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The Specifics of the Application of Article 6.septies of the Paris Convention for the Protection of Industrial Property in Russia

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Aleksey RobinovVash Patent, AIPPI Russia



Evgenii KolesovVash Patent, AIPPI Russia

According to Clause (1) of the Article 6septies of the Convention for the Protection of Industrial Property of March 20, 1883 (hereinafter – the Paris Convention, the Convention): “If the agent or representative of the person who is the proprietor of a mark in one of the countries of the Union applies, without such proprietor’s authorization, for the registration of the mark in his own name, in one or more

countries of the Union, the proprietor shall be entitled to oppose the registration applied for or demand its cancellation or, if the law of the country so allows, the assignment in his favor of the said registration, unless such agent or representative justifies his action”.

As it seems from the content of this Article, its purpose is the protection of the interests of the Proprietor, whose trademark, protected in one of the Paris Convention member states, was registered or applied in another member state by his agent or representative without the Proprietor’s authorization.

In the practice of applying the Article 6septies of the Paris Convention in the Russian Federation, the following questions arose:

- Does Article 6septies of the Paris Convention imply a ban on registering the same (identical) trademark or does it also apply to confusingly similar marks?
- Are the terms “Agent” or “Representative” used in a narrow legal sense (as a party to an agency agreement or a representative under a power of attorney) or in a broader sense as a person(s) acting on behalf of the trademark holder by virtue of agreements or established business practice?
- Does the Article 6septies extend to persons who are affiliated with the Agent or the Proprietor of the trademark?

1) Regarding the issue of identity or confusing similarity of the trademarks of the Proprietor and his agent (representative) one may imply from the literal reading of paragraph (1) of Art. 6septies of the Paris Convention, that Article 6septies applies only to cases where the agent’s trademark is identical to the one of the original proprietor (at which may point the words “the registration of **the mark**”).

At the same time, it is obvious that the registration of non-identical, but confusingly similar trademark by an agent or representative without the permission of the proprietor will also violate the interests of the original trademark holder.

The same conclusions follow from Russian judicial practice on the application of Article 6septies of the Paris Convention.

In particular, on June 28, 2006, the Ninth Arbitration Court of Appeal, overturning the decision of the court of the first instance in case No. A40-50466/05-27-237 (hereinafter the “Bullerjan Buleryan” trademark case) concluded that the registration of trademarks identical or confusingly similar to the trademarks of the counterparty without the consent of the latter and in contradiction with the terms of the agreement concluded between the parties violates the principle of proper performance of contractual obligations, enshrined in Art. 309 of the Civil Code of

the Russian Federation. In addition, as the appellate court emphasized, such registration may lead to a confusion regarding the goods, or the industrial or commercial activities of the parties to the agreement, which, in turn, is a violation of Article. 10bis of the Paris Convention. A similar position was also taken by the appellate and cassation courts in case No. A40-56183/2008, which concerned the “TOPAS TOPAS” trademark.

Consequently, the Court for Intellectual Property Rights, established in 2013, took the same approach. In particular, as it follows from the decision of 21.04.2021 in case No. SIP-620/2020:

“To recognize the granting of legal protection to a trademark as invalid on the basis of Article 6septies of the Paris Convention, taking into account the established law enforcement practice, not only the identity of the compared designations is taken into account, but also a high degree of similarity, a special case of which is the use of the transliteration technique” (the corresponding legal position was also previously expressed in the ruling of the Intellectual Property Court of 27.11.2017 No. SIP-58/2017).

Therefore, in applying Article 6septies of the Paris Convention, the Russian courts take into account not only the identity, but also the similarity of the trademarks of the Proprietor and his agent or representative.

2) In regards to the question of how broadly should the terms “agent” and “representative” of Article 6septies of the Paris Convention be interpreted the Russian courts at a certain stage had to resort to an expanded interpretation of the provisions of the Paris Convention.

As, in particular, the Ninth Arbitration Court of Appeal has pointed out in the above-mentioned “Bullerjan Булеян” trademark case: “... the court turned to the preparatory materials used during the Lisbon Conference held on October 31, 1958, which testified to the fact that when interpreting the terms “agent” and “representative” one should proceed not from the narrow legal meaning of these terms inherent in the branches of civil and commercial law, but from a definition that would cover distributors of the products of the owner of the trademark, who are in certain contractual relations with it.” A similar position also follows from case No. A40-56183/2008 on the trademark “ТОПАС/ТОPAS”.

This approach was also supported by the Court for the Intellectual Property Rights. Thus, as it follows from the decision of 01.03.2022 in case No. SIP-225/2020, “The Intellectual Property Court believes that when applying Article 6-septies of the Paris Convention, agency and representative relations between the owner of a disputed trademark and a trademark in a state party to the Paris

Convention are interpreted broadly and include any contractual relations for the sale of goods marked with the disputed designation on the territory of the Russian Federation.”

In its decision of 30.01.2025 in case No. SIP-1196/2023, the Court for the Intellectual Property Rights, based on the evidence presented in the case, had recognized the existence of actual representative relations between the parties in absence of a written agreement between them, taking into account the previously adopted approach regarding the broad interpretation of the concept of “agency and representative relations” in relation to the provisions of Article 6septies of the Paris Convention.

Thus, Russian courts broadly interpret the terms “agent” and “representative” used in Article 6septies of the Paris Convention, not limiting themselves to understanding them in a narrow legal sense.

3) The question of whether Article 6septies of the Paris Convention extends to the persons affiliated with the trademark holder or his agent (representative) in the territory of Russia was relatively recently resolved in the practice of Russian courts and the patent office (Rospatent).

For the first time, the affiliation of persons on the side of the agent (representative) of the copyright holder was taken into account by the Court for the Intellectual Property Rights in its ruling on the case SIP-379/2015. In that case, the court considered that it is possible to cancel a trademark registered in the name of a person who is the founder of the company being an agent of a foreign trademark holder in Russia.

Subsequently, this approach was also adopted by the Russian patent office (Rospatent). In its decision of 20.03.2019, the Rospatent canceled the registration of trademark No. 358553 “DUROSTONE DUROSTONE” due to the fact that it was registered in the name of a person affiliated with an agent company of the holder of a similar trademark “DUROSTONE”, originally registered in Germany. At the same time, Rospatent indicated that the paragraph (1) of Article 6septies of the Paris Convention applies to a person who is affiliated with the agent of the copyright holder, since these persons may act in concert. The Court for the Intellectual Property Rights in the case No. SIP-236/2019 supported the position of Rospatent, leaving the above decision in force.

It should be noted that Russian courts, when applying Article 6septies of the Paris Convention, also take into account the presence of affiliation on the part of the original trademark holder.

In particular, as it follows from the decision of the Court for the Intellectual Property Rights dated 30.01.2025 under the case No. SIP-1196/2023 (“MAST” trademark case), the exclusive licensee of the trademark holder in the territory of one of the member states of the Paris Convention Union (China) has the right to challenge the registration of a trademark applied by the agent of the trademark holder in Russia under Article 6septies of the Paris Convention.

The above approach allows to protect the interests of the original trademark holder in a case when the agent or representative applies trademark not in his own name, but resorts to the help of third parties, as well as in a case when the contested trademark is registered in the name of an agent of a person that is affiliated with the original trademark holder.

Thus, as the practice of application Article 6septies of the Paris Convention in Russia shows, the courts and the Patent Office quite broadly interpret the concepts used in it, including “agent or representative”, thereby allowing to ensure the broadest protection of the interests of foreign trademark holders.