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BBC recovers its TOP GEAR trademark after two-year battle

Russian Federation - [A.Zalesov & Partners](#)

- **The IP Court has overturned an earlier decision in which it had confirmed the invalidation of the BBC's TOP GEAR mark**
- **The court found that the applicant for invalidation had filed the action only to cause harm to the BBC**
- **The decision provides important guidelines concerning the cases in which an invalidity action should be refused**

On 28 October 2019 the Russian Intellectual Property Court (IP Court) overturned its earlier decision and agreed with the British Broadcasting Corporation (BBC) that its TOP GEAR trademark could not be invalidated by an individual who had purchased a similar earlier trademark from a company under liquidation without any real intention of using it.

Background

In 2017 an individual entrepreneur, Mr Ibatoulin, filed an invalidation action against the BBC's TOP GEAR trademark (RU538851), with priority as of 2013. Ibatoulin relied on the earlier trademark TOP GEAR (RU339837), with priority as of 2005, which he bought in 2016 from a company under liquidation.

The BBC filed a cancellation action against this earlier mark on the ground of non-use, but Ibatoulin filed a request with Rospatent for the early termination of this trademark, which made it impossible for the BBC to cancel the mark or invalidate it. Meanwhile, the Russian Federal Service for Intellectual Property (Rospatent) had invalidated the BBC's trademark and Ibatoulin had registered another TOP GEAR trademark, which he tried to sell to the BBC.

In January 2019 the IP Court [upheld](#) Rospatent's decision and held that the invalidation of the BBC's trademark was lawful.

The BBC disagreed and filed a cassation appeal. On 27 May 2019 the Presidium of the IP Court held that the findings of the IP Court were wrong and returned the case back to the lower instance.

Second IP Court decision

Considering the case for a second time, and relying on the guidelines given by the Presidium, the IP Court gave important guidelines concerning the cases in which an invalidity action should be refused. If it is established that one of the parties acted in bad faith, the court, taking into account the nature and consequences of such behaviour, must:

- refuse to protect that party's rights in whole or in part; and
- apply other measures to protect the interests of the good-faith party or third parties against such unfair conduct.

The IP Court stated as follows:

- the BBC's TOP GEAR trademark has a high level of fame and is associated directly with its owner, which Ibatoulin should have been aware of;
- Ibatoulin acquired the earlier trademark from an entity under liquidation;
- Ibatoulin does not carry out broadcasting or similar services; and
- Ibatoulin terminated his earlier trademark early, shortly after Rospatent's decision on the invalidity of the BBC's trademark.

The court thus found that Ibatoulin had no real intention of using his trademark for his business and had filed the invalidation action only to cause harm to the BBC.

The existence of a right (in this case, the right of the holder of the senior trademark to file an invalidation against the younger trademark) does not, in itself, mean that the holder of the senior trademark is not abusing its right by using such right solely with the intention of harming another party. Thus, as the court found that Ibatoulin had abused his right to file an invalidation action against the BBC's trademark, the decision of Rospatent to uphold the invalidation action should be cancelled.

Also important for practice is the court's finding that, where the earlier trademark is not in use, there cannot be confusion with the later trademark and, therefore, there is no ground for the invalidation of the later trademark.

Taking into account Ibatoulin's behaviour, the IP Court cancelled Rospatent's decision and ruled that the latter should reinstate the TOP GEAR trademark in Russia.

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