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# Comparison of the trademark regulations in the United States of America and Russian Federation

*By Fikrat Abdinov,  
Analyst, Ambassadeurs de la Jeunesse*

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Ambassadeurs de la Jeunesse  
31 Rue de Poissy 75005 Paris  
E-mail : [contact@ambassadeurs-jeunesse.org](mailto:contact@ambassadeurs-jeunesse.org)  
Site internet : [www.ambassadeurs-jeunesse.org](http://www.ambassadeurs-jeunesse.org)



## **Abstract**

Trademarks are something very habitual, familiar and sometimes obnoxious. They are an integral part of any person's day to day life. The implementation of the trademarks is as ancient as the whole human civilization. Throughout the history craftsmen and merchants tried to mark their goods to make them famous and to protect them from being copied and forged. With the rise of the trademark's usage the awareness of their protection arose. Above all, states were concerned of their regulations, since trade and exchange of goods were one of the main activities of the country. Moreover, trademarks identified a product's origin and many craftsmen included unique images and signs on their goods for easier recognition. These practices certainly increased the interest in the country of origin and helped the government to raise its own reputation. Therefore, many states started to introduce various norms and rules to regulate imposition of unique stamps, marks and badges and their protection, mainly by some sort of punishment. Each country developed in its own specific way, the same way developed its laws and rules, trademark law is no different. This paper provides the comparison of the trademark regulations between two major world powers, namely United States of America and Russian Federation and draws some proposals of further development.

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## **Introduction**

In everyday life, people often use the terms "brand name", "logo", "brand", "trademark", "slogan". Summarizing the meaning of these concepts, they can be all designed to enable the consumer to distinguish the company's goods and services from the goods and services of others. From a legal point of view, the vast majority of these concepts fall under the term "trademark". Protection of the trademarks to help to preserve a company's goodwill, and to help consumers easily identify the source of the things they purchase, represent a complex and multi-faceted problem. Its solution involves the regulation of relations between manufacturers and their subordination to a certain system of regulations, instructions and rules. Nowadays, the relevance of the research topic is manifested in the ongoing qualitative growth of cooperation of subjects of international and national law. The use of a trademark is a kind of link between the manufacturer and the consumer, serves as an active means of attracting the attention of buyers to the marked goods and allows consumers to choose the goods they need from a certain manufacturer. The use of trademarks is important for both sellers and buyers. A trademark is a kind of symbol indicating who is responsible for this product. When choosing a product, the buyer is guided by the trademark. In case of satisfaction with the purchase next time, it will be guided simply by the trademark. Consumers receive a tool that allows them to navigate the market for goods and services and choose a product that has the right quality, or its manufacturer, which has the right reputation. Producers and intermediaries through means of individualization gain the opportunity to guarantee the quality of products produced or sold by them, as well as to promote their goods and services among the goods and services sold by other market participants. The state can count on a high level of civilization of the economy and the availability of additional mechanisms for the development of the institutional infrastructure of the national market. The international legal

mechanisms regulating the activities of states and international organizations aimed to preserve the business environment through the prevention, reduction and maximum possible limitation of adverse actions such as copying a source-identifying mark or adopting a name or logo that is “confusingly similar” to an existing mark in unity with national legal measures that open the way to achieving harmony between businesses. However, everyone knows that in different states trademark legislation can be regulated in a different way. This essay will provide the comparison of the trademark regulations in the United States of America and Russian Federation.

## **I. History of the trademark law in the United States of America and Russian Federation**

Both countries have undergone quite different historical legislative processes and both states as modern sovereign and secular states do have much in common in legislation concerning trademark law. Since, the countries belong to different legal systems (e.g. United States is mostly based on common law and the Russian Federation is the part of the continental legal system) the trademark regulations and the evolvement of the trademark law have some differences. The moment of the appearance of trademark legislation 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 the criminal punishment was provided<sup>1</sup>. 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, the forgery was

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<sup>1</sup> 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).

established as a criminal offense in that decree. With this decree in 1830, the introduction of an official register of Russian manufacturers registered their brands in the Department of trade and manufactures were started<sup>2</sup>. One of the most important pieces of legislation concerning the trademark protection in Russia was the enforcement of the “Regulation on trademarks” in 1974<sup>3</sup>. 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. Although, 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 prime sources. The main source is the 76<sup>th</sup> chapter section two of fourth part of Civil Code of Russian Federation<sup>4</sup>, where the major mechanisms of the 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<sup>5</sup>, 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). The Article 180 of the Criminal Code of Russian Federation<sup>6</sup> defines the condition of criminal liability and punishment and is applied only after proving that the copyright holder has been repeatedly caused major damage.

In United States the moment of codifying of the trademark law can be considered “The First Federal Trademark Law” in 1870, but after the

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<sup>2</sup> Trademarks and brands / N. V. Konik (and others). M. 2006 page 17. (Товарные знаки и бренды/ Н.В.Коник (и другие). М. 2006 год страница 17).

<sup>3</sup> 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»)

<sup>4</sup> 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).

<sup>5</sup> 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).

<sup>6</sup> 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).

number of revisions, amendments, and the final recognition by the Supreme Court in 1879, the entire federal statutory trademark system unconstitutional, the regulation of the trademark in US was drowned in the decades of dissatisfaction, confusion and panic until the US Congress revisited the subject and passed the law of 1905. This paper focuses on the tumultuous development of trademark law from the passage of the original law in 1870 to the creation of the 1905 law that, although flawed itself, established many of the principles upon which modern trademark law and practice is based.<sup>7</sup> First several treaties concerning the trademark protection were made in 1868 with both Russia and Belgium that agreed that “any counterfeiting in one of the two countries of the trademarks affixed in the other on merchandise ... shall be strictly prohibited and repressed”<sup>8</sup>. In service of this goal, foreign marks could be registered at the United States Patent Office, and reciprocal arrangements were made for registration of American marks. One of the major bills related with the trademark law in US is the 1946 Lanham Act<sup>9</sup>. The Lanham Act defines federal trademark protection and trademark registration rules. The Lanham Act grants the United States Patent and Trademark Office ("USPTO") administrative authority over trademark registration. The most recent developments in U.S. trademark law have included the adoption of the Federal Trademark Dilution Act of 1995<sup>10</sup>, which protected famous trademarks from uses that dilute their distinctiveness, even in the absence of any likelihood of confusion or competition. It went into effect on January 16, 1996. This act has been largely supplanted by the Trademark Dilution Revision Act of 2006 (TDRA), signed into law on October 6, 2006<sup>11</sup>. However, the Anticybersquatting Consumer Protection Act (ACPA)<sup>12</sup> is worth to be mentioned. The act itself “established a cause of action for registering, trafficking in, or using a domain name confusingly

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<sup>7</sup> Early Development of American Trademark Law Ross Housewright M.I.M.S. 2007, page 2.

<sup>8</sup> S. Doc. No. 20, 56th Cong., 2nd Sess. 96 (1900).

<sup>9</sup> The Lanham (Trademark) Act (Pub.L. 79–489, 60 Stat. 427, enacted July 5, 1946, codified at 15 U.S.C. § 1051 et seq. (15 U.S.C. ch. 22).

<sup>10</sup> H.R.1295 - Federal Trademark Dilution Act of 1995, 104th Congress (1995-1996).

<sup>11</sup> H.R.683 - Trademark Dilution Revision Act of 2006 109th Congress (2005-2006).

<sup>12</sup> Anti-Cybersquatting Consumer Protection Act (“ACPA”). 15 U.S.C. § 1125(d).



similar to, or dilutive of, a trademark or personal name”<sup>13</sup>. The law was designed to “thwart” “cybersquatters” who register Internet domain names containing trademarks with no intention of creating a legitimate web site, but instead plan to sell the domain name to the trademark owner or a third party”<sup>14</sup>.

As an increasing number of countries created a system of protection of inventions, trademarks, there was a need to harmonize the legislation on industrial property at the international level. Since the end of the XIX century a number of international agreements in the field of industrial property protection were signed - the Paris Convention of 1883<sup>15</sup>, the Madrid agreement on the international registration of marks of 1891<sup>16</sup>, etc. The latter itself makes the primary international system for facilitating the registration of trademarks in multiple jurisdictions around the world, as well as the Protocol Relating to the Madrid Agreement (1989)<sup>17</sup>. The law improves with the time and does not stop.

## **II. Economic aspects of trademarks in United States of America and Russian Federation**

Trademarks are important to both sellers and buyers around the globe. A trademark is a kind of symbol indicating who bears responsibility for this product. Homogeneous goods can be manufactured by different manufacturers, distributed by different sellers -- and those and others can use their trademarks.

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<sup>13</sup> Jane C. Ginsberg, Trademark and Unfair Competition Law 748 (Robert C. Clark et al. eds., Foundation Press 4th ed. 2007) (2001).

<sup>14</sup> 2-7A Gilson on Trademarks §7A.06, Trademark Cyberpiracy and Cybersquatting (Matthew Bender & Co. 2009).

<sup>15</sup> Paris Convention for the Protection of Industrial Property (1883) TRT/PARIS/008 (Convention de Paris pour la protection de la propriété industrielle (1883)).

<sup>16</sup> MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS of April 14, 1891, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Nice on June 15, 1957, and at Stockholm on July 14, 1967, and as amended on September 28, 1979 TRT/MADRID-GP/001.

<sup>17</sup> Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (as amended on November 12, 2007) TRT/MADRIDP-GP/001.

When choosing a product, the buyer is guided by the trademark. If the buyer was satisfied with the purchase next time, they will choose the product with that trademark.

A trademark serves several purposes. From the point of view of the person interested in buying, it serves as a guide when choosing a particular product. The choice is based on the expected properties of the product. In this case, the function of the trademark is to indicate to the buyer the presence of a particular quality of the goods.

Trademark helps to distinguish the goods or services of a particular enterprise from the homogeneous goods and services of other enterprises. In addition, the trademark allows you to determine the source of origin of the goods, as information about the owners of trademarks are included in the register of trademarks registered with the Patent office (to register the mark with the U.S. Patent and Trademark Office ("PTO") in United States of America and with the Russian Federal Service for Intellectual Property (e.g. a Russian governmental agency in charge of intellectual property) in Russian Federation.

One of the most important economic benefits for a trademark is advertising. Trademarks, through their connection with goods, provide information to the public about goods and services, helping to stimulate and maintain demand for them, and provide wide publicity to the enterprise and the goods. Thus, to sellers the trademark allows to allocate their production among the homogeneous production let out by other enterprises, to consumers-specifies that the goods are not a fake and possesses certain quality. A trademark is an important contribution to the economy of the enterprise, as it allows it to take a certain position in the market, based on the recognition of the trademark.

It is a mistake to think that the mere use of a trademark will provide an entrepreneur with ultra-high profits. This requires a whole range of measures aimed at gaining a stable position in the markets. However, it should be beared in mind that a significant place among these activities are

occupied by the trademark regulations. Therefore, one of the important aspects of commercial activities is to protect the trademark.

The United States of America and the Russian Federation enjoy the same economical and legal benefits from the trademark regulations, since they are members of the World Intellectual Property Organization (hereinafter referred to as “WIPO”), therefore they are both members of several WIPO-Administered Treaties. More precisely they are parties of such treaties related to the trademark law as the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (1957)<sup>18</sup>, the Trademark Law Treaty (Geneva, 1994)<sup>19</sup> and more modern Singapore Treaty on the Law of Trademarks (Singapore 2006)<sup>20</sup>, which was built on the Trademark Law Treaty (Geneva, 1994) has a wider scope of application and addresses more recent developments in the field of communication technologies.

### **III. The concept of “trademark” use and functions in the legislation of United States of America and Russian Federation**

The definition of “trademark” is not directly specified -unlike the types of the trademarks- in the fourth part of the Russian Civil Code, which is basically the main source of the trademark regulation in Russia. However Russian legislation officially use the definition of the 1974 Order “Regulations on trademarks”<sup>21</sup>. The 1974 Order itself is irrelevant due to

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<sup>18</sup> 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.

<sup>19</sup> Trademark Law Treaty and Regulations done at Geneva on October 27, 1994.

<sup>20</sup> 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).

<sup>21</sup> 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 (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»)).

the 2002 Order of Russian governmental agency in charge of intellectual property from 14.02.2002 N 25. 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.”. The types of the trademark are described in the 1974 Order, however the official version is one that is written in the Article 1482 of the fourth part of the Civil Code of 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.

In general, 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”<sup>22</sup>. The chapter 76 of the 4<sup>th</sup> part of Russian Civil Code includes the legal name of the legal entity (firm name), trademark and service mark, geographical indication (GI) and more recently the domain name, which is stated under the 2006 Federal Act "About information, information technologies and about information protection"<sup>23</sup>. Association of the specified objects in one related group of 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. 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.

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<sup>22</sup> "The civil code of the Russian Federation (part four)" of 18.12.2006 N 230-FZ (ed. of 18.07.2019) Chapter 76 ("Гражданский кодекс Российской Федерации (часть четвертая)" от 18.12.2006 N 230-ФЗ (ред. от 18.07.2019)).

<sup>23</sup> item 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) (п. 15 ст. 2 ФЗ № 149-ФЗ «Об информации, информационных технологиях и о защите информации» (в ред.от 28.07.2012)).

On the other hand, 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<sup>24</sup>.

Trade name, commercial name. The terms "trade name" and "commercial name" mean any name used by a person to identify his or her business or vocation.

The term "trademark" is well defined in the United States legislation in the §45 (15 U.S.C. §1127) Construction and definitions; intent of chapter. As the paragraph states:

"The term "trademark" includes any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown."

The US legislator puts the differences between such terms as the "service mark", "certification mark", "collective mark" and just a "mark".

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<sup>24</sup> Legal nature of rights to means of individualization Text of the scientific article on the specialty " State and law. Legal Sciences " - Sorokina A. I. p.8 (2011) (Правовая природа прав на средства индивидуализации Текст научной статьи по специальности «Государство и право. Юридические науки» - Сорокина А.И. стр.8 (2011)).

The term “mark” generalizes all mark-terms and the §45 (15 U.S.C. §1127) states:

“The term “mark” includes any trademark, service mark, collective mark, or certification mark.”

The term that cannot be found in the Russian trademark law is the “colorable imitation”. Which is defined by the §45 (15 U.S.C. §1127) as:

“The term “colorable imitation” includes any mark which so resembles a registered mark as to be likely to cause confusion or mistake or to deceive.”

There more other “mark” terms in the §45 (15 U.S.C. §1127), such as:

Service mark. “The term "service mark" means any word, name, symbol, or device, or any combination thereof —

(1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.

Certification mark. “The term "certification mark" means any word, name, symbol, or device, or any combination thereof—

(1) used by a person other than its owner, or (2) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this chapter, to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person’s goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.

Collective mark. “The term "collective mark" means a trademark or service mark—

(1) used by the members of a cooperative, an association, or other collective group or organization, or (2) which such cooperative, association, or other collective group or organization has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, and includes marks indicating membership in a union, an association, or other organization”

The functions of the trademark are quite equal for both nations. Trademarks represent the “goodwill” or reputation of the business and its products/services enjoy with the public. In general, the use of a trademark has several purposes. From the point of view of the person interested in buying, it serves as a guide when choosing a particular product. The choice is based on the expected properties of the goods, in this case, the function of the trademark is to indicate to the buyer the presence of a particular quality of the goods.

Another function of a trademark is to distinguish the goods or services of a particular manufacturer from similar goods and services of other manufacturers. A trademark can perform this function only if it has a distinctive ability. It might be difficult for the consumer to identify a particular manufacturer among many if the manufacturers have similar design marks, word marks or the composite marks.

In addition to the fact that the use of a trademark distinguishes the goods of a particular manufacturer from similar goods and services of other manufacturers, the trademark allows you to determine the source of origin of the goods, since information about the owners of trademarks is included in the Register of trademarks registered with the Patent office to register the mark with the U.S. Patent and Trademark Office ("PTO") in United States of America and with the Russian Federal Service for Intellectual

Property (e.g. a Russian governmental agency in charge of intellectual property) in Russian Federation).

Another important function of a trademark is advertising. Trademarks, through their connection with goods, provide information to the public about goods and services, helping to stimulate and maintain demand for them, and provide wide publicity to the enterprise and the goods.

The main legislative acts regulating relations related to the legal protection of trademarks is the Article 1515 of the Civil Code of the Russian Federation. In accordance with this law, legal protection of a trademark is granted on the basis of its state registration with the Patent office of Russia. The owner of the trademark has the exclusive right to use and dispose of the trademark, as well as to prohibit its use by other persons. Illegal use of a trademark or similar designation entails civil and (or) criminal liability. The Article 180 of the Criminal Code of Russian Federation<sup>25</sup> defines the condition of criminal liability and punishment and is applied only after proving that the copyright holder has been repeatedly caused major damage.

Under the US law the trademark owner has the right to sue for trademark infringement. Trademark infringement is when a party other than the trademark owner uses the mark without the trademark owner's permission.

The standard of a "likelihood of confusion" for consumers used to decide trademark infringement cases. If you are selling a good that is trademarked that you don't own or a mark that is similar to a trademark that you don't own, and buyers are likely to confuse your product with the product of the trademark owners, it likely constitutes trademark infringement. Infringement of a registered mark includes the use of "any reproduction, counterfeit, copy, or colorable imitation" in order to sell or advertise goods

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<sup>25</sup> 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).



or services, and which “is likely to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1114(1).

As it has already been mentioned, the owner of an unregistered trademark may be able to assert a claim under the Lanham Act’s “likelihood of confusion” standard, which prohibits the use of the mark in a way that is likely to deceive or cause confusion about the nature or origin of a product or service. 15 U.S.C. § 1125(a)(1).

In addition to trademark infringement, some trademark owners can and do sue for trademark dilution. A trademark dilution claim can only be brought against marks that are considered "famous".

As the 15 U.S.C. § 1125(c)(4) States : “For purposes of paragraph (1), “dilution by blurring” is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark. In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following: (i) The degree of similarity between the mark or trade name and the famous mark. (ii) The degree of inherent or acquired distinctiveness of the famous mark. (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark. (iv) The degree of recognition of the famous mark. (v) Whether the user of the mark or tradename intended to create an association with the famous mark. (vi) Any actual association between the mark or trade name and the famous mark. (C) For purposes of paragraph (1), “dilution by tarnishment” is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark”.

#### **IV. Trademark protection in the United States of America and Russian Federation**

*De jure* U.S. trademark protection is accomplished under the Commerce Clause of the U.S. Constitution. Today, trademarks are protected both under the federal registration system, codified as the Lanham Act (Title 15, Chapter 22, of the United States Code) and administered by the USPTO, as well as under state law. Both federally registered and common law trademarks may be protected under the Lanham Act; however, federal registration provides some advantages like shifting the burden of proof on the existence of a protectable mark to the registrant's favor in a trademark infringement suit. Federal regulations relating to trademarks are located within Title 37 of the Code of Federal Regulations. State laws regarding marks, whether statutory or common law, will vary by state and may be labeled as trademark or unfair competition law<sup>26</sup>.

Counterfeiting enforcement remains a top priority for the United States. The Trademark Counterfeiting Act of 1984 (Pub. L. No. 98-473, 98 Stat. 2178 (1984)) amended various sections of the Lanham Act and Title 18 of the U.S. Code (containing the criminal laws), codified provisions making it a federal offense to violate the Lanham Act, and established strict penalties for counterfeiters. The National Intellectual Property Rights Coordination Center (IPR Center) helps conduct counterfeiting investigations in collaboration with twenty three domestic and international agencies— including the Federal Bureau of Investigation and U.S. Customs and Border Protection. The White House Office of the U.S. Intellectual Property Enforcement Coordinator (IPEC) works with other agencies to develop the U.S. government's strategy to tackle the challenges posed by counterfeiting. Most of US companies are part of the International Trademark Association (INTA). INTA is the global association of trademark owners and professionals, dedicated to

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<sup>26</sup> <<https://wipo.int/en/info/outline/US>> “accessed 13.11.2019.

supporting trademarks and related intellectual property in order to protect consumers and to promote fair and effective commerce<sup>27</sup>.

*De facto*, one of the most famous US legal cases concerned the trademark protection is the *Already, LLC v. Nike, Inc.* (2013)<sup>28</sup>.

*Facts of the case*

Since 1982, Nike Inc. sold a shoe called the Air Force 1. The shoe has a distinctive appearance and Nike owns multiple federal trademark registrations for the shoe's design. In July 2009, Nike filed suit against *Already, LLC* for selling shoes that were confusingly similar to the Air Force 1 shoe. In November 2009, *Already* counterclaimed and requested cancellation of Nike's trademark on the basis that it interfered with *Already's* ability to continue selling its shoes.

To avoid further litigation, Nike provided *Already* with a covenant not to sue. The agreement promised that Nike would not pursue any legal action against *Already* with regard to trademark infringement. The District Court held a hearing to determine whether the covenant caused the court to lose subject matter jurisdiction over *Already's* counterclaims. Following the hearing, the District Court determined that it no longer had subject matter jurisdiction and dismissed the case. The U.S. Court of Appeals for the Second Circuit affirmed the decision, holding that the counterclaim alone did not create a case or controversy before the court; therefore, the court did not have subject matter jurisdiction over the claim.

*Held*

Chief Justice John G. Roberts, Jr., writing for a unanimous court, affirmed the Ninth Circuit. The Supreme Court held that Nike's covenant not to sue made the case moot. Nike met its burden to show that it "could not reasonably be expected" to resume trademark enforcement action against *Already*. The language of the covenant was broad enough that the Court

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<sup>27</sup> <<https://members.inta.org/corporate-member-list?reload=timezone>> "accessed 13.11.2019".

<sup>28</sup> *Already, LLC v. Nike, Inc.* (U.S. 133 S.Ct. 721) Jan. 9, 2013.

could not conceive of a shoe that would fall outside of its scope. The Court also rejected Already's assertion that dismissing the case would allow Nike to enforce invalid trademarks against any competitor by continually issuing covenants not to sue. Nike has an incentive not to do this because allowing many competitors to use Nike's marks, or confusingly similar ones, could lessen the strength of Nike's mark.

Justice Anthony M. Kennedy concurred, emphasizing that covenants not to sue should not be a first reaction to trademark litigation. Courts should be wary of large companies intentionally burdening smaller competitors with infringement actions only to turn around and promise not to sue after learning valuable future business information. A covenant not to sue should only terminate litigation when it meets the high burden required by in this case. Justice Clarence Thomas, Justice Samuel A. Alito, Jr., and Justice Sonia Sotomayor joined in the concurrence<sup>29</sup>.

As the case shows, in order to avoid further litigation Nike decided to conclude an agreement with its opponent. Another US case that shows the US trademark law in action is the Dairy Queen, Inc. v. Wood. (1962)<sup>30</sup>.

### *Facts*

Dairy Queen, Inc. (Defendant) and the McCullough partnership (Plaintiff) entered into a licensing contract in which Defendant agreed to pay Plaintiff \$150,000 to be able to use the trademark "Dairy Queen" trademark in parts of Pennsylvania. After Defendant defaulted on its payments to Plaintiff, Plaintiff terminated Defendant's right to use the trademark and sent Defendant a notice of such termination. Despite this termination letter, Defendant continued to use the trademark. Plaintiff sued Defendant for breach of contract. In the complaint, Plaintiff sought "an accounting to determine the exact amount of money owing by [Defendant] and a judgment for that amount." In the complaint, Plaintiff also demanded a jury trial. However, Defendant filed a motion to strike the demand for a

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<sup>29</sup> Legal Information Institute, LII; text 11-982

<sup>30</sup> Dairy Queen, Inc. v. Wood. 369 U.S. 469 (1962).

jury trial. The federal district court in Pennsylvania (Judge Wood) granted Defendant's motion to strike because Plaintiff's lawsuit was "purely equitable." The federal district court based its decision on the fact that Plaintiff's complaint sought "accounting" terms, rather than for damages. Plaintiff appealed to Court of Appeals for the Third Circuit, which affirmed the district court's decision. The United States Supreme Court granted certiorari.

*Issue*

Does the diction in a complaint dictate whether the claim is a legal issue or an equitable issue when such a claim is traditionally brought as a legal issue for money damages ?

*Held*

No. The diction in a complaint does not dictate whether the claim is a legal issue or an equitable issue when such a claim is traditionally brought as a legal issue for money damages. In this case, Plaintiff was seeking money damages after Defendant breached their contract. As such, Plaintiff is entitled to have a trial by jury on the legal issues in the case. The United States Supreme Court reversed the lower court's decision.

As the case shows, a jury is competent to decide the legal issue of damages stemming from breach of contract or trademark infringement, so long as the accounts between the parties are not so complicated that only a court of equity could untangle such accounts<sup>31</sup>.

The relatively recent case concerned the trademark protection bullying in US is the Forever 21, Inc. v. Adidas America Inc., and Adidas AG, (2017)<sup>32</sup>.

The case is concerned the complaint for declaratory judgement of (1) non-infringement of trademarks and (2) non-breach of settlement agreement.

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<sup>31</sup> <<https://www.casebriefs.com/blog/law/civil-procedure/civil-procedure-keyed-to-glannon/the-rights-to-jury-trial/dairy-queen-inc-v-wood/>> "accessed 18.11.2019".

<sup>32</sup> Forever 21, Inc. v. Adidas America Inc., and Adidas AG , Case No. 2:17-cv-01752.

*Facts*<sup>33</sup>

Years ago, Adidas managed to secure federal trademark registrations for use of three, parallel stripes placed in specific locations on certain shoes and clothing. Adidas is well known for aggressively enforcing its perceived trademark rights against others, suing and threatening suit against retailers and manufacturers of footwear and clothing who use three stripes in a manner that Adidas believes is likely to cause confusion.

But Adidas has taken its claims even further—too far—essentially asserting that no item of clothing can have any number of stripes in any location without infringing Adidas’s trademarks. To this end, Adidas has sued clothing and footwear manufacturers who have used two stripes. It has sued those who use four. It has sued over stripe patterns involving multiple widths and colors, and it has sued over garments Adidas is not known for making. It has also threatened to sue many others on similar claims.

Forever 21, a well-known, international retailer of specialty clothing, headquartered in Los Angeles, has fallen victim to Adidas’s threats on more than one occasion. Since 2006, Adidas has commenced a pattern of complaining about striped apparel sold by Forever 21, and it has steadfastly increased its threats to encompass virtually any item of clothing with decorative stripes. Most recently, in a letter dated February 24, 2017, Adidas’s counsel has again threatened to sue Forever 21 over its use of stripes on six items of clothing. The stripes on the Forever 21 clothing at issue are merely ornamental and decorative. None of these items of clothing display any of Adidas’s three-stripe marks, and no consumer is likely to believe any of these items are manufactured by, or otherwise associated with, Adidas.

Tired of operating with a cloud over its head with regard to its right to design and sell clothing items bearing ornamental/decorative stripes, and

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<sup>33</sup> KattenMuchinRosenman LLP, 2029 Century Park East, Suite 2600, Los Angeles, CA 90067-3012  
< <https://enriqueortegaburgos.com/wp-content/uploads/2019/07/ANEXO-5.pdf> > “accessed 18.11.2019”.

unwilling to stop doing something it has every right to do and pay a bully to leave it alone, Forever 21 has decided that enough is enough. Forever 21 is not infringing any Adidas trademark and has not breached any agreements with Adidas. This matter is ripe for a declaratory judgment.

On or around February 28, 2017, Forever 21 received a letter from an attorney at Kilpatrick Townsend on behalf of Adidas America, Inc., and Adidas AG. The letter was dated February 24, 2017, and generally demanded that Forever 21 discontinue all sales of certain clothing items containing stripes. (Adidas's February 24 letter will be referred to throughout this Complaint as the "No Stripes Letter.>"). In the No Stripes Letter, Adidas asserted that each of the clothing items pictured above (the "Striped Clothing") infringes Adidas's rights in various federal trademark registrations for the use of three stripes on clothing items.

In addition to demanding that Forever 21 "immediately discontinue" all sales of the Striped Clothing and any other clothing "bearing confusingly similar imitations of the Three-Stripe Mark," Adidas demanded in its No Stripes Letter that Forever 21 provide an accounting of all Striped Clothing sold and in inventory. Adidas further threatened to file a lawsuit against Forever 21 in the United States District Court for the District of Oregon, as it did in 2015, if Forever 21 did not comply with Adidas's demands.

#### *Jurisdiction and venue*

This Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. § 2201 and 28 U.S.C. § 1338 because Count 1 is for declaratory judgment for claims involving trademarks and because an actual case or controversy exists between Adidas and Forever 21. The Court has supplemental jurisdiction over Count 2 pursuant to 28 U.S.C. § 2201 and 28 U.S.C. § 1367 because the claim asserted therein is so related to the claim asserted in Count 1 that it forms part of the same case or controversy.

This Court has personal jurisdiction over Adidas AG and Adidas America, Inc., because they conduct business in the state of California and because

they have threatened legal action against a company that is headquartered in Los Angeles, California.

Venue is appropriate in this district pursuant to 28 U.S.C. § 1391(b) because a substantial part of the events or omissions giving rise to Forever 21's claim have occurred in this district and a substantial part of the property that is subject to the action is situated in this district.

*Prayer for relief*

Wherefore, Forever 21 prays for the following relief: 1.A judgment declaring that (a) the stripes on Forever 21's Striped Clothing is ornamental and does not serve a source-identifying function, (b) Forever 21's Striped Clothing does not infringe any trademark rights owned by Adidas, and (c) Forever 21's sale of the Striped Clothing does not constitute a breach of any contract entered into by Forever 21 and any Adidas entity;2.An award of costs in this action;3.A finding that this case is "exceptional" within the meaning of 15 U.S.C. § 1117 and a corresponding award of attorneys' fees in Forever 21's favor; and4.For such other, further, or different relief as the Court deems just and proper."

*The case is still ongoing*

*De jure*, the Russian trademark law contains many legal mechanisms for the trademark protection. Those mechanisms include the Article 1515 of the Civil Code of the Russian Federation<sup>34</sup> for the civil liability, the Civil Code is often used as the counterfeit enforcement; the Article 180 of the Criminal Code of Russian Federation<sup>35</sup>, if the act against the trademark owner was committed repeatedly or caused major damage and Article

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<sup>34</sup> 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 (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).

<sup>35</sup> Part 2 of the Criminal code of the Russian federation 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) (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)).



14.10 Administrative code of the Russian Federation<sup>36</sup> for the administrative liability. Each measure depends on the severity of the offense.

*De facto*, one of the most popular trademark protection case in the Belgorod oblast of Russia is the Case No. A08-5959/2016 from 19 April 2017 <sup>37</sup>, that briefly states the following :

*Facts*

Plaintiff - Carte Blanche Greetings Limited has addressed in Arbitration court of the Belgorod region with the claim to the sole proprietor Davydova Y. C. for the recovery of compensation in the amount of 10 000 rubles for infringement of exclusive trademark rights, registered under number 861543 and for the paid state fee for consideration of the claim in the amount of 2 000 rubles and expenses for payment of postal services in the amount of 87.5 rubles.

Carte Blanche Greetings Limited has the exclusive right to the trademark with the image of the Teddy bear "Tatty Teddy "(the designation placed on the paws of the bear's head with a blue nose and a patch). The right to the specified trademark is confirmed by the claimant, the certificates of registration at the World Intellectual Property Organization presented in case materials-are registered 02.04.2005. Validity of registration 02.04.2015 MKTU: 16.28 (registration number 861543). The plaintiff in support of the claim pointed out, 13.06.2015 in the store "Bouquet and chocolate", located at the address: Belgorod region, Belgorod, Belgorod

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<sup>36</sup> 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) (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)).

<sup>37</sup> Decision of 19 April 2017 in case no. A08-5959/2016 The arbitration court of Belgorod region (Belgorod region as) (Решение от 19 апреля 2017 г. по делу № А08-5959/2016 Арбитражный суд Белгородской области (АС Белгородской области)).

Avenue, 67, sole proprietor Davydova Julia Sergeevna sold counterfeit goods-soft toy bear with gray hair.

In confirmation of the above, the applicant submitted a document (leaflet) with the details inherent in the sales receipt, terminal check from 13.06.2015 in the amount of 1 490 rubles.

At sale of counterfeit goods the defendant issued and provided the commodity check in case materials No. A08-4610/2015.

As pointed out by the plaintiff, the fact of sale of goods recorded video produced by the representative of the plaintiff in the order of articles 12 and 14 of the Civil code of the Russian Federation.

The claimant believes that the defendant violated the exclusive rights of the plaintiff to the trademark. Violation was expressed in use of the trademark registered under No. 861543 by the offer for sale and realization of the goods similar to degree of confusion with the specified trademarks.

*Held*

Having assessed the evidence available in the case materials, the court considers that the plaintiff's claims are unfounded and illegal, because of the enforced decision of the appellation instance of 17.02.2016 (case no. A08-4610/2015), which had previously partially satisfied the claims of same plaintiff.

Sale of goods by the defendant in an outlet containing the images similar to degree of confusion with disputable trademarks of the claimant on the basis of consecutive transactions of purchase and sale, represents one violation for which defendant has already been previously brought to the civil liability. Therefore, the repeated appeal of the plaintiff to the court with a claim to recover from the defendant another amount of compensation in this case for the same violation is unlawful.

In such circumstances, the court considers that the bases for satisfaction of requirements of the claimant about collecting of indemnification at a rate of 10 000 rubles for infringement of exclusive trademark rights, registered

under number 861543 paid the state fee for consideration of the claim in the amount of 2,000 rubles and expenses for payment of postal services in the amount of 87.5 rubles are absent.

According to article 110 of the Arbitration procedure code of the Russian Federation judicial costs are charged by the plaintiff.

In this case it is obvious that the rights of the trademark owner were reserved. However, the trademark owner themselves has violated the law and filed the lawsuit with the claim that has already been previously enforced. In the previous court's decision, the plaintiff's claims have been partially satisfied".

Another typical case in Russia is the Decision from 4<sup>th</sup> June 2019 in case no. A65-4100/2019 by the Arbitration Court of the Republic of Tatarstan<sup>38</sup>.

#### *Facts*

The plaintiff-the Company "Robert Bosch" GmbH, appealed to the Arbitration court of the Republic of Tatarstan with a claim to recover from the entrepreneur Davlyatov F. G. 50,000 rubles of compensation for violation of exclusive rights to the trademark.

the plaintiff is the owner of the exclusive right to trademark No. 39873 on the certificate of the Russian Federation.

The company's right to these trademarks is confirmed by the certificate presented in the case file, issued by the Committee for inventions and discoveries under the Council of Ministers of the USSR dated 28.05.1970, with the priority date of 04.08.1969, valid until 04.08.2019.

Employees of the plaintiff 08.08.2016 g. in the outlet located at the address: Kazan, Orenburg passage, shop "Krepezh" was established and recorded the fact of the offer for sale and retail sale on behalf of sole

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<sup>38</sup> Decision of 4 June 2019 in case no. A65-4100/2019 ; Arbitration court of the Republic of Tatarstan (as of the Republic of Tatarstan) (Решение от 4 июня 2019 г. по делу № А65-4100/2019; Арбитражный суд Республики Татарстан (АС Республики Татарстан)).

proprietor Davlyatov F. G. of goods-1 cloth for the electric jigsaw, having technical signs of counterfeiting.

The fact of the implementation of the said goods is confirmed by receipt from 08.08.2016 for the sum of 76 rubles which contains information on the name and value of the goods sold, the sale date, and name, registered taxpayer number of the sole proprietor – defendant (L. D. 7, 61); by counterfeit goods, presented by the plaintiff in the case, as well as a video (CD-ROM attached to the case) made for the purposes and on the basis of self-defense civil rights in accordance with article 12 and 14 of the Civil Code of Russian Federation.

This product contains designations similar to the degree of confusion with the trademark number 39873.

According to the plaintiff, that the defendant's sale of the goods in the package with the printed word and image symbols "BOSCH", similar to the point of confusion with the trademark Number 39873, violate the plaintiff's exclusive rights in the specified marks.

In order to pre-trial settlement of the dispute by the plaintiff, the defendant sent a claim (ex. from 27.12.2018 g. l. d. 10, evidence of the direction-l. d. 11) with the requirement for payment of compensation for violation of the exclusive rights of the plaintiff to trademarks, which is left by the defendant without satisfaction.

These circumstances served as the basis for the appeal to the arbitration court with this claim.

### *Held*

In accordance with article 1250 of the Civil Code of Russian Federation, intellectual rights are protected in the ways provided for by the Civil Code of Russian Federation, taking into account the substance of the violated right and the consequences of violation of this right.

Under clause 1 part 4 article 1515 of the Civil Code of Russian Federation, the rightsholder is entitled to demand at his option from the infringer

instead of remuneration for damages payment of compensation: in the amount from ten thousand rubles to five million rubles determined at the discretion of the court based on the nature of the violation.

In point 43.2 of the joint Resolution of Plenum of the Supreme Court of the Russian Federation and Plenum of the Supreme Arbitration Court of the Russian Federation of 26.03.2009 N 5/29 "About some questions which arose in connection with introduction of part four of the Civil code of the Russian Federation" it is explained that compensation is subject to collecting at proof of the fact of violation.

Based on the above law and the provisions of part 1 of article 65 of the Arbitration Procedure Code of the Russian Federation, a subject of proof at the request of the protection of trademark rights include the following: the fact of belonging to the claimant of said right and fact of its breach by the defendant by using the trademark or designation similar with it to the point of confusion.

The case file confirms that the plaintiff has exclusive rights to the disputed trademark in respect of which its violation was recorded by the defendant.

Also presented is evidence-cloth for electric jigsaw "BOSCH", purchased from the defendant 08.08.2016.

Thus, the evidence presented in the case file, in its totality and relationship, fully confirm the fact of realization by the defendant of counterfeit goods-cloth for electric jigsaw "BOSCH".

Receipt from 08.08.2016 contains all the details required for this type of document and allows to determine the purchased goods as the document date, product name, quantity, price one instance, the signature of the seller, specifying taxpayer registered number of the seller (defendant).

Taking into account stated, the court considers that the claimant proved the fact of violation of its exclusive rights to a trademark by actions of the Respondent on sale of counterfeit goods.

Proofs of representation to the Respondent of the right to introduction into civil circulation of the disputable goods in accordance with the established procedure (existence of the license agreement, etc.) in case materials are not available.

The Court held to fully satisfy the claim. To collect from the sole proprietor Davlyatov Fanis Gilemkhanovich (OGRN 305167513800013 INN 163500021397), Republic of Tatarstan, Sabinsky district, village Evlashtau in favor of the Company "Robert Bosch" GmbH, Gerlingen, Germany (registration number HRB 14000) 10000 rubles for violation of exclusive rights to the trademark number 39873, 2000 rubles of state duty costs, 76 rubles of costs for the purchase of disputed goods, 92 rubles of postage.”

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 important part of the corporate identity of any enterprise. At its creation and registration, it is necessary to observe all legal norms in any country.

To sum up, I would like to draw attention to possible ways to improve trademark protection mechanisms and the mechanisms of protection against cybersquatting.

Firstly, the national laws of the United States and Russia need changes. Both legal systems do not contain a definition of cybersquatting, so the most important goal for legislatures is to develop an adequate definition. In the Russian legal system, there are no special rules aimed at combating cybersquatting. The US legal system has managed to develop appropriate rules, but some of them still need clarification to avoid abuse of imperfect wording and misinterpretation.

Secondly, the judicial practice of both countries 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.

Thirdly, it is pretty obvious that WIPO harmonizes the trademark law throughout the globe. At least, two of the largest states in the world have quite equal legal tools for the trademark regulation. That gives the wish for the further simplification of the court proceedings in this sphere and for the better protection of trademarks worldwide.

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