change of name for the Office. That means, the Office for Harmonization in the Internal Market became the European Union Intellectual Property Office.

As of March 23, 2016, the EU Trademark Regulation (EUTMR) entered into force to replace the old Community Trademark Regulation (CTMR). This completed the reform of European trademark law, which has been adapted to the changed circumstances and encompassed some other significant changes, including new terminology and a new fee structure. However, the above-mentioned Regulation has made it no longer possible to file applications via national Offices. Instead, applications were made possible to be filed only at the European Union Intellectual Property Office. New rules have spawned criticism such as *"[…] the changes might also create difficulties, especially in cases in which the final destination of the goods is not declared in the customs declaration. In this case, in practice, the trademark owner will not know whether or not it is entitled to have the customs authority detain the shipment. If it decides to have the shipment seized and start infringement procee-dings, it will run the risk that the shipper declares a country of destination in which the trademark is not protected. This might expose the trademark owner to the risk of liability towards the shipper*"[55]. However, in general, most legal scholars have agreed that *"[…] the new legislation includes some important changes and will modernize European Union trademark law*"[56].

Nowadays, the trademark law of the Russian Federation is based primarily on the traditional approach of the trademark registration at the national authority. Nevertheless, the Russian Federation is the member of the World Intellectual Property Organization since 1970[57]. The

[54] Regulation (EU) 2015/2424 of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) [2015] OJ L 341/21 . Can be found on: <https://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:32015R2424&from=EN> accessed on 26.04.2020.

[55] Ulrich Worm, Konstantin von Weber, Ana Elisa Bruder. The New European Union Trademark Regulation. New Challenges for Trademark Owners (June,2016) < https://www.mayerbrown.com/-/media/files/perspectives-events/publications/2016/06/the-new-european-union-trademark-regulation/files/get-the-full-report/fileattachment/160613-frk-ip-lu-trademark-regulation.pdf> accessed on 26.02.2020.

[56] Leighton Cassidy 'Major Reforms to EU Trade Marks Law'. Publication. 16.07.2015., can be found < https://www.fieldfisher.com/en/insights/major-reforms-to-eu-trade-marks-law > accessed on 26.02.2020.

[57] Country Profiles < https://www.wipo.int/directory/en/details.jsp?country_code=RU > accessed on 26.02.2020.

state became party to the Madrid Agreement in 1976[58] and to the Madrid Protocol [1989] in 1997[59]. Therefore, it is possible to register the trademark in Russia via both approaches, namely national registration and international registration via the World Intellectual Property Organization. Registration of a trademark and obtaining a trademark certificate can be done at the state service called Federal Service for Intellectual Property or simply another official name is 'Rospatent'[60]. Through the state registration of a trademark, service mark, collective mark, or a trademark mark is being recognized solely on the territory of Russian Federation[61]. One who wants to register for the national trademark should first get ready the specified list of documents, pay the fee for formal and substantive examination of the trademark and submit all the documents to Federal Service for Intellectual Property[62]. The documents can be submitted both via electronic filing and via non-electronic filing. Electronic filing can be submitted in two ways: via the Federal Service for Intellectual Property's official website and via the Unified portal of public services and functions. Non-electronic filings can be submitted either personally, via the post or via telefacsimile[63]. After the submission the state service takes time

[58] Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks. Status on January 15, 2020. Can be found on: <https://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf> accessed on 26.02.2020.

[59] *Ibid*.

[60] Order of the Ministry of economic development of the Russian Federation of August 27, 2015 N 602 "on approval of the Administrative regulations for the provision by the Federal service for intellectual property of the state service for the recognition of a trademark or designation used as a trademark as a well-known trademark in the Russian Federation" (with amendments and additions).10 [in Russian] (Приказ Министерства экономического развития РФ от 27 августа 2015 г. N 602 "Об утверждении Административного регламента предоставления Федеральной службой по интеллектуальной собственности государственной услуги по признанию товарного знака или используемого в качестве товарного знака обозначения общеизвестным в Российской Федерации товарным знаком" (с изменениями и дополнениями).10) Can be found on: https://base.garant.ru/71206912/ accessed on 17.04.2020.

[61] State registration of a trademark, service mark, or collective mark. [in Russian] (Государственная регистрация товарного знака, знака обслуживания, коллективного знака).
< https://rupto.ru/ru/stateservices/gosudarstvenanaya-registraciya-tovarnogo-znaka-znaka-obsluzhivaniya-kollektivnogo-znaka-i-vydacha-svidetelstv-na-tovarnyy-znak-znak-obsluzhivaniya-kollektivnyy-znak-ih-dublikatov> accessed on 26.02.2020.

[62] Order of the Ministry of economic development of the Russian Federation of August 27, 2015 N 602 "on approval of the Administrative regulations for the provision by the Federal service for intellectual property of the state service for the recognition of a trademark or designation used as a trademark as a well-known trademark in the Russian Federation" (with amendments and additions).107 [in Russian] (Приказ Министерства экономического развития РФ от 27 августа 2015 г. N 602 "Об утверждении Административного регламента предоставления Федеральной службой по интеллектуальной собственности государственной услуги по признанию товарного знака или используемого в качестве товарного знака обозначения общеизвестным в Российской Федерации товарным знаком" (с изменениями и дополнениями).17) Can be found on: https://base.garant.ru/71206912/ accessed on 17.04.2020.

[63] Guide on implementation of administrative procedures and actions within the framework of public service provision on state registration of a trademark, service mark, or collective mark their duplicates. Ch.1. p. 8.[in Russian]
(Руководство по осуществлению административных процедур и действий в рамках предоставления государственной услуги по государственной регистрации товарного знака, знака обслуживания,коллективного знака и выдаче свидетельств на товарный знак, знак обслуживания,

to check the whole package of documents. The state service may notify the applicant about the results of verification of compliance of the claimed designation with the requirements of the legislation of the Russian Federation. The notification is sent, if the results of procedure it is established that state registration of a trademark may not be fully implemented or the state registration of a trademark may be exercised in respect of only part of the goods contained in the list of goods submitted by the applicant[64]. In general, the result of the administrative procedure for examining the application on its merits and the procedure for transmitting the result: sending the applicant a decision on the state registration of a trademark and a document notifying of the fee to be paid for the registration of a trademark and issuing a certificate for it, and transmitting the application documents to the division that registers the trademark in the state register, publishing information about the registration of the trademark and issuing the certificate; sending the applicant a decision on the state registration of a trademark for a part of the goods and a document notifying of the fee to be paid for the registration of a trademark and issuing a certificate for it, and transmitting the application documents to the division that registers the trademark in the State register, publishing information about the registration of the trademark and issuing the certificate; sending the applicant a decision to refuse state registration of a trademark in respect of the entire list of goods; sending the applicant a decision to recognize the application as withdrawn with an explanation of the reasons for the decision; sending the applicant a decision to satisfy the application for recognition of the application as withdrawn[65]. After paying the last state fee, if the decision of the state service was affirmative, the applicant can receive their trademark certificate[66]. On the 23rd of October 2018, the Director General of Federal Service for Intellectual Property, Grigory Ivliev declared : *"[...] the number of applications for trademark registration in Russia for the first nine months of this year increased by 5.9% compared to the same period last year. At the same time, despite the increased volumes, the deadline for reviewing applications was reduced by 4 months*.", and highlighted *"The increase in the number of trademark applications is evidence of a developing market for goods and services, reflecting economic growth, and the needs of Russian businesses for new means*

коллективный знак, их дубликатов.) Гл.1. Can be found on: <https://rupto.ru/ru/documents/rucov-tz/download> accessed on 22.04.2020.

[64] *Ibid*. Ch. 2. p. 12.

[65] *Ibid*. Ch. 1-3.

[66]Get a trademark certificate. 5.[in Russian] (Получите свидетельство на товарный знак.5.) < https://rupto.ru/ru/stateservices/gosudarstvenanaya-registraciya-tovarnogo-znaka-znaka-obsluzhivaniya-kollektivnogo-znaka-i-vydacha-svidetelstv-na-tovarnyy-znak-znak-obsluzhivaniya-kollektivnyy-znak-ih-dublikatov> accessed on 26.02.2020.

of individualization to enter the market and strengthen their positions" Mr. Ivliev stated[67]. These statements can be further supported by the annual reports of the Federal Service for Intellectual Property. Thus, in 2018, 5.9% more applications were submitted than in 2017 (34,973 applications in 2018 and 33,018 in 2017). It is important to note that in relation to the same period in 2015, the overall increase in applications was 25.4%, according to the national procedure - 35.3%, and particularly from Russian applicants it has reached 44.7 %. This indicates the growth of the market for goods and services, which requires new means of individualization[68].

According to the World Intellectual Property Organization's Intellectual Property Statistics Data Center, in 2018 the most popular application filing was among trademarks (14.3 million)[69]. The same can be seen in total trademark applications (direct and via the Madrid system) in the Russian Federation. The increase in total application can be noticed in contrast to 2017 on 31%[70].

Russia has come a long way towards a modern trademark law system. The moment when trademark legislation appeared in Russia can be considered the adoption of the Government Decree on obligatory branding of all Russian goods with the special factory marks in 1754. According to this decree, the brand should be applied to all goods, and for the false brands, criminal sanctions were provided[71]. However, the more detailed and more complex decree was enforced in 1830, where the Senate of the Russian Empire describes the definition and the importance of the branding, the procedure for the imposition of brands (stamps) and their registration, and that forgery became a criminal offense. With this decree in 1830, the state introduced an official register, which was recording all Russian manufacturers who has

[67] The Agency notes a steady increase in domestic applications for all the IP objects (Роспатент отмечает уверенный рост отечественных заявок по всем объектам ИС) [in Russian] < https://rupto.ru/ru/rospatent-otmechaet-uverennyj-rost-otechestvennyh-zayavok-po-vsem-obektam-is> accessed on 26.02.2020.

[68] Annual official publication of the Federal service for intellectual property (Rospatent). The report contains statistical and analytical materials that reflect the results of the activities of Rospatent and its subordinate organizations in 2018. Moscow, 2019.Text, Rospatent, 2019 p. 142. Table 1.1 [in Russian] (Ежегодное официальное издание Федеральной службы по интеллектуальной собственности (Роспатент). Отчет содержит статистические и аналитические материалы, отражающие итоги деятельности Роспатента и подведомственных ему организаций в 2018 году. Москва, 2019.Текст, Роспатент, 2019 стр. 142. Таблица 1.1). Can be found on: < https://rupto.ru/ru/pdfdocuments/5#book/> accessed on 26.04.2020.

[69] Facts and Figures. Global IP filing activity in 2018 <https://www.wipo.int/edocs/infogdocs/en/ipfactsandfigures2018/> accessed on 26.02.2020.

[70] Intellectual Property Statistics < https://www.wipo.int/ipstats/IpsStatsResultvalue> accessed on 26.02.2020.

[71] Superanskaya A.V., Soboleva T. A. Trademarks, 2nd edition, corrected and supplemented by M. Librok, 2009, page 20. (Суперанская А.В., Соболева Т.А. Товарные знаки, 2-е издание, исправлено и дополнено М. Либроком, 2009 год, страница 20).

registered their brands in the Department of trade and manufactures of Russian Empire[72]. One of the most important pieces of legislation concerning trademark protection in Russia was when the "Regulation on trademarks" went into effect in 1974[73]. The regulation gave the clear definition of the trademark - which is still used in the modern Russian legislation - and provided the detailed description of the functions of the registration authority. In addition, the regulation gave the detailed explanation of the order, content, condition use of trademarks and protection of the rights of the owner. Nowadays, the legal sources which provide the trademark regulation in Russia are based on several primary sources. The main source is the Chapter 76, Section two of the fourth part of the Civil Code of the Russian Federation[74], where the major mechanisms of trademark law regulations are given. Another source is the administrative regulation, approved by order No. 483 of the Ministry of economic development of the Russian Federation dated 20.07.2015[75], which regulates the registration of trademarks by the Russian Federal Service for Intellectual Property (e.g. a Russian governmental agency in charge of intellectual property). Article 180 of the Criminal Code of the Russian Federation[76] defines the condition of criminal liability and punishment and is applied only after proving that the copyright holder has been repeatedly caused major damage.

As it can be observed the World Intellectual Property Organization has generally harmonized the basic trademark regulations via the Madrid Agreement and the Madrid Protocol [1989]. The organizations such as the International Trademark Association (INTA) and global non-profit

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[72] Konik N. V. (and others). Trademarks and brands.M. 2006 page 17. (Коник Н.В. (и другие).Товарные знаки и бренды. М. 2006 год страница 17).

[73] State Committee of inventions of the USSR, Order of January 8, 1974 "Regulations on trademarks" (Госкомизобретений СССР, Приказ от 8 января 1974 года «Положение о товарных знаках»). Can be found: < http://www.consultant.ru/cons/cgi/online.cgi?req=doc&base=ESU&n=3581#07813743584101295> accessed on 26.04.2020.

[74]Civil code of the Russian Federation part 4, Chapter 76, paragraph 2, dated 18.31.2006 N 230-FZ (Гражданский кодекс Российской Федерации часть 4, глава 76, параграф 2,от 18 декабря 2006 года N 230-ФЗ). Can be found on: < http://www.consultant.ru/document/cons_doc_LAW_64629/1f28b63a10d28f4b519ff8e4984b42d620071cd0/> accessed on 25.04.2020.

[75] Order No. 483 of the Ministry of economic development of the Russian Federation dated 20.07.2015 (Приказ Минэкономразвития России от 20.07.2015 № 483). Can be found on: < http://www.garant.ru/products/ipo/prime/doc/71073902/> accessed on 25.04.2020.

[76] Criminal code of the Russian Federation" dated 13.06.1996 N 63-FZ (as amended on 02.08.2019). Criminal code Article 180 (Уголовный кодекс Российской Федерации" от 13.06.1996 N 63-ФЗ (ред. от 02.08.2019). УК РФ Статья 180). Can be found: < http://www.consultant.ru/document/cons_doc_LAW_10699/ba7f1b597c6e57acc18cd6cb69af326dd0db93a5/> accessed on 26.04.2020.

advocacy associations of brand owners and professionals help to advance trademarks and trademark legislation throughout the world.

2. Consumer aspects of trademarks in the European Union and Russian Federation

Trademarks are the driving force for the sellers and buyers around the world. Trademarks are mainly symbols showing the responsibility for a particular product. Congeneric items can be produced by different manufacturers and spread by numerous vendors and one of the main aspects that allows purchasers to differentiate one product from another is the trademarks that these manufacturers have. Consumers are usually guided by the trademark when choosing the product[77].

A trademark inter alia speaks for several goals. As the paper has already highlighted, from the perspective of the buyer the trademark serves as a guide in the wide choice of products in our modern society. At the same time, from the perspective of the seller, the trademark is a great tool to block competitors from using their brand. In addition, the trademark can be an effective weapon against competitors who may attempt to hijack the market, especially in case of online trading. In general, the selection is based on the expectations of the consumer from the product, while here, it functions as the indicator of the presence of particular quality and certain assurance of the product[78].

As it has been previously stated, the trademark helps to distinguish the products and services of the specific manufacturer from the homogeneous goods and services of other enterprises. Basically, "*the main purpose of a trademark is to enable the public to recognize the goods or*

[77] Kudashov V.I., Ryabokon A.I. Use of trademarks and brands to promote new developments on the market. Works of Belarusian State Technological University, 2018, part 5, № 1. p 19. [in Russian] (Кудашов В.И., Рябоконь А.И. Использование товарных знаков и брендов для продвижение на рынок новых разработок, товаров и услуг. Труды Белорусского технического университета, 2018, серия 5, № 1. стр.19).
[78] Nermien Al-Ali. Comprehensive Intellectual Capital Management: Step-by-Step.Published by John Wiley & Sons Inc. p. 145.

services as originating in a particular company or being a particular product or service."[79] Moreover, it allows consumer to define the source and origin of the good, as information about the owner is one of the main conditions that should be carried out in order to register the mark.

Nevertheless, as it was mentioned by Timothy H. Hiebert : *"[...] the entire body of trademark law is steeped in the notion that the interests of consumer and trademark owner naturally coincide*"[80].

One of the most notorious benefits of the trademark for consumption is advertisement. Advertisements are helping manufacturers to introduce the new product in the market and give it a chance to promote the new trademark. It also helps to expand the market by making the trademark more popular and helps the consumer to distinguish it. It familiarizes the customers with the new products and their various uses and educates them about the new uses of existing products[81]. In addition, attention to the advertisement allows for more elaboration and strengthening of existing brand associations in memory[82]. Moreover, *"more attention is paid to the brands in original ads, which indirectly promotes brand memory, while simultaneously the brands in original advertisements become more memorable directly, independent of the amount of attention"*[83]. Advertisements are usually making brand names more diversified and prompt the branded products to assure a standard quality to the consumers. The manufacturer is forced in this case to provide quality goods to the consumers and tries to win their confidence in their product[84]. Nevertheless, advertisements help to increase the standard of living[85]. That is based on the experience of advanced nations and countries like the Republic of India[86] or People's Republic of China[87], which felt the great growth in the standard of living.

[79] The basics of trademarks < https://www.inta.org/Media/Documents/2012_TMBasicsBusiness.pdf > accessed on 13.03.2020.
[80] Timothy H. Hiebert. Parallel Importation in U.S. trademark law. Greenwood Press (1994). p. 3.
[81] Thomas O'Guinn, Chris Allen, Richard J. Semenik. Advertising and Integrated Brand Promotion. South Western Educ Pub; 006 edition (16 Feb 2011). pp. 22-25.
[82] Peter, Rik & Warlop, Luk & Wedel, Michael (2002). Breaking Through the Clutter: Benefits of Advertisement Originality and Familiarity for Brand Attention and Memory. Management Science. 48. 765-781. 10. 1287//mnsc.48.765192. p. 768.
[83] *Ibid*.
[84] Baburin V.A., Goncharova N.L. Advertising activities in trading business. Tutorial. SPb.: Asterion, 2014. p.101 [in Russian] (Бабурин В.А., Гончарова Н.Л. Рекламная деятельность в торговом деле. Учебник. СПб.: Астерион,2014. Стр.101).
[85] Thomas O'Guinn, Chris Allen, Richard J. Semenik. Advertising and Integrated Brand Promotion. South Western Educ Pub; 006 edition (16 Feb 2011). p. 115.
[86] UNCTADSTAT. General Profile : India <https://unctadstat.unctad.org/CountryProfile/GeneralProfile/en-GB/356/index.html> accessed on 10.03.2020.
[87] UNCTADSTAT. General Profile: China < https://unctadstat.unctad.org/CountryProfile/GeneralProfile/en-GB/156/index.html> accessed on 10.03.2020.

Advertisements helped to create a large demand for products[88]. Because of this, companies have purchased a wide variety of products in bulk, which lowered the cost for goods per unit. Then in turn, they could sell these products to the consumer for a lower price. In the absence of advertisements, companies would only buy a limited number of products, which then would make the price point they would purchase it at much higher[89]. This would then increase the pricing trader would have to sell it for to the customer. "*Because advertising increases the probability of success that new products will succeed, consumers have a greater variety of choice in products and services*"[90].

Since the designated purpose of trademarks is to differentiate between goods, the touchstone for an infringement action is regardless there is a likelihood of consumer confusion between the marks[91]. There are many different legal tools in the European Union to prevent certain manufacturers to infringe on one's intellectual property rights, particularly trademark rights. Firstly, one may request the competent national customs department to detain or block suspicious goods that might be sold bearing one's trademark without their authorization and as a victim of counterfeiting, one may file this kind of legal action[92]. One should lodge an application for action with the competent customs department requesting them to take action. A Union application for action when granted in one European Union Member State has the same legal status in all other Member States, where action was requested for in that application[93]. Applicant may register with the Enforcement Database of European Union Intellectual Property Office since it allows one to be in direct communication with the relevant authorities[94]. In case, if someone has registered the similar or identical European Union trademark to someone, one can request the European Union Intellectual Property Office to cancel the registration. One may also oppose the application if the registration of the trademark

[88]Thomas O'Guinn, Chris Allen, Richard J. Semenik. Advertising and Integrated Brand Promotion."Olma Media Group" 2003. p.127 [in Russian] (Томас О'Гвин, Крис Аллен, Ричард Дж. Семеник. Реклама и продвижение бренда. «Олма Медиа Групп» 2003. Стр 127).

[89] *Ibid*.p. 126.

[90] Thomas O'Guinn, Chris Allen, Richard J. Advertising and Integrated Brand Promotion (2015) 5th Edition. South-Western Cengage Learning. p. 81.

[91] Opposition guidelines part 2. Ch.2: Likelihood of confusion D. Global Assessment. Final version: November 2007.Can be found: < http://euipo.europa.eu/en/mark/marque/pdf/global_assessment-EN.pdf> accessed on 22.04.20

[92] Imitation of a branded good – Counterfeit products. < https://europa.eu/youreurope/business/running-business/intellectual-property/infringement/index_en.htm> accessed on 22.04.2020.

[93] Defend your rights <https://ec.europa.eu/taxation_customs/business/customs-controls/counterfeit-piracy-other-ipr-violations/defend-your-rights_en> accessed on 22.04.2020.

[94] Rights holders <https://euipo.europa.eu/ohimportal/en/web/observatory/ip-enforcement-portal-home-page> accessed on 22.04.2020.

is ongoing[95]. Problem of cybersquatting may also affect trademark owners and confuse customers in the cyberspace. In such case, one may go to court or make good use of non-judicial remedies including the Internet Corporation for Assigned Names and Numbers alternative proceedings[96].

Legislators in the Russian Federation implement several legal tools to prevent consumer confusion and help trademark owners to avoid the trademark misuse. Primarily, the Civil Code of the Russian Federation sets liability for illegal use of a trademark. Article 1515 of the Civil Code of the Russian Federation[97] determines the counterfeit products. Thus "*Goods, labels, and packages of goods on which a trademark or a confusingly similar designation is unlawfully placed are counterfeit*"[98]. Afterwards, the legislator sets rights of the trademark owner such as "*[…] withdrawal from circulation and destruction at the expense of the infringer of counterfeit goods , labels, packages of goods that contain an illegally used trademark or a designation similar to it to the extent of confusion*", or "*[…] demand that the infringer remove from the counterfeit goods, labels, and packaging of the goods an illegally used trademark or a designation that is confusingly similar to it*"[99]. Following, the obligations of a person who infringes the exclusive right to a trademark when performing works or rendering services is "*to remove the trademark or its confusingly similar designation from the materials that accompany the performance of such works or rendering services, including documentation, advertising, and signage*"[100].

Thus, "*The rightsholder has the right to demand compensation from the infringer instead of compensation for damages :*

[95] Identical or similar EU trade marks < https://europa.eu/youreurope/business/running-business/intellectual-property/infringement/index_en.htm> accessed on 22.04.2020.
[96] Infringement of intellectual property rights.pp.2-3 < https://europa.eu/youreurope/business/running-business/intellectual-property/infringement/index_en.htm> accessed on 13.03.2020.
[97] "Civil code of the Russian Federation (part four)" from 18.12.2006 N 230-FZ (as amended on 18.07.2019). Article 1515. Liability for illegal use of a trademark. Section 1. [in Russian] ("Гражданский кодекс Российской Федерации (часть четвертая)" от 18.12.2006 N 230-ФЗ (ред. от 18.07.2019). Статья 1515. Ответственность за незаконное использование товарного знака. Пункт 1). Can be found on: < http://www.consultant.ru/document/cons_doc_LAW_64629/44bf2477089f6ece7185aaf3e37bae5ace2954cf/> accessed on 22.04.2020.
[98] *Ibid*. Section 2.
[99] *Ibid*.
[100] *Ibid*. Section 3.

1) in the amount of ten thousand to five million rubles, determined at the discretion of the court based on the nature of the violation.

2) twice the value of the goods on which the trademark is unlawfully placed, or twice the value of the right to use the trademark, determined on the basis of the price that, under comparable circumstances, is usually charged for the lawful use of the trademark.

5. A person who makes a warning marking in relation to a trademark not registered in the Russian Federation shall be liable in accordance with the procedure provided for by the legislation of the Russian Federation"[101].

If the rightsholder discovers the illegal use of a trademark, one can apply to several state bodies in order to protect his exclusive right, as well as to bring those who have appropriated this trademark without his consent to justice. In such cases, the trademark holder may submit applications for initiation of criminal proceedings to the territorial bodies of the Ministry of Internal Affairs of Russian Federation on the fact of the crime and to the regional offices of the Prosecutor's Office of the Russian Federation on the detected offense; apply to the territorial customs authority for customs Declaration of goods imported into the Russian Federation; send an application to the territorial Antimonopoly authority, which may indicate the fact of advertising products with the assigned brand (that is, the illegal use of a trademark); complaint to the territorial bodies of the Federal service for supervision of consumer rights protection. According to the recommendations of Kotelnikova Z.V., senior researcher at laboratory of economic and sociological research at the Higher School of Economics National Research University : "*The fact of bringing an offender to justice for illegal use of a trademark can serve as a control purchase of its products. To do this, you need to introduce yourself as a simple consumer and get a cash receipt, which is then attached to the claim*"[102].

There is a trademark administrative liability available as well. Administrative liability for illegal use of a trademark Article 14.10 of the Administrative Code of Russian Federation[103]

[101] *Ibid*. Section 4 and 5.
[102] Kotelnikova Z.V. A product with someone else's face or why trademark owners condones counterfeiting.p.10 [in Russian] (Котельникова З.В. «Товар с чужим лицом, или почему правообладатели торговых марок попустительствуют контрафакту») стр.10.
[103] Article 14.10 of the Administrative Code of Russian Federation [in Russian] (Статья 14.10 Кодекс об административных правонарушениях (КоАП РФ)) Can be found on: <http://base.garant.ru/12125267/ce436510e7b4bedcb0c021d3470cd8ad/> accessed on 25.04.2020

establishes a penalty for the assignment of an existing trademark, for indicating a false point of production of products, for similar marking on products of the same type.

The criminal liability is regulated by Article 180 of the Criminal Code of the Russian Federation[104]. The illegal use of a trademark is applied in cases where the illegal use has been repeated, which caused great harm or loss. Methods of protection of a registered trademark are specified in Article 1252 of the Civil Code of the Russian Federation[105]. One can report an illegal act, demand the elimination of the specified products and all the elements attached to them, and demand compensation for material damage. It is best to claim compensation for illegal use of a trademark, since the judicial authority will calculate it not on the basis of lost income, but on the basis of its own definition, as well as section 2 of article 1515 of the Civil code of the Russian Federation.

In general, both the European Union and the Russian Federation have equal economic and legal benefits from the trademark regulations since all European Union Members States and the Russian Federation are parts of the World Intellectual Property Organization[106]. That means that European Union Member States and the Russian Federation are members of several World Intellectual Property-Administered Treaties. More clearly, they are parties of such treaties related to trademark law such as Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (1957)[107] the Trademark Law Treaty (Geneva, 1994)[108] and more modern Singapore Treaty on the Law of Trademarks (Singapore 2006)[109], which was built on the Trademark Law Treaty (Geneva, 1994), has a wider

[104] Article 180 of the Criminal Code of the Russian Federation [in Russian] (Статья 180 Уголовного кодекса Российской Федерации.) Can be found on: < http://www.consultant.ru/document/cons_doc_LAW_10699/ba7f1b597c6e57acc18cd6cb69af326dd0db93a5/> accessed on 25.04.2020.

[105] Article 1252 of the Civil Code of the Russian Federation [in Russian] (Статья 1252 Гражданского кодекса Российской Федерации.) Can be found on: < http://base.garant.ru/10164072/8102824d55abc8c944291ea708e917ca/> accessed on 25.04.2020.

[106] Member States < https://www.wipo.int/members/en/> accessed on 14.03.2020.

[107] Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15, 1957, as revised at Stockholm on July 14, 1967, and at Geneva on May 13, 1977, and amended on September 28, 1979. Can be found on: < https://wipolex.wipo.int/en/text/287437> accessed on 22.04.2020.

[108] Trademark Law Treaty and Regulations done at Geneva on October 27, 1994. Can be found on: < https://wipolex.wipo.int/en/text/294358> accessed on 22.04.2020.

[109] Singapore Treaty on the Law of Trademarks Resolution by the Diplomatic Conference Supplementary to the Singapore Treaty on the Law of Trademarks (done at Singapore on March 27, 2006) and Regulations Under the Singapore Treaty on the Law of Trademarks (as in force on November 1, 2011). Can be found on: < https://wipolex.wipo.int/en/text/290013> accessed on 22.04.2020.

scope of application and addresses more recent developments in the field of communication technologies.

3. The concept of "trademark" use and functions in the legislation of European Union and Russian Federation

The term of European Union trademark is well defined in Article 5 of Regulation (EU) 2017/100 as following : "*An EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of :*

(a) distinguishing the goods or services of one undertaking from those of other undertakings; and
(b) being represented on the Register of European Union trade marks ('the Register'), in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor"[110].

The European Union legislator makes the differences between such terms as "European Union collective mark" and "European certification mark". Article 74 regulates the European Union collective mark, which says : "*A European Union collective mark ('EU collective mark') shall be an EU trade mark which is described as such when the mark is applied for and is capable of distinguishing the goods or services of the members of the association which is the proprietor of the mark from those of other undertakings. Associations of manufacturers, producers, suppliers of services, or traders which, under the terms of the law governing them, have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts, and to sue and be sued, as well as legal persons governed by public law, may apply for EU collective marks*"[111].

[110] Regulation (EU) 2017/1001 of 14 June 2017on the European Union trade mark [2017] OJ L 154/1. Article 4 < https://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:32017R1001&from=EN#d1e573-1-1> accessed on 14.03.2020.
[111] *Ibid*. Article 74.

The term "European Union certification mark" is regulated by Article 83 of Regulation (EU) 2017/100, as the following :

"*1. An EU certification mark shall be an EU trade mark which is described as such when the mark is applied for and is capable of distinguishing goods or services which are certified by the proprietor of the mark in respect of material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics, with the exception of geographical origin, from goods and services which are not so certified.*

2. Any natural or legal person, including institutions, authorities and bodies governed by public law, may apply for EU certification marks provided that such person does not carry on a business involving the supply of goods or services of the kind certified"[112].

Since the European Union trademark lives in coexistence with the national trademark the Regulation (EU) 2017/100 Article 19 regulates dealing with EU trademarks as national trademarks. Thus, the Article outlines, the following :

"*1. Unless Articles 20 to 28 provide otherwise, an EU trade mark as an object of property shall be dealt with in its entirety, and for the whole area of the Union, as a national trade mark registered in the Member State in which, according to the Register:*

(a) the proprietor has his seat or his domicile on the relevant date;

(b) where point (a) does not apply, the proprietor has an establishment on the relevant date.

2. In cases which are not provided for by paragraph 1, the Member State referred to in that paragraph shall be the Member State in which the seat of the Office is situated.

3. If two or more persons are mentioned in the Register as joint proprietors, paragraph 1 shall apply to the joint proprietor first mentioned; failing this, it shall apply to the subsequent joint proprietors in the order in which they are mentioned. Where paragraph 1 does not apply to any of the joint proprietors, paragraph 2 shall apply"[113].

[112] *Ibid*. Article 83.
[113] *Ibid*. Article 19.

The trademark definition is not determined in the Russian legal regulations. However, the types of trademarks in the fourth part of the Civil Code of the Russian Federation, which is an essential source of trademark regulation in the Russian Federation. Though, Russian legislation formally applies the definition of the Section II of 1974 Order "Regulations on trademarks"[114], therefore according to the Section II of the legislation, the trademarks are the "*designations registered in accordance with the established procedure serving for distinction of goods of one enterprise from homogeneous goods of other enterprises*"[115]. The types of trademark are described in the 1974 Order, but however, the official version is the one that is written in Article 1482 of the fourth part of the Civil Code of the Russian Federation. The Article states : "*Verbal, pictorial, volumetric and other designations or combinations thereof may be registered as trademarks*". In fact, the same statement was incorporated into Section II of the 1974 Order. Nevertheless, the 1974 Order itself is irrelevant due to the 2002 Order of the Russian governmental agency in charge of intellectual property from 14.02.2002 N 25. As a whole, according to Russian law the trademarks are included in the broader concept called the "*Rights to means of individualization of legal entities, goods, works, services and enterprises*"[116]. Chapter 76th of the IVth part of the Russian Civil Code includes the legal name of the legal entity (firm name), trademark and service mark, geographical indication and more recently the domain name, which is stated under the 2006 Federal Act "*About information, information technologies and about information protection*"[117]. Association of the specified objects in one related group by means of individualization is caused by their main and general function of recognition of goods and their producers which they are urged to carry out in civil relations.

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[114] Regulations on trademarks 1974 (as amended on September 20, 1990) (not valid on the territory of the Russian Federation on the basis of the order of Russian governmental agency in charge of intellectual property of 14.02.2002 N 25 [in Russian] (Положение о товарных знаках (с изменениями на 20 сентября 1990 года) (не действует на территории РФ на основании приказа Роспатента от 14.02.2002 N 25 Госкомизобретений СССР, Приказ от 8 января 1974 года «Положение о товарных знаках»). Can be found on: < http://www.consultant.ru/cons/cgi/online.cgi?req=doc&base=ESU&n=3581#05573594571455482> accessed on 22.04.2020.

[115] *Ibid*. Section 2.

[116] "The civil code of the Russian Federation (part four)" of 18.12.2006 N 230-FZ (ed. of 18.07.2019) Chapter 76 [in Russian] ("Гражданский кодекс Российской Федерации (часть четвертая)" Глава 76 от 18.12.2006 N 230-ФЗ (ред. от 18.07.2019)). Can be found on: < http://www.consultant.ru/document/cons_doc_LAW_64629/be8fc5b6a0661d4daf083041900996da0c8d91b7/> accessed on 22.04.2020.

[117] Clause 15 of Art. 2 of Federal law No. 149-FZ "About information, information technologies and about information protection" (in the edition from 28.07.2012) [in Russian] (п. 15 ст. 2 ФЗ № 149-ФЗ «Об информации, информационных технологиях и о защите информации» (в ред.от 28.07.2012)). Can be found on: < http://www.consultant.ru/document/cons_doc_LAW_61798/c5051782233acca771e9adb35b47d3fb82c9ff1c/> accessed on 22.04.2020.

Meanwhile, the presence of a common function does not negate a number of fundamental differences between them. So, a trademark or a service mark, and appellation of origin of goods, for the purpose of obtaining legal protection, are subjected to the examination of the claimed designation, and the right to their use is validated by the special security documents - the trademark certificate and certificate for the right to use appellation of place of origin of goods. Additionally, the legal name of the legal entity (firm name) is subject to special registration under the current Russian legislation, it is not subject to expert evaluation procedures, and the right to use it is not certified by a special security document. The use of the legal name of the legal entity (firm name) is the responsibility of commercial organizations. Use of means of individualization of production from the point of view of identification of the last is an obligation of the company owners.

The means of individualization are by nature ideal - like any abstract sign system. At the same time, as symbols of the objects replaced (individualized) by them, they are embodied in material carriers available to human perception[118].

4. Trademark protection in the European Union and Russian Federation

As aforementioned, protection of trademark in the European Union can be done via several legal mechanisms. These mechanisms include: The Union trademark for the European single market and national trademarks for each individual Member State. The main pieces of legislation for the registration of European Union Trademark and protection of the trademark in all 28 European Union Member States, are European Union Trademark Directive 2015/2436[119], European Union Regulation 1151/2012 on quality schemes for agricultural

[118] Sorokina A. I. Legal nature of rights to means of individualization Text of the scientific article on the specialty " State and law. Legal Sciences " p.8 (2011) [in Russian] (Сорокина А.И. Правовая природа прав на средства индивидуализации Текст научной статьи по специальности «Государство и право. Юридические науки» стр.8 (2011)).

[119] Direction (EU) 2015/2436 of 16 December 2015 to approximate the laws of the Member States relating to trade marks [2015] OJ L 336/1. Can be found: < https://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:32015L2436&from=EN> accessed on 26.02.2020.

products and foodstuffs[120] and European Union Trademark Regulation 2017/1001 – EUTMR[121]. The Directive stands for harmonization of trademark laws of the European Union Member States major revisions and modernizations had to be transposed into national laws until January 2019 and Regulation 2017/1001 stands for protection with one trademark registration in the territories of all European Union Member States. The registration procedure is regulated by Article 39 of the European Union Trademark Regulation 2017/1001 and the unregistered trademark protection is regulated by Article 8 of the Paris Convention, which provides for protection of a foreign business or company name without registration of a trademark as soon as the name has first been commercially used. Most of the European Union companies are part of the International Trademark Association (INTA)[122]. INTA is the global association of trademark owners and professionals, dedicated to supporting trademarks and related intellectual property rights in order to ensure the protection of consumers and to promote fair and effective commerce.

One of the most famous cases in the European Union is the Koninklijke Philips Electronics NV v Remington Consumer Products Ltd[123].

Facts of the case : The plaintiff is Philips Electronic, which had introduced a shaver in 1966. The shaver had a sheet with three rotational shavers organized in an equilateral triangle. It had enrolled its trademark for the shaver. The mark was the following: a sheet of three turning razor-sharp edges in an equilateral triangle. The other manufacturer (Remington), then contrived razors that were sold in the United States' market. Philips claimed that Remington had infringed its trademark by using the features of a shaver with three turning sharpened pieces of steels managed in an equilateral triangle which made confusion in the psyches of the psyches of the customer as they thought it was an item produced by Philips. Then again Remington denied

[120] Regulation (EU) No 1151/2012 of 21 November 2012 on quality schemes for agricultural products and foodstuffs [2012] OJ L 343/1. Can be found: < https://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2012:343:0001:0029:en:PDF> accessed on 26.04.2020.

[121] Regulation (EU) 2017/1001 of 14 June 2017on the European Union trade mark [2017] OJ L 154/1. Article 4 < https://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:32017R1001&from=EN#d1e573-1-1> accessed on 14.03.2020.

[122] Corporate Member List <https://members.inta.org/corporate-member-list?reload=timezone > accessed 13.11.2019.

[123] Koninklijke Philips Electronics NV v Remington Consumer Products Ltd. Case C-299/99. [2002]. Can be found on: < http://curia.europa.eu/juris/showPdf.jsf;jsessionid=642C9CBB24B457FCC4DC440D44185EF1?text=&docid=47423&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=4069950> accessed on 22.04.2020.

that this was a trademark infringement and that the enrollment of the imprint for Philips ought to be denied.

Remington claimed that based on the reason that the imprint has gained a distinctive character since Philips invented the razor, to begin with, the trademark law does not permit the claimant to enlist such stamps. The enrollment of such verifications ought not to be permitted because it is important to acquire a fundamental specialized result and in this way such enrolment is invalid.

The issue is whether the shape of the mark should be necessary in order to obtain a specific technical result ?

Holding of the case : Philips had not acquired a specific character in spite the fact that it was the manufacturer that presented the razor with such a shape in the business. The court summarized that a form whose essential features perform a technical function, and which were chosen to carry out that function should be used freely by all competitor manufacturers, an aim which is in the public interest. Hence it was held that Remington has not violated Philips trademark rights. It was never a legitimate trademark and Philips had neglected to demonstrate that it had obtained distinctive attributes.

This position reflects the legitimate aim of not allowing individuals to use the registration of a mark in order to acquire or perpetuate exclusive rights relating to technical solutions.

From being allowed imposing a business model over specialized and utilitarian arrangements the trademark law goes for keeping and shielding an owner. It ought not to turn into a constraining to interleave candidates who need to arrive and easily offer their items and administrations. Shapes that give special result ought to be publicly attainable. The law does not give the privilege to replace check a shape, which gives a specialized result, despite of the possibility that various shapes can give an equal specific result. The shape can be allowed to be enlisted, if it has received unique character from being utilized, it can have a permission to be enlisted. Meanwhile, the mark utilized by Philips did not gain any unique features. The shape used by Philips was one, which was valuable to get that specialized outcome such as the way in which the hair would be trimmed. In this situation, the technical feature of the product could be used by the competitors since it is in a public interest. It is basic that there ought to be an

impulsive expansion to the shape, which can not be credited to perform some useful reason, if one needs to enroll their imprint.

The case shows an interesting situation concerning the functionality excluding trademark registration.

The Russian trademark law contains many legal mechanisms for the trademark protection. Those mechanisms include Article 1515 of the Civil Code of the Russian Federation[124] for civil liability, as the Civil Code is often used as the counterfeit enforcement; Article 180 of the Criminal Code of the Russian Federation[125], if the act against the trademark owner was committed repeatedly or caused major damage, and Article 14.10 of the Administrative Code of the Russian Federation[126] for the administrative liability. Each measure depends on the severity of the offense.

One of the most popular trademark protection case in the Tula oblast of Russia is the Case No. A68-9383/2019 from 14th October 2019[127], that briefly states the following:

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[124] Chapter 76. Rights to means of individualization of legal entities, goods, works, services and enterprises § 2. Right to trademark and right to service mark item 7. Protection of the right to a trademark Article 1515. Responsibility for illegal use of the trademark of part IV of the Civil Code of the Russian Federation [in Russian] (Глава 76. Права на средства индивидуализации юридических лиц, товаров, работ, услуг и предприятий § 2. Право на товарный знак и право на знак обслуживания пункт 7. Защита права на товарный знак Статья 1515. Ответственность за незаконное использование товарного знака части IV Гражданского Кодекса Российской Федерации). Can be found on: <http://www.consultant.ru/document/cons_doc_LAW_64629/be8fc5b6a0661d4daf083041900996da0c8d91b7/> accessed 22.04.2020.

[125] Criminal code of the Russian Federation Art 2, Section 8. Crimes in the sphere of Economics Chapter 22. Crimes in the sphere of economic activity Article 180 of the criminal code. Illegal use of means of individualization of goods (works, services) [in Russian] (Часть 2 Уголовного кодекса РФ Раздел 8. Преступления в сфере экономики Глава 22. Преступления в сфере экономической деятельности Статья 180 УК РФ. Незаконное использование средств индивидуализации товаров (работ, услуг)). Can be found on: <http://www.consultant.ru/document/cons_doc_LAW_10699/799a726d990f4e000b31703cf3be49fa16cb180d/> accessed on 22.04.2020.

[126] Chapter 14. Administrative offences in the field of entrepreneurial activity and activities of self-regulatory organizations Article 14.10. Illegal use of means of individualization of goods (works, services) "the Code of the Russian Federation about administrative offenses" of 30.12.2001 N 195-FZ (edition of 04.11.2019) [in Russian] (Глава 14. Административные правонарушения в области предпринимательской деятельности и деятельности саморегулируемых организаций Статья 14.10. Незаконное использование средств индивидуализации товаров (работ, услуг) "Кодекс Российской Федерации об административных правонарушениях" от 30.12.2001 N 195-ФЗ (ред. от 04.11.2019)). Can be found on: < http://www.consultant.ru/document/cons_doc_LAW_34661/> accessed on 22.04.2020.

[127] Decision of 14 October 2019 in case no. A68-9383/2019**.** The arbitration court of Tula region (Tula region AS) (Решение от 14 апреля 2019 г. по делу № А68-9383/2019**.**Арбитражный суд Тульской области (АС Тульской области). Can be found on: < https://sudact.ru/arbitral/doc/h9Ou2cYQhrl4/?arbitral-txt=&arbitral-case_doc=%E2%84%96%20%D0%9068-9383/2019&arbitral-lawchunkinfo=&arbitral-date_from=&arbitral-date_to=&arbitral-region=&arbitral-court=%D0%90%D0%A1%20%D0%A2%D1%83%D0%BB%D1%8C%D1%81%D0%BA%D0%BE%D0%B9

Facts of the case : Open joint stock company "RIKOR electronics" (hereinafter-JSC "RIKOR electronics", the plaintiff) appealed to the Arbitration court of the Tula region with a claim to an individual entrepreneur Natalia Davydova (hereinafter – Individual Proprietor (IP) Davydova N.V., entrepreneur, defendant) for recovery of compensation for violation of exclusive rights to a trademark under certificate No. 289416 in the amount of 50,000 rubles, court costs for payment of state duty in the amount of 2,000 rubles, expenses for the purchase of counterfeit goods in the amount of 149 rubles, postage in the amount of 100 rubles, expenses for obtaining a statement from the Unified State Register of Private Entrepreneurs in the amount of 200 rubles.

The case was accepted for consideration in accordance with Chapter 29 of the Arbitration Procedure Code of the Russian Federation in simplified proceedings (hereinafter - the APC of the Russian Federation).

The parties are duly notified of the consideration of the case in summary proceedings in accordance with articles 123 and 228 of the APC of the Russian Federation.

In a statement dated 15.08.2019, JSC "RIKOR electronics" clarified the claims, changing, among other things, the type of compensation, and asked to recover compensation for violation of exclusive rights to a trademark registered under No. 289416 in the amount of 180,000 rubles (twice the cost of the right to use the trademark), state duty in the amount of 2,000 rubles, court costs in the form of a fee for obtaining information from the unified state register in the amount of 200 rubles, costs for purchasing counterfeit goods in the amount of 149 rubles, costs for paying for postal services in the amount of 100 rubles.

In accordance with article 49 of the APC of the Russian Federation, the court accepted for consideration an application for clarification of claims.

From the sole proprietor Davydova N.V. in due time, the response to the claim was not received.

The court considered the case in summary proceedings on the basis of evidence submitted to the commercial court.

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Issue of the case : Were the exclusive rights for the trademark violated or not ?

Decision of the case : The claims of open joint stock company "Rykor electronics" are partially satisfied.

Recover from the individual entrepreneur Natalia Davydova (OGRNIP 304714107600024, INN 711200693536) in favor of the open joint stock company "Rykor electronics" (INN 5243001622, OGRN 1025201335279) compensation for violation of exclusive rights to a trademark under certificate no. 289416 in the amount of 180,000 rubles, court costs for payment of state duty in the amount of 2,000 rubles, expenses for the purchase of counterfeit goods in the amount of 149 rubles, postage costs in the amount of 100 rubles. Refuse to meet the rest of the requirements.

Collect from the individual entrepreneur Natalia Davydova (OGRNIP 304714107600024, TIN 711200693536) in the Federal budget state duty in the amount of 4,400 rubles. The decision on the case considered in summary proceedings is subject to immediate execution and can be appealed within fifteen days from the date of its adoption, and in the case of a reasoned decision – from the date of the decision in full, to the Twentieth commercial court of appeal by filing an appeal through the Commercial court of the Tula region.

In this case, it is evident that the registered trademark rights are reserved, and the power of the law prevailed. The infringer was fined, and the trademark owner enjoyed the benefits of the trademark protection.

Conclusion

A trademark is a very significant part of the enterprise identity of any corporation. All legal norms in any country need to be observed at its creation and registration.

Summarizing the results, I would like to pay attention to the further development of the cooperation between countries and improving the trademark protection worldwide. The creation of such institution as European Union Intellectual Property Office is the great step not only for the European Union Member States but is a great opportunity for all people around the world to benefit from this great legal tool and implement the achievements and experience of the European Union to improve the trademark protection around the world. The World Intellectual Property Organization tried to globalize the trademark protection and has achieved significant improvements in generally harmonizing the basics in trademark law around the world. However, some important changes have not been made and thus, it is hard to protect one's trademark other than in the country of registration, especially in case of the Commonwealth of Independent States countries. One might be faced with significant obstacles and high expenses. However, the judicial practice of both European Union and Russian Federation can serve as an example of strong and convincing arguments, but judicial decisions still lack uniformity. Moreover, international cooperation issues seem to be relevant. At the very least, it is desirable to conclude bilateral agreements on the protection of trademarks from various types of violations. Such an agreement must necessarily include provisions governing mutual recognition and enforcement of judgments. In general, trademark regulations around the world are getting more and more integrated and globalized. That is the very significant attempt to protect the exclusive rights better.

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