

**CRITERIA FOR ESTABLISHING WELL-KNOWN TRADEMARK STATUS**

Khoshimova Yulduzhon Olimjonovna,  
PhD Student at Tashkent State University of Law  
E-mail: [yulduzhon.khoshimova@mail.ru](mailto:yulduzhon.khoshimova@mail.ru)

**ABSTRACT**

This research examines the social relations arising from the submission of an application by a right holder or applicant to the Ministry of Justice of the Republic of Uzbekistan for the recognition of a trademark or service mark as well-known within the territory of the Republic of Uzbekistan. The subject of the study encompasses the norms of existing civil legislation, subordinate regulatory acts governing the specifics of recognizing a trademark or designation as well-known, scholarly works, and materials from law enforcement practice. Through analysis of law enforcement practice, novel criteria, not explicitly codified by the legislator, have been identified: the longevity of business operations in the market; the promotion of the trademark or designation through the most popular and accessible communication channels; a common source of origin for the goods; a defined market share; and the conferral of specific awards.

**Keywords:** Well-Known Trademark Status, Criteria, Trademark, Designation, Appellate Board, Paris Convention, Administrative Regulations.

**Introduction**

Trademarks constitute critical intangible assets for any company or business, and their value is significantly amplified when the right holder seeks and obtains official recognition of the trademark as well-known from the competent authority. In essence, possessing a certificate of well-known trademark status enhances a company's reputation among consumers, drives increased consumer demand, and facilitates the conclusion of major contracts. In particular, it substantially increases the likelihood of success, enabling a broader scope of legal protection extending to all goods and services.

The definition of a well-known trademark is stipulated in Article 32<sup>1</sup> of the Law of the Republic of Uzbekistan "On Trademarks, Service Marks, and Appellations of Origin": "Upon application by a legal entity or individual, a trademark may be recognized in the Republic of Uzbekistan as a well-known trademark if it is protected within the territory of the Republic of Uzbekistan based on its registration, a trademark protected within the territory of the Republic of Uzbekistan without registration in accordance with an international treaty of the Republic of Uzbekistan, as well as a designation used as a trademark but not enjoying legal protection within the territory of the Republic of Uzbekistan, provided that such trademarks or designations, as a result of their intensive use, have become widely known in the Republic of Uzbekistan among the relevant consumers in relation to the goods of that person as of the date specified in the application[1].

Legal protection for well-known trademarks is enshrined in Article 32<sup>2</sup> of the Law of the Republic of Uzbekistan "On Trademarks, Service Marks, and Appellations of Origin," which

stipulates that "legal protection for a well-known trademark shall be granted in accordance with the procedure established by law, based on a decision of the Appellate Board. A trademark recognized as well-known shall be entered by the Ministry into the List of Well-Known Trademarks. Information pertaining to the well-known trademark shall be published in the official bulletin of the Ministry, which is also posted on its official website, after its entry into the List of Well-Known Trademarks. The issuance of a certificate for a well-known trademark shall be carried out in electronic form, confirmed by a QR code (matrix barcode) by the Ministry, according to the date of entry of the trademark into the List of Well-Known Trademarks. The form of the certificate and the composition of the information contained therein shall be established by the Ministry. Legal protection for a well-known trademark shall be valid indefinitely[1].

Further affirmation is found in the Resolution of the Plenum of the Supreme Court of the Republic of Uzbekistan "On Certain Issues of Considering Cases Related to Intellectual Property," which states that legal protection for a well-known trademark (service mark) arises based on a decision of the Appellate Board of the authorized state body, adopted in accordance with legislation [2].

Article 321 of the Law of the Republic of Uzbekistan "On Trademarks, Service Marks, and Appellations of Origin" [1], which is based on Article 6bis(1) of the Paris Convention for the Protection of Industrial Property (concluded in Paris on March 20, 1883) [3], allows for the recognition of a designation as a well-known trademark if that designation, as a result of intensive use, has become widely known in the Republic of Uzbekistan among the relevant consumers in relation to the goods of the applicant as of the date specified in the application."

Unlike standard trademarks, well-known trademarks possess the capacity to extend their protection to goods and services beyond those for which they are registered, thereby affording them enhanced legal safeguards. Furthermore, they benefit from long-term retrospective protection encompassing past decades, and are exempt from the regular renewal requirements of every ten years, rendering their protection perpetual. These and other advantages generate significant interest among businesses in acquiring exclusive rights to well-known trademarks.

Several criteria are established for the recognition of a trademark as well-known. According to A.A. Tyulkin, in his work "Peculiarities of Granting Legal Protection to Means of Individualization," key parameters that contribute to the well-known status of a trademark include: the anchoring of the trademark (or designation) in the minds of consumers and the influence of specific, relevant consumer groups, representative of society as a whole, on the emergence of the particular trademark (or designation) [4].

It is important to note that a well-known trademark is formed under the influence of specific consumers, which necessitates the submission of a corresponding application to the competent authority for its registration. This registration constitutes an act of public recognition and confirmation of the trademark's (or designation's) well-known status.

The advantages accruing to the right holder upon recognition of the trademark as well-known are noteworthy:

1. Perpetual legal protection for the well-known trademark is guaranteed under Article 32<sup>2</sup> of the Law of the Republic of Uzbekistan "On Trademarks, Service Marks, and Appellations of

Origin." Furthermore, this legislative entrenchment is reflected in paragraph 14 of the Resolution of the Plenum of the Supreme Court of the Republic of Uzbekistan "On Certain Issues of Considering Cases Related to Intellectual Property," which directs the attention of the courts to the fact that exclusive rights to intellectual property objects are of limited duration, with the exception of rights to undisclosed information, company names, and well-known trademarks [2]. It is important to note that certificates for ordinary trademarks, according to Article 21 of "On Trademarks, Service Marks and Appellations of Origin," are valid for ten years from the date of filing the application;

2. The scope of legal protection extends to all classes of goods and services, as stipulated in paragraph 1 of point 13 of Article 10 of the Law of the Republic of Uzbekistan "On Trademarks, Service Marks, and Appellations of Origin": "The following shall not be registered as trademarks: designations identical or similar to the point of confusion with trademarks of other persons, recognized as well-known in the established order, in respect of any goods;

3. Upon establishing and confirming the public recognition of a product associated with a specific trademark, the right holder can realize significant profits. For example, the value of the company may increase manifold, and broad opportunities will arise for the realization of exclusive rights.

Paragraph 7 of the Rules for Filing and Examining Appeals and Applications for the Recognition of Well-Known Trademarks in the Republic of Uzbekistan to the Appellate Board of the Ministry of Justice of the Republic of Uzbekistan dated October 30, 2019, No. 3190 [5], establishes the following criteria for the recognition of a trademark and service mark as well-known:

The application and its accompanying materials must contain factual data confirming the well-known status of the trademark. Such materials may include documents containing information regarding:

- Intensive use of the trademark within the territory of the Republic of Uzbekistan;
- A list of settlements where the sale of goods in respect of which the trademark was used was carried out;
- The volume of sales of these goods;
- The method of using the trademark, including advertising and presentation at fairs or exhibitions of products and/or services for which the mark is used;
- The average annual number of consumers of the goods;
- Countries in which the trademark has acquired wide recognition;
- The results of a survey of consumers of goods, conducted by a specialized independent organization, taking into account the recommendations established by the Ministry.

Evidence of the duration, continuity, intensity, and large volume of use of the trademark may include conclusions (certificates) from product quality control bodies, trade organizations, organizations and societies for the protection of consumer rights, declarations, quality certificates, and other documents. The application must indicate the date on which use of the trademark began, and the date on which the person submitting the application considers their trademark to have become well-known within the territory of the Republic of Uzbekistan.

The aforementioned information, as stipulated in Order No. 3190 of the Ministry of Justice of the Republic of Uzbekistan dated October 30, 2019, constitutes the comprehensive set of

evidence required for an applicant to seek well-known trademark status from the Ministry of Justice of the Republic of Uzbekistan. It must be emphasized that the competent authority reviews this information as the definitive criteria for recognizing a trademark or designation as well-known. Consequently, failure to adhere to any of the established requirements grants the competent authority the right to reject the application for well-known trademark status.

As an illustration, within Uzbekistan, only one trademark has been recognized as well-known according to the Decision of the Appellate Board dated December 6, 2012 – ASTRA, effective from January 1, 1996 [6]. The right holder, JV LLC "UZBAT A.O.", provided corroborating documentation for recognition of the well-known trademark covering the period from 1995 to 2002, demonstrating compliance with the aforementioned criteria.

An analysis of international practice highlights the dispute surrounding the trademark "Lay's," where the applicant was PepsiCo (USA), while the production and promotion of the chips in the Russian market was undertaken by ООО "Фрито Лей Мануфактуринг." Rospatent noted that the case file did not contain evidence of the applicant's direct participation in the production and marketing activities associated with the product, thereby casting doubt on the legitimacy of the claims [7]. The rejection of well-known status for the "Raffaello" trademark was further justified by the fact that the actual use of this designation in relation to confectionery products was carried out not by the applicant (the Luxembourg company Somartec S.A.), but by the Russian organization ZAO "Ferrero Russia," acting as the licensee [8]. Indeed, in contemporary brand management practice, an organizational model has become widespread in which the right holder does not directly engage in the production and promotion of goods, but only controls the companies involved in these processes through corporate governance or licensing agreements. While economically expedient, this model can create significant obstacles to ensuring the legal protection of a well-known trademark.

Consequently, the aforementioned information, as codified in Order No. 3190 issued by the Ministry of Justice of the Republic of Uzbekistan on October 30, 2019, constitutes the definitive evidentiary basis required for an applicant to petition the Ministry of Justice of the Republic of Uzbekistan for the recognition of a trademark as well-known. It is crucial to emphasize that the competent authority rigorously assesses this information against established benchmarks in order to determine whether a trademark or its associated designation merits recognition as well-known. As such, failure to fully comply with any of the prescribed requirements may empower the competent authority to reject the application for well-known trademark status.

## References

1. Law of the Republic of Uzbekistan No. 267-II of August 30, 2001, "On Trademarks, Service Marks, and Appellations of Origin."
2. Resolution No. 19 of the Plenum of the Supreme Court of the Republic of Uzbekistan, June 23, 2023, "On Certain Issues of Considering Cases Related to Intellectual Property."
3. Paris Convention for the Protection of Industrial Property, concluded in Paris on March 20, 1883.
4. Tyulkin, A.A. "Osobennosti predostavleniya pravovoy okhrany sredstvam individualizatsii" [Peculiarities of Granting Legal Protection to Means of Individualization]. *Aktual'nye Problemy*

---

*Rossiyskogo Prava* [Actual Problems of Russian Law], 2014, no. 9 (46), pp. 1942–1948. (Note: transliteration and translation provided.)

5. Rules for Filing and Examining Appeals and Applications for the Recognition of Well-Known Trademarks in the Republic of Uzbekistan to the Appellate Board of the Ministry of Justice of the Republic of Uzbekistan No. 3190 of October 30, 2019.

6. *Ofitsial'nyy Byulleten' Agentstva po Intellektual'noy Sobstvennosti RUz* [Official Bulletin of the Intellectual Property Agency of Uzbekistan], April 30, 2013, no. 4, p. 245. Available at: [https://my.ima.uz/uploads/files/bullitens/2013/04%20\(144\)%2030-04-2013.pdf](https://my.ima.uz/uploads/files/bullitens/2013/04%20(144)%2030-04-2013.pdf)

7. Decision No. 283065 of the Chamber for Patent Disputes of Rospatent of December 28, 2017, on application No. 2004710979 [Electronic resource]. Available at: [http://www.fips.ru/ConveraDocs/pps/\\_new/2017/2017%D0%9201521/2017%D0%9201521-2017.12](http://www.fips.ru/ConveraDocs/pps/_new/2017/2017%D0%9201521/2017%D0%9201521-2017.12)

8. Decision of the Chamber for Patent Disputes of Rospatent of December 14, 2017, on application No. 18-252 OI [Electronic resource]. Available at: [http://www.fips.ru/ConveraDocs/pps/\\_new/2018/2018%D0%9205965/2018%D0%9205965-2018.12.14.pdf](http://www.fips.ru/ConveraDocs/pps/_new/2018/2018%D0%9205965/2018%D0%9205965-2018.12.14.pdf)