

## To protect and enforce trademarks

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Sovereign Belarus passed its national Law on Trademarks and Service Marks on February 5, 1993. Under Article 2 of this law, trademarks are legally protected either upon their registration with the National Center of Intellectual Property (NCIP) or under international treaties to which Belarus is a party (Belarus participates in both the Madrid Agreement and the Madrid Protocol). The NCIP examines trademark applications for formal requirements and on absolute and relative grounds. Pending applications are not published and cannot be opposed by third parties. Protection is granted on a first-to-file basis.

One of the most distinctive features of the Belarusian trademark system is the enforcement of granted rights. In Belarus, all disputes relating to IP, irrespective of the parties involved, are considered by the Intellectual Property Chamber of the Supreme Court. This specialised court, unique in the whole post-Soviet territory, began operating in March 2000.

Regarding trademarks, it is within the chamber’s competence to resolve:

- Trademark infringement actions;
- Trademark invalidations;
- Complaints against the decisions of the Appeal Board of the NCIP, which deals with oppositions against registered trademarks and appeals against trademark examination decisions; and
- Complaints against the decisions of the Antimonopoly Body, which is empowered to establish facts of unfair competition.

It will take the chamber no longer than two months from the date that an action was filed to resolve it. But if a foreign company or a natural person who is domiciled in a foreign state participates in the case, it shall be considered within one year. Although the term of trial for foreign natural and legal persons is considerably longer, about a quarter of all of the chamber’s cases involve foreign companies (coming, *inter alia*, from England, Germany, the US, Italy, The Netherlands, France, India, Spain, China, Switzerland, Austria, Poland and Bulgaria).

According to Zhanna Shkourdyuk, chairwoman of the chamber, foreign parties are usually experienced in applying for court protection, aware of the possible perspectives involved in case resolution and prepared for an adversarial trial.

The chamber does not hear a lot of IP cases. In 2010, it tried 96 cases, 59 of which were industrial property disputes; 37 were related to copyright. Unlike courts of general jurisdiction in Belarus, the chamber is not overworked. Therefore, it can carefully consider cases that often demand non-legal expert knowledge. If this is the case, the chamber summons experts and asks them to prepare an opinion on various IP topics such as art, linguistics and technology.

The chamber’s decisions come into effect immediately after they are announced and are not subject to appeal. They may be reviewed only by way of supervision if higher officials of the Supreme Court or the Prosecutor’s Office protest. The chamber reports that just three to six percent of its decisions are annually challenged by way of supervision.

Some trademark owners consider that civil trials conducted by the chamber are too lengthy and costly and prefer a less cumbersome administrative procedure. But while in the latter it is the state that prosecutes an infringer, collects fines and disposes of seized counterfeit goods, the former procedure allows a trademark owner to claim in its own discretion the most appropriate remedy.

The Belarusian trademark law, in addition to injunction and compensation for damages, provides the following civil sanctions for the unlawful use of a trademark:

- The removal of an unlawfully used trademark or a sign that is confusingly similar to the trademark from the goods or the packaging that it is applied to, or the destruction of existing reproductions of a trademark or of a sign that is confusingly similar to a trademark;
- The seizure or destruction of goods for which a trademark was unlawfully used; and
- The imposition of a fine for the benefit of an injured party amounting to the value of goods on which the trademark was unlawfully used.

Therefore, if a trademark owner is seeking for infringing goods to be destroyed (which is often of more importance than receiving compensatory payments or knowing that an infringer has been fined), it can be achieved only in a civil procedure.

Trademark infringement cases are becoming more and more frequent in the chamber. During the last few years, domain names were involved in some of them. In 2010, one of the most resonant disputes was about the domain name tempo.by. The plaintiff in the case owned a chain of pizzerias under the name Tempo, which was a registered trademark (a word mark in Cyrillic characters) for the services in class 43. The defendant, a Belarusian national, registered in the domain name tempo.by, which directed users to a site that offered them pizza delivery services. The date of registration was later than that of trademark registration.

The plaintiff asked the court to prohibit the defendant's use of the domain name tempo.by and to order the domain name registrar to cancel the defendant's registration. After the defendant became aware of the case, the website at tempo.by was deleted, while the domain name redirected users to a website operating under the domain name pizza.by that offered the same food and delivery services. The chamber acknowledged the infringement of trademark rights, although:

- Trademark law does not expressly list "use in domain name" among infringing actions, but only among forms of trademark use by the owner;
- The conflicting trademark and domain name were written in different alphabets; and
- The domain name was not used as it is, but only for redirection.

The chamber's decision was based on similarity of services in the Tempo trademark registration and those offered on the website that operated under the domain name pizza.by.

Another important case considered by the chamber at the end of 2010 concerned the trademark Sosedo (meaning neighbours in Belarusian). This is the name of a chain of supermarkets and the chain's owner, Libretik, registered the word Sosedo as a trademark for the goods in nearly all 34 trademark classes. Unfortunately, it omitted retail services in class 35. A Belarusian national pounced on this omission and obtained an identical trademark registration in class 35, and then started to threaten Libretik with a trademark infringement action. When Libretik successfully opposed the trademark registration at the Appeal Board of the NCIP, the defendant filed an appeal against the decision in the chamber. Based on the size and reputation of Libretik's retail chain, the chamber upheld the Appeal Board of the NCIP's decision and stated that the defendant's trademark would mislead consumers as to who or what operated Libretik's retail chain.

This case highlights the difficulties that are caused by piratical trademark registrations in Belarus. It is quite difficult to cancel marks once they have been registered. This difficulty comes from the absence of the “bad faith” notion in Belarusian trademark legislation. A trademark registration cannot be cancelled because of its owner’s bad faith, but it can be cancelled if any act of the owner in relation to the trademark registration is an act of unfair competition. This is established by the Antimonopoly Body, which necessarily requires proof of the competitive relations between the owner of the opposed mark and the opposing party. In cases of piratical registrations in the name of a person who does not own or run a business, this obviously cannot be proved, because such a person does not run any business and so is not a competitor of the opposing party in a strict sense. This is why the only option left open is to claim the misleading nature of a trademark as it is registered in the name of a person who is not connected to, or the owner of, the brand. Such a claim needs to be supported by evidence that shows a substantial volume of activity (sales and advertising, for example) and renown of the brand in Belarus.

Another variation of piratical trademark registrations is registration that is obtained in the name of an importer (local distributor) of foreign goods. These distributors tend to think that they are protecting a brand owner’s interests and doing it a favour. Brand owners and their attorneys should remember that even if there are registered trademarks and duly formalised relations with distributors in Russia and Eastern European countries that neighbour Belarus, these do not automatically spread to Belarus, and so protection in Belarus needs to be obtained separately and quickly.

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