

## Mattel Inc. Faced Trouble Registering Barbie® Trademark in Certain Classes in Ukraine

*By Igor Alfiorov and Yulia Kropivka, PETOŠEVIĆ Ukraine*

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Mattel Inc., US manufacturer of numerous globally known toy brands, faced problems trying to register its most famous trademark Barbie® in Ukraine, in certain classes of goods.

Mattel Inc. already owns trademark registrations for the famous doll brand in Ukraine. According to court papers, in September 2016, the US company filed a trademark application No. M201619948 to register the trademark BARBIE for goods in classes 8 (hand tools), 29 (meats and processed foods), 30 (staple foods) and 32 (light beverages). In February 2018, the Ukrainian PTO issued a provisional refusal against Mattel's trademark application for being confusingly similar to the prior trademark БАРБИ (BARBI in Cyrillic), Reg. No. 32903, which covers goods in classes 29, 30 and 32, and was registered by "Food company Yasen", LLC in July 2003.

"Food company Yasen", LLC is a Ukrainian manufacturer of soft drinks, mineral water, and confectionery products. According to Yasen's website, the food company uses its trademark БАРБИ (BARBI in Cyrillic) for fruit jelly candies, which are also called "marmalade" in Ukraine.

In order to remove the obstacle to the registration of their trademark, Mattel Inc. filed an action before the Kyiv City Commercial Court on May 13, 2019, requesting cancellation of Yasen's trademark БАРБИ in relation to all designated goods due to non-use for more than five years. The defendants are "Food company Yasen", LLC and the Ministry of Economic Development and Trade of Ukraine, which is the competent authority for IP matters in Ukraine. The PTO Examining Authority was brought into the proceedings as a non-party intervener.

The same date the statement of claims was filed, Mattel Inc. asked the court to grant a preliminary injunction prohibiting the Examining Authority from issuing its final decision on Mattel's trademark application before the court's decision in the non-use cancellation action enters into force. However, the court declined to grant the request because of insufficient evidence and insufficient grounds for the injunction.

To prove actual use of its trademark in Ukraine, the defendant provided copies of the supply agreements in relation to "marmalade БАРБИ". However, the court noted that Yasen's trademark БАРБИ does not cover "marmalade" but covers "jellies" in class 29. In order to determine whether marmalade falls under the category of jellies, the court examined the relevant State Standards of Ukraine (Derzhavni Standarty Ukrainy, DSTU) and concluded that, based on DSTU definitions, marmalade and jelly could be defined as different products. In particular, these goods are prepared by different cooking technologies: fruit puree is boiled for marmalade, and extracts or essences are mixed with other

elements without boiling for the jelly. Therefore, the court did not find the grounds to consider that the defendant's trademark БАПБІ covering jellies in class 29 also covers marmalade, and disregarded the agreements provided by the defendant as evidence of trademark use.

The defendant did not provide any other evidence to confirm the use of their trademark. Under these circumstances, the court concluded that the plaintiff's claims are valid and issued a decision on September 3, 2019 ruling to cancel Yasen's trademark БАПБІ in all classes due to non-use for more than five years.

No appeal was filed by the deadline stipulated in procedural law, and the decision is now final.

***For more information, please contact:***



Igor Alfiorov  
PETOŠEVIĆ Ukraine  
[igor.alfiorov@petosevic.com](mailto:igor.alfiorov@petosevic.com)  
[www.petosevic.com](http://www.petosevic.com)



Yulia Kropivka  
PETOŠEVIĆ Ukraine  
[yulia.kropivka@petosevic.com](mailto:yulia.kropivka@petosevic.com)  
[www.petosevic.com](http://www.petosevic.com)