**Overview of jurisprudence on the overlap between copyright and trademarks, including new types of marks**

In accordance with the legislation in force in the Russian Federation (Article 7(3)(iii) of the Law of the Russian Federation on Trademarks, Service Marks and Appellations of Origin (hereinafter the Law on Trademarks), designations identical to the name of a work of science, literature or art, or character or quotation from such a work, or a fragment thereof, known in the Russian Federation on the application filing date, may not be registered as trademarks, without the consent of the copyright owner or its lawful successor, if the rights in these works have arisen earlier than the priority date of a registered trademark.

In this regard, in accordance with Article 12 of the Law on Trademarks, in the case of an examination of a claimed designation for the purposes of its registration, an examination of its compliance with the requirements of Article 7(3) of the Law shall not be conducted, i.e. of the absence of an overlap with copyright. However, the Law on Trademarks establishes the possibility for third parties to challenge the legality of such a registration in accordance with administrative procedure in the Chamber of Patent Disputes, as provided for by legislation.

An analysis of jurisprudence, which has been examined by the courts of arbitration of various authorities, where decisions taken during the pre-court procedure by the Chamber of Patent Disputes – the administrative authority for the examination of disputes – gives rise to the following comments.

In the cases identified, the courts have recognized as lawful decisions taken by the Chamber of Patent Disputes, relating to appeals by third parties - copyright owners or their lawful successors, to whom exclusive rights in copyright subject matter belong.

In this connection, firstly verification or, where necessary, establishment (clarification of the existence) of copyright in the corresponding copyright subject matter has taken place. Secondly, the courts have examined the legality of the registration of disputed trademarks.

In practice, courts operate on the basis that a copyright infringement is the use as a trademark of protectable subject matter, without the consent of the owner(s) of the right in this subject matter, whereby such use may be creative (reprocessing) or non-creative (direct borrowing).

When examining disputes relating to the use as a registered trademark of copyright subject matter by third parties, the courts apply all the legislative standards relating to trademarks and copyright legislation.

In accordance with Article 16(2) of Law No. 5351-I of the Russian Federation on Copyright and Related Rights (Law on Copyright) of July 9, 1993, an author's exclusive right to use a work means the right to reproduce or allow the reproduction of a work of copyright (the right to reproduction).

Pursuant to Article 12(1) of the Law on Copyright, the copyright in an adaptation or other work reprocessed by the authors of other derived works shall belong to those authors.

The author of a derived work shall avail himself of the copyright in the work which he has created, provided that he respects the copyright in a work to be adapted or other work to be reprocessed.

By applying the above legislative standards in the field of copyright, the courts shall recognize as invalid the grant of legal protection for trademarks constituting designations identical to (or including) copyright subject matter.

The following examples illustrate the jurisprudence.

1. The illustration of a bird under the title "Ptitsa Gzhel" was created by the artists T.V. Khazovaya and V.N. Khazovoi, in the performance of their professional duties for the public company "Gzhel'" and published in a catalog of art objects in 1988. Subsequently, the public company "Gzhel'" assigned to the public limited company "Gzhel" the proprietary copyright to use the illustration of "Ptitsa Gzhel", in accordance with the agreement of November 29, 1991.

As the rights owner of the exclusive proprietary copyright in a work of fine art, the public limited company "Gzhel" considered that its rights had been infringed when the trademark was registered in 1993, in another person's name.

As a figurative element, illustrations of birds were used as a registered trademark, reproducing directly as a mirror image a fragment of the above works of art, without the consent of the copyright owner.

A court recognized as unlawful the grant of legal protection for the trademark.

2. A similar approach was also adopted in relation to settling a dispute which arose as a result of the registration of the trademark "WINNIE". The subject of discussion by the court was the question of the authorship of B. Zakhoder of the name of the character "Winnie" in the work "Winnie the Pooh and the others", which became famous to Russian readers thanks to the translation done by Mr. Zakhoder of the work by the author A.A. Milne "Winnie the Pooh and the House at Pooh Corner". Firstly, the court stated that the word "Winnie" was introduced into the Russian lexicon by Mr. Zakhoder, after the publication of his book "Winnie the Pooh and the others", and the literary translation is a product of creative activity and cannot be wholly identical to the original. In this connection, the court concluded that in reality Mr. Zakhoder had the copyright in the

character Winnie (Winnie the Pooh, Pooh) as part of the derived work which he had created. The registration in another person's name of a trademark including or representing, in particular, the verbal element "Winnie" without the permission of the author's successor – G. Zakhoder – is unlawful.

3. In practice, Russian courts have examined such cases concerning the infringement of the copyright of foreign persons.

In 1994, the Russian Federation acceded to the Berne Convention on the Protection of Literary and Artistic Works, 1971 version, and the Universal Copyright Convention, 1971 version.

In accordance with Article II(1) of the Universal Convention, "Published works of nationals of any Contracting State and works first published in that State shall enjoy in each other Contracting State the same protection as that other State accords to works of its nationals first published in its own territory, as well as the protection specially granted by this Convention".

On the basis of the above standard, a dispute arising between the German firm "Carl Bechem GmbH" and the rights owner of the trademark with the verbal element "HESSOL" (Certificate No. 166934) – the Russian public limited company "Prognoz-Holding Advertising Information Center" - was settled.

In taking a decision, the court took into account the documentary evidence – an affidavit by Mr. Ronald Neumeister, a German citizen, according to which the illustration of a lion reproduced in the disputed trademark was produced by his creative effort. In this connection, the owner of the exclusive copyright in the given work, as a result of mutual labor relations, is the author's employer – the advertising agency Neumeister GmbH, which subsequently transferred the exclusive copyright in the named work, according to the author's agreement, to a third person – the firm "HESSOL Hessische Ölwerke A. Fischer und Sohn". In accordance with the court's decision, the registration of a trademark reproducing the name of a character from a work of literature is recognized as invalid.

As regards non-traditional types of marks, in the preparation of this material cases of the examination by courts, of disputes relating to the overlap of copyright and the rights in non-traditional trademarks, have not been identified.