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Case Note

A COURT'S *INTER PARTES* RECOGNITION OF A TRADEMARK AS WELL-KNOWN AS PART OF THE REASONS FOR THE JUDGMENT'S, AND NOT THE DECLARATORY JUDGMENT ITSELF - COMMENT ON THE CITRAMON CASE

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The author is a Justice of the Grand Chamber of the Supreme Court and was a member of the panel of judges that heard the case reviewed in this material. The views, conclusions, and analytical assessments expressed in this article reflect the author's personal academic position solely and do not represent the official view, legal position, or interpretation of the Grand Chamber of the Supreme Court.

ABSTRACT

Background: *Ukrainian trademark law allows the owner of a well-known trademark to obtain recognition of its well-known status either through an administrative procedure or through court proceedings. These mechanisms are generally perceived as alternative options available to the trademark owner, both of which produce erga omnes effects. The Grand Chamber of the Supreme Court was required to determine whether this understanding is compatible with the principle that a judgment in a commercial dispute is binding only on the parties to that dispute, i.e., that it has only inter partes effect.*

Method: *The study employs doctrinal and normative methods. It combines cross-jurisdictional doctrinal analysis, used to identify how the doctrine of the inter partes effect of judicial* *decisions has developed in modern Ukrainian jurisprudence, with a case-study methodology illustrating the practical consequences of the identified doctrinal problem. The study also employs interpretive and argumentation analysis to reconstruct the Court's reasoning. Normative analysis assesses the Court's decision against the requirements of adversarial proceedings, courts' statutory duty to provide an effective remedy, and the enforceability of judgments.*

Results and Conclusions: *The Grand Chamber's decision confirms the Supreme Court's established approach, emphasising courts' duty to provide an adequate and effective remedy. In disputes involving a well-known trademark and a competing registered trademark, the appropriate remedy is not standalone declaratory relief recognising a trademark as well-known. Rather, the court should invalidate the competing trademark registration and order the IP Office to record its cancellation, while recognising the claimant's trademark as well-known as a necessary precondition for granting that relief. This approach preserves the inter partes effect of judicial decisions. It avoids undermining the time limit under Article 6bis of the Paris Convention for cancelling a good faith competing registration, as allowing separate proceedings for recognition of well-known status could effectively restart the limitation period for cancellation and deprive bona fide owners of competing registered trademarks of a legitimate limitation defence.*

1 INTRODUCTION

On 17 April 2024, the Grand Chamber of the Supreme Court of Ukraine delivered its ruling in the case initiated by the private joint-stock company pharmaceutical firm Darnytsia (hereinafter the 'Firm') against the joint-stock company 'Lubnypharm' (hereinafter the 'Company') and the State organisation the Ukrainian National Office for Intellectual Property and Innovations[1] (hereinafter the 'IP Office') to obtain the court's recognition of the designation 'Citramon'[2] as the Firm's well-known trademark, as well as to invalidate the Company's certificate for the trademark 'Citramon-U'[3] and require the IP Office to register and officially publish information on this recognition of the Firm's trademark as well-known and information on the cancellation of the Company's certificate.[4]

1 The legal action was initiated against the Ministry for Development of Economy, Trade and Agriculture of Ukraine as the State body that administers the IP Office and establishes the regulatory framework for trademark registration. Following this, the defendant was replaced by the State enterprise 'Ukrainian Intellectual Property Institute' and, later, by the IP Office, as its legal successor.

2 In Ukrainian 'Цитрамон'.

3 In Ukrainian 'Цитрамон-У'.

4 See the ruling of the Supreme Court of Ukraine in the case of *PJSC Pharmaceutical firm Darnytsia v the Ukrainian National Office for Intellectual Property and Innovations and JSC 'Lubnypharm'*: Case no. 910/13988/20 (*Darnytsia v Lubnypharm*) (Grand Chamber of the Supreme Court, 17 April 2024) <https://reyestr.court.gov.ua/Review/118601114> accessed 10 February 2026.

The core of the dispute revolved around two pivotal questions: first, whether the Firm should be recognised as the owner of a well-known trademark, and second, whether there were sufficient grounds to invalidate the Company's competing trademark certificate. Both companies are major players in the pharmaceutical market, producing drugs under various trademarks containing the word 'Citramon'.

Following the court of first instance's satisfaction of the Firm's claims, that is to say, the recognition of the designation 'Citramon' as the Firm's well-known trademark and the invalidation of the Company's trademark certificate, and the order to the IP Office to enter the respective data into the List of well-known trademarks and the State Register of Certificates of Ukraine for Trademarks (hereinafter the 'Register'), and to make official publications, the appellate court upheld this judgment. The Company then appealed these decisions to the Supreme Court. The case was referred to the Grand Chamber of the Supreme Court, which ultimately overturned the lower courts' decisions. In its ruling, the Grand Chamber dismissed the Firm's claim for recognition of the trademark as well-known, as well as the claim seeking to require the IP Office to enter information about the well-known trademark in the List and to make a corresponding official publication. In relation to the claims for the invalidation of the Company's certificate, and the associated derivative claims for the IP Office to enter the data on the cancellation of the certificate in the Register and to make an official publication, the Grand Chamber remitted the case for a new review by the court of first instance.

The first part (II) of this article will provide a concise overview of the dispute, with particular emphasis on the wording of the relief sought by the Firm, as this will be pertinent to the pivotal conclusions of the case. This section outlines the opinions of the first instance and appellate courts, along with the arguments raised by the Company in its appeal against those decisions. Additionally, it provides a synopsis of the legal issues the Grand Chamber of the Supreme Court is likely to address in this case. The second part of the article (III) examines the primary issue of this case, namely, the effect (*erga omnes* or *inter partes*) of the court's recognition of a trademark as well-known. This section also explores whether this recognition constitutes a remedy that the court can grant to protect the trademark owner's rights. The third part of the article (IV) elucidates the rationale for remitting the case to the court of first instance for a new review, following the Grand Chamber's resolution of the primary issue. The article further expounds on the matters that the court of first instance was tasked with resolving during this new review. Finally (V), the article examines subsequent developments in the case, how the Grand Chamber's opinion in *Darnytsia v Lubnypharm* was incorporated into the Supreme Court's jurisprudence, and how the amendments to trademark legislation proposed in 2026 align with this jurisprudence.

2 THE NATURE OF THE DISPUTE, COURT DECISIONS AND LEGAL ISSUES RAISED IN THE CASE

The Firm initiated legal proceedings before a local commercial court against the Company and the IP Office, seeking the following relief:

- to recognise the designation 'Citramon' as a well-known trademark in Ukraine as of 1 January 1997 for goods in Class 05 of the Nice Classification, namely 'pharmaceutical preparations,' in the name of the Firm.
- to obligate the IP Office to record the recognition of the designation 'Citramon' as a well-known trademark in the List of well-known trademarks in Ukraine and to publish the relevant information in the official electronic bulletin.
- to declare invalid in its entirety Ukraine Certificate for the trademark 'Citramon-U', owned by the Company (issued on 15 February 2002 pursuant to an application dated 24 February 1997); and
- to require the IP Office to amend the Register to reflect the invalidation of the above certificate owned by the Company and to publish the relevant information in the official electronic bulletin.

The claim was supported by the following argument, as summarised: For many years, the Firm has utilised trademarks bearing the designation 'Citramon'. The Firm's pharmaceutical products are so well known in the market under this designation that, at least since 1 January 1997, the designation 'Citramon' should be considered a well-known trademark for the Firm's products. The Law of Ukraine No. 3689-XII dated 15 December 1993 'On the Protection of Rights to Marks for Goods and Services'[5] (hereinafter referred to as the 'Trademarks Act') provides alternative mechanisms for recognising a trademark as well-known: either the Appeals Chamber of the IP Office or a court may recognise a trademark as such. The Firm has alleged that its rights have been violated by its competitor, the Company, which is distributing products on the market bearing a mark including the word 'Citramon'. The court is thus asked to recognise the designation 'Citramon' as a well-known mark and, in this regard, to protect the Firm's rights as the owner of a well-known mark by invalidating the certificate for the competitor's mark.

The Company objected to the claim, noting that it had been labelling its pharmaceutical products with the designation 'Citramon' since at least 1982. The certificate of the Company, the invalidation of which is requested by the Firm, was issued in 2002 upon the application filed in 1997. In this regard, the Company requested that the limitation period be applied to

5 Law of Ukraine No 3689-XII 'On the Protection of Rights to Marks for Goods and Services' of 15 December 1993 (amended 26 February 2026) <https://zakon.rada.gov.ua/laws/show/3689-12> accessed 28 February 2026.

both the claim for recognition of the designation 'Citramon' as a well-known mark and the claim for invalidation of the Company's certificate.

The court of first instance granted the Firm's claim in full, and the court of appeal upheld the judgment and concurred with the lower court's arguments in substantial respects.

The primary line of argument advanced by the courts can be summarised as follows. The core issue was whether the evidence presented demonstrated that the Firm had utilised the designation 'Citramon' to the extent that it had become a well-known trademark for the Firm's products. In light of the courts' determination that the response to the aforementioned question was in the affirmative, a decision was made to formally recognise the 'Citramon' mark as a well-known trademark owned by the Firm. Consequently, from the moment the court's decision is rendered, the mark attains this status, thereby empowering its owner to exercise the right accorded by the legislation to the owner of a well-known trademark. This right includes the ability to claim invalidation of the certificate for a competitor's mark whose utilisation is deemed to infringe upon the Firm's rights. In this regard, the courts considered the Company's references to the limitation period to be irrelevant.

In accordance with the courts' decisions, the limitation period for the claim for invalidation of the Company's certificate commenced on the date the designation 'Citramon' was recognised as a well-known trademark. This reasoning is based on the premise that 'the rights to the well-known trademark were confirmed only with the court's decision on the merits of this case and, therefore, were considered violated as of the date stated in the claim'.[6]

The Company appealed the Supreme Court.

The case was initially reviewed by the panel of judges of the chamber specialising in intellectual property disputes of the Commercial Cassation Court. However, the panel subsequently referred the case to the Grand Chamber. One of the circumstances in which a case may be referred to the Grand Chamber is that of the so-called exceptional legal issue. In this instance, the panel of judges identified two key aspects. (1) It is clear that the Trademarks Act provides for the recognition of a trademark as well-known by the Office or a court. These two pathways are considered alternatives, and the choice between them is at the applicant's discretion. Nevertheless, if the recognition of a trademark as being well-known in a court constitutes an alternative to the administrative procedure before the IP Office (where there is no specific infringer as a counterparty), how does this align with the fact that an individual or an entity should resort to a commercial court only to protect their violated rights or interests or to prevent such violation, in both cases by a particular person? (2) The second key question pertains to the applicability of the

6 See Case no. 910/13988/20 (Northern Commercial Court of Appeal, 29 September 2022) <https://reyestr.court.gov.ua/Review/106539042> accessed 10 February 2026. See also, *Darnytsia v Lubnypharm* (n 4) para 2.15.

provisions of the Civil Code on limitation of actions in instances where an individual seeks recognition of a well-known mark, contingent upon the infringement of that right by a specific individual or entity. If such an infringement is proved, it is essential to ascertain the point at which the rights of the owner of a well-known trademark have been violated, and the owner had the right to initiate legal action. Consequently, the limitation period should commence. The court of first instance dismissed the defendant's motion for the application of the limitation period because 'the Firm's right to submit such a claim to the court arises from the moment the court recognises the trademark as well-known'.[7] This could be perceived as a paradox, since, in accordance with Ukrainian legal doctrine, the right to initiate legal proceedings arises from the moment of violation or threat of violation of a particular right and must be exercised in good faith, usually within the limitation period. However, it is equally evident that for a violation to occur, the existence of a specific right on the part of the plaintiff is an indispensable prerequisite.

The Court of Appeal clarified this contradictory logic. It stated that the rights to a well-known trademark are *confirmed* only by a decision on the merits of the dispute and are, therefore, considered violated as of the date stated in the claim.[8]

However, if the court decision is the starting point from which the right to sue arises, how can the plaintiff submit a claim in good faith without having such a right at the time of submission? This paradoxical situation arose from the formal recognition of the claim for recognition of a well-known trademark as a separate relief a plaintiff might seek. The decision to refer this case to the Grand Chamber indicates that this paradox had to be resolved.

In its appeal to the Supreme Court, the Company emphasised its efforts to demonstrate that, at the time the Firm claimed to utilise the 'Citramon' designation as a well-known trademark (i.e., 1 January 1997), Ukrainian IP law did not recognise such an object of intellectual property as a well-known trademark.

Additionally, the appellant highlighted the lower courts' failure to appropriately examine the evidence of the Company's long-standing utilisation of the contested mark[9], and the courts' reliance on inadmissible evidence to establish the Firm's use of the said mark.[10] Furthermore, the Company noted that the Firm did not utilise the 'Citramon' designation itself, but rather a related one that incorporated the word 'Citramon'. However, as of 1997, the Trademarks Act did not provide for the possibility of recognising a designation as a well-known trademark because a similar designation had been used.[11] Finally, the Company also drew the Court's attention to the fact that the limitation period should still

7 *Darnytsia v Lubnypharm* (n 4) para 2.11.
8 ibid, para 2.15.
9 ibid, paras 4.2, 4.3.
10 ibid, para 4.4.
11 ibid, para 4.5.

have been applied to the main and derivative claims from the date indicated by the claimant as the starting point from which the claimant's alleged right to the mark should be traced, i.e., from 1 January 1997.

The long-standing use of the disputed mark, as well as the fact that the issue of creation of the disputed mark in the Soviet Union should have been analysed in this case, were also emphasised in a dissenting opinion by one of the judges of the panel of the Commercial Court of Cassation, which referred the case to the Grand Chamber.[12] It is, therefore, important to note that the case could also raise the issue of the special regime of trademarks that were a legacy of the Soviet era.

The question of whether the designation 'Citramon' had lost its distinctiveness at all and whether the word had become a generic designation of a medicinal product, which, as it turned out, was produced by several pharmaceutical plants in the Soviet Union[13], could be considered close to this. However, it should be understood that the Supreme Court did not address this aspect, and that this omission is entirely consistent with the court's function. In the context of Ukrainian case law, the determination of whether a specific designation possesses a distinctive character has historically been approached by courts as a matter of fact rather than of law. Furthermore, this issue is traditionally regarded as requiring expert knowledge. The Supreme Court cannot interfere with how the lower courts determine issues of fact. It can only set aside a court's decision and remit the case to a lower court if a party claims that the decision was based on inadmissible evidence or if the lower court failed to examine evidence relevant to the case. In other words, the Supreme Court cannot intervene in this matter on its own initiative. An appeal to the Supreme Court must be clearly motivated by these violations of evidentiary matters. Since the party did not claim that the lower courts did not take into account any evidence on the basis of which they should have concluded that the designation had lost its distinctive features, as can be seen from the description of the appellant's arguments, the Supreme Court could not address this issue *sua sponte*.

Taking into account the arguments raised by the Company in its appeal to the Supreme Court, as well as the Court's limited powers to raise certain issues on its own initiative, the Grand Chamber first focused on the question of whether such an intellectual property object as a well-known trademark existed in law in 1997, i.e., when, according to the Firm, the designation 'Citramon' used by it allegedly acquired the characteristics of a well-known trademark.

12 Case no. 910/13988/20, Dissenting opinion of Judge I Benedysyuk (Commercial Cassation Court of the Supreme Court, 26 January 2023) <https://reyestr.court.gov.ua/Review/108739263> accessed 10 February 2026.

13 *Darnytsia v Lubnypharm* (n 4) para 7.23.

The Company argued that it did not. In doing so, it relied primarily on an analysis of domestic law, specifically the Trademarks Act, which at that time did not contain separate provisions for safeguarding and protecting well-known marks.

However, the Grand Chamber drew attention to the fact that such provisions were contained in Article 6*bis* of the Paris Convention for the Protection of Industrial Property (hereinafter the 'Paris Convention'), as amended by the Stockholm Act of 1967,[14] which came into force in the USSR on 26 April 1970. For Ukraine separately, the Paris Convention entered into force on 25 December 1991.[15] In other words, even during the time of the USSR, when production of Citramon began, the law provided a basic mechanism for protecting rights to a well-known trademark.

As the Paris Convention contains rules that are directly applicable to matters concerning the safeguarding and protection of industrial property, as well as rules requiring countries of the Union (see Article 1) to regulate certain issues in their domestic legislation, the Grand Chamber concluded that the provisions of Article 6*bis*, stating that the court should protect the rights of the interested person (owner of a well-known trademark) at their request, were rules of direct application. In reaching this decision, the Grand Chamber referred to a similar interpretation of the Paris Convention set out in the 1968 Guide to the Application of the Paris Convention published by the World Intellectual Property Organization (hereinafter 'WIPO').[16]

Therefore, the Grand Chamber found that the Ukrainian IP law recognised a well-known trademark as an object of intellectual property in 1997 and subsequently, rejecting the Company's assertion to the contrary.[17]

3 THE KEY ISSUE OF THE CASE: THE EFFECT OF THE COURT RECOGNISING A TRADEMARK AS WELL-KNOWN

Given that the main claim in this case was recognition of the 'Citramon' designation as a well-known trademark belonging to the Firm, the question arose as to the implications of such recognition. Domestic civil law and intellectual property law specifically mention the recognition of a well-known trademark. According to the Trademarks Act, a trademark may be recognised as well-known by either an administrative body (the Appeals Chamber of the IP Office) or a court.[18] It also sets out the general procedure for such recognition by an administrative body. The detailed procedure for recognising a trademark as well-known by

14 Paris Convention for the Protection of Industrial Property [1977] UNTS 828/305.

15 *Darnytsia v Lubnypharm* (n 4) para 8.9.

16 See GHC Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property* (BIRPI 1968) doi:10.34667/tind.28637.

17 *Darnytsia v Lubnypharm* (n 4) para 8.15.

18 See Law of Ukraine No 3689-XII (n 5) art 25(1).

the Appeals Chamber is set out in a special Regulation.[19] This involves deciding on an application from a person or entity who considers themselves to be the owner of a well-known trademark and entering information about the decision into the IP Office's List of well-known trademarks. This procedure vaguely resembles the trademark registration process, which may result in the issuance of a trademark certificate to the applicant and registration in the Register, which is publicly available and maintained by the IP Office.

According to the Trademarks Act, the holder of a trademark certificate is entitled to use the respective trademark. Therefore, the certificate is traditionally considered as a title document, and registration in the Register constitutes official State recognition of the certificate holder's rights, with *erga omnes* effect.

Consequently, if any person challenges the certificate holder's rights to the mark or attempts to terminate them in the future, they can do so by initiating a claim-based proceeding for the certificate's invalidation (cancellation) before the court.

As mentioned previously, the administrative procedure for recognising a mark as well-known is only remotely similar to the procedure for issuing a certificate. However, rather than receiving a certificate, the applicant receives a decision from the Appeals Chamber, and rather than being registered in the Register, the decision is entered into the List of well-known marks.

Adopting this simplistic analogy, the Appeals Chamber's decision to recognise a trademark as well-known, along with the information contained in the List of well-known trademarks, should be accorded *erga omnes* effect. Furthermore, if we consider only that the law states that a trademark may be recognised as well-known by either the IP Office or a court, and that the law does not distinguish between the effects of these two forms of recognition, we can conclude that they are alternative forms with the same character, i.e., they have an effect on an unlimited number of third parties. After all, information on court decisions recognising a trademark as well-known is also subject to inclusion in the above List.

However, this oversimplified logic raises several issues.

So far, the courts in Ukraine have considered the issue of recognising a trademark as well-known in claim-based proceedings, in which only claims brought by a person whose rights have been infringed are reviewed against the infringer. The current commercial procedural law does not provide for any other procedure. Notably, Ukraine is planning to establish a specialised High Court for Intellectual Property to adjudicate disputes related to intellectual property rights.

19 See Order of the Ministry of Economic Development, Trade, and Agriculture of Ukraine No 433 of 2 March 2021 'Regulations of the Appeals Chamber of the National Intellectual Property Authority' [2021] Official Gazette of Ukraine 39/2336. These Regulations superseded the Procedure for Recognizing a Mark as Well-Known in Ukraine by the Appeals Chamber of the State Intellectual Property Service of Ukraine, approved by Order no. 228 of the Ministry of Education and Science of Ukraine dated 15 April 2005.

If established, the procedural law may be improved, including by establishing a separate procedure for recognising a trademark as well-known, irrespective of disputes with particular infringers. This would allow the court to inform the general public about such cases and involve all interested parties. In such a procedure, the court's powers to establish the circumstances of the trademark's use and whether it complies with the characteristics of a well-known trademark could be broader, as they would not be limited by the principles of party autonomy and adversarial process that apply in claim-based proceedings and restrict the court's ability to obtain evidence and determine the circumstances relevant to the case.

However, the current procedural law, by which the courts were guided at the time of the case, did not provide for all these opportunities.

It is, therefore, imperative that there exists not only a plaintiff, who is the alleged owner of a well-known trademark, but also a defendant who has infringed upon the rights of the former. It is then difficult to accept that the court's decision to resolve a dispute between these persons, who, according to the principles of party autonomy and the adversarial process, have the power to limit the court in what it finds and decides, can have an *erga omnes* effect.

This also creates grounds for abuse, since obtaining a court decision recognising a mark as well-known, which would have this *erga omnes* effect, could allow an interested party to initiate a bad-faith claim against a 'friendly' defendant.

The Paris Convention and the Trademarks Act constitute the legal framework within which the safeguarding and protection of rights to a well-known mark, irrespective of its registration status, is achieved. The registration of a trademark is subject to time limits, and if the owner fails to renew the registration, the exclusive rights to the trademark expire. Termination of these rights may also occur if the owner fails to utilise the trademark for a stipulated period. However, the Trademarks Act does not contain any provisions about the validity of rights to an unregistered well-known trademark. In Ukrainian procedural doctrine, a court decision resolving a commercial dispute and having the effect of *res judicata* is generally not considered to have a duration (the issue is not the period for enforcement, but rather the period during which the court's determination is valid). It is evident that, in acknowledging the court's ability to grant recognition of a well-known mark as a distinct remedy, the issue of the duration of such recognition becomes pertinent. Moreover, should the *erga omnes* effect of such a decision be recognised, the magnitude of the problem would increase, as it is to be expected that there would be a mechanism for interference with such a court decision by other interested parties. Otherwise, in a dispute between two persons, the status of a well-known trademark may be established indefinitely. The claimant will be recognised as having rights that are not contingent on changes in the trademark's state of use (for example, the trademark may cease to be so recognisable over time) or on temporal limitations. This stands in direct opposition to the fundamental principles of the doctrine of exclusive rights.

This approach also creates another logic 'trap'. As previously stated, an effective recourse for the owner of a well-known trademark to protect their rights against another person using a similar trademark for which that person holds a valid certificate is to file a claim to invalidate that certificate. However, it should be noted that such a claim is subject to a limitation period. Ukrainian courts have developed well-established jurisprudence in holding that the limitation period is calculated from the moment when a person becomes aware of, or could reasonably be expected to become aware of, the violation of their right or the identity of the individual responsible for the violation. It can thus be concluded that in the event of a court decision recognising a trademark as being well-known, the limitation period for claims against specific infringers is also calculated from the moment of that decision. The courts of first instance and appeal in this case fell into this perplexing paradox.

The Grand Chamber was not satisfied with this simplistic analogy, which also created the basis for the paradox described above. As can be seen from its ruling, the Grand Chamber delved into the legal meaning of both ways of recognising a trademark as well-known, i.e., in administrative proceedings and in court.

It became apparent that there was no ground for drawing an analogy between, on the one hand, a trademark certificate and its registration in the Register, which has an *erga omnes* effect, and, on the other hand, the decision of the Appeals Chamber and the entry of information about it in the List of well-known marks.

The administrative procedure for reviewing applications for recognition of a trademark as well-known in the Appeals Chamber, analysed by the Grand Chamber, although not adversarial, enables the Appeals Chamber to establish the necessary circumstances *ex officio* to decide whether a trademark has the characteristics of a well-known one. However, this procedure does not provide an effective mechanism for involving other interested parties. Moreover, the aforementioned Regulation, which stipulates this procedure, expressly states that the Appeals Chamber's decision is binding on the parties concerned, namely the applicant and the IP Office. The decision in question does not possess an *erga omnes* effect. This decision binds the IP Office, as it will prevent the registration of identical or confusingly similar marks.

The recognition of a trademark as well-known by a court differs from the above administrative procedure. As previously emphasised, a court decision in a commercial dispute does not confer new rights; rather, its function is to protect existing rights. Therefore, the rights of the owner of a well-known trademark must already exist and must be violated. It is only in these circumstances that the court can provide adequate protection.

In the scenario where the owner of a well-known trademark alleges that the rights to the said trademark are being infringed by the owner of another trademark, which the latter uses based on the respective trademark certificate registration, the rights of the owner of the well-known trademark should be protected in a manner that results in the invalidation of the certificate, thereby preventing the infringer from using the identical or similar trademark.

Accordingly, the Grand Chamber has determined that the recognition of a trademark as well-known does not constitute a legal remedy in itself but rather serves as a prerequisite for the court to protect the right of the trademark's owner against a specific infringement in a manner that is effective.[20] In summary, the conclusion that the mark is well-known constitutes an integral element within the court's reasoning, rather than representing an independent declaratory judgment. Consequently, the conclusion regarding the trademark does not have *erga omnes* effect; rather, it applies only to the parties to the specific dispute. In this opinion, the Grand Chamber also referred to the comments of the WIPO International Bureau, which emphasised the inter partes effect of any court decision establishing that a mark is well-known.[21]

The Grand Chamber was also tasked with elucidating the consistency of its aforementioned opinion with the explicit provisions of the Commercial Procedural Code (Articles 20(2) and 20 (3)), which establish a distinct category of cases within the ambit of commercial courts' jurisdiction. This category pertains to 'cases related to the recognition of a trademark as well-known'.[22] Furthermore, the Grand Chamber was tasked with addressing the utilisation of the term 'a trademark recognised as well-known in accordance with the procedure established by law' as set out in Article 494 of the Civil Code .[23]

For proponents of a literal interpretation of the law, these could be significant arguments in favour of a separate declaratory judgment on the recognition of a trademark as well-known.

However, the Grand Chamber explained that the rules on remedies in Ukrainian law are an integral part of substantive, not procedural, law.[24] In the Ukrainian legal tradition, the division of branches of law into substantive and procedural law is deeply entrenched. In view of this, it is evident that the provisions of procedural law, including those concerning the jurisdiction of commercial courts in adjudicating cases about the recognition of a trademark as well-known, do not govern legal remedies. In essence, the case under consideration involves a dispute wherein the plaintiff, the owner of a well-known trademark, seeks to invalidate a competing trademark certificate. This case falls within the purview of recognising a trademark as well-known. However, in such circumstances, the court's approach is not to issue a declaratory judgment recognising the trademark as well-known. Instead, the court employs the most effective and concrete remedy available, namely the invalidation of the competing trademark's certificate.

20 *Darnytsia v Lubnypharm* (n 4) paras 8.36, 8.37.

21 See International Bureau of the World Intellectual Property Organization, *Protection of Well-Known Marks: Memorandum* (WKM/CE/III/2, 20 August 1997) <https://www.wipo.int/edocs/mdocs/mdocs/en/wkm_ce_iii/wkm_ce_iii_2.pdf> accessed 10 February 2026.

22 *Darnytsia v Lubnypharm* (n 4) para 8.31.

23 ibid, para 8.43.

24 ibid, para 8.32.

The Grand Chamber also did not interpret the provision of the Civil Code on 'a trademark recognised as well-known in accordance with the procedure established by law' literally as requiring courts to recognise a trademark as well-known in the operative part of the judgment, i.e., by way of granting this recognition as declaratory relief. One of the main reasons for not adopting this interpretation has already been outlined above: it would result in a court decision recognising a mark as well-known being perceived as having an *erga omnes* effect. It would constitute a way of acquiring rights to a trademark rather than a tool for its protection. The idea that a court decision resolving a commercial dispute is not a means of acquiring subjective rights, but only an instrument for their protection, is deeply rooted in Ukrainian case law.[25]

It is important to note that the question of whether recognition of a well-known mark constitutes a separate remedy was not raised in the statements of the parties.

The Supreme Court raised this issue *sua sponte*, as the appropriateness of remedies is decided ex officio by the court in Ukraine. Since December 2017, new versions of the procedural codes have come into force, assigning the courts the task of *effectively* protecting violated rights. In jurisprudence, this, as well as the requirement of Article 13 of the European Convention on Human Rights to provide effective remedies for the protection of conventional rights, as interpreted by the courts, has become the basis for the doctrine that the court independently assesses the appropriateness and effectiveness of the remedy requested by the plaintiff. If the plaintiff insists on obtaining protection in a manner that the court deems to be ineffective or generally inadequate, this constitutes an independent ground for dismissing the claim that embodies the request for an inadequate remedy.

This approach is predicated on the court's assumption of responsibility for ensuring that the awarded remedy is effectively enforceable and leads to the real protection of the infringed right. That is to say, the plaintiff does not have to go to court again with subsequent claims if one judgment does not change their situation. This approach also implies that the defendant should not be held liable if the plaintiff has accumulated several claims against him that were not necessary. It is important to note that the plaintiff must pay a court fee for each claim, and if the claim is satisfied, the defendant typically bears the financial burden. In instances where the plaintiff, whose right has been violated and can be protected in one particular way, submits a comprehensive list of claims that are devoid of practical significance and whose satisfaction by the court does not result in tangible protection for

25 See for example, Case no. 760/20948/16-ц (Grand Chamber of the Supreme Court, 10 April 2024) para 46 <https://reyestr.court.gov.ua/Review/118520073> accessed 10 February 2026; Case No 916/1608/18 (Grand Chamber of the Supreme Court, 19 May 2020) para 76 <https://reyestr.court.gov.ua/Review/89819917> accessed 10 February 2026; Case no. 909/337/19 (Grand Chamber of the Supreme Court, 23 June 2020) para 78 <https://reyestr.court.gov.ua/Review/90359317> accessed 10 February 2026; Case No 923/1283/16 (Commercial Cassation Court of the Supreme Court, 22 May 2018) para 14 <https://reyestr.court.gov.ua/Review/74346080> accessed 10 February 2026.

the plaintiff, the court does not satisfy these superfluous claims and, consequently, does not impose the burden of costs on the defendant.

As is evident from the Grand Chamber's ruling, this approach was applied to the claimant's request that the IP Office enter information regarding the recognition of the trademark as well-known in the List. In light of the *inter partes* effect of the court's decision on the protection of rights to a well-known trademark and given the fact that the List is exclusively informational and its data has no effect on third parties, only the IP Office, the claim to enter data into the List was deemed by the Grand Chamber to be incapable of protecting the rights of the owner of a well-known trademark.

Furthermore, as the Grand Chamber has held that the effective protection of the rights of the owner of a well-known trademark from infringements in the form of use of a similar mark by the owner of a competing certificate can be achieved by invalidating the competing certificate, it would, therefore, have been necessary for the courts to focus on this claim as the main one.

4 SUBSEQUENT QUESTIONS OF THE CASE: GOOD FAITH OF REGISTRATION AND USE OF A SIMILAR MARK BY A COMPETITOR

Consequently, the Grand Chamber did not concur with the simplistic approach adopted by the lower courts in finding the Company's certificate invalid. They regarded this matter as one that should be resolved automatically, upon the resolution of the issue of recognising the trademark as well-known: once the mark is recognised as well-known, its owner may exercise the right to prohibit the use of a competing mark by invalidating the certificate.

In this particular logical construction, the circumstances of the Company's use of the 'Citramon' designation (including the question of whether the use of this mark was in good faith) were mistakenly dismissed as irrelevant. In the opinion of the Grand Chamber, the courts failed to examine the relevant evidence submitted by the Company. Accordingly, as the courts effectively suspended their deliberations at an intermediate stage in regards to the circumstances relevant to the case, thereby reducing the subject of proof[26], the Grand Chamber remitted the case to the court of first instance for a new review of two claims brought by the plaintiff (namely the invalidation of the Company's certificate and the obligation of the IP Office to amend the Register)[27] for the purpose of examining the evidence relating to the aforementioned circumstances.

26 *Darnytsia v Lubnypharm* (n 4) para 8.94.
27 ibid, para 9.4.

The issue of good faith on the part of the Company in its use of the 'Citramon' designation was also a matter of relevance for the application of the limitation period.

The Grand Chamber clarified the alignment between Article 6*bis* of the Paris Convention, stipulating that the time limit for filing a claim for cancellation of a competing mark is 'at least five years from the date of registration' and domestic civil law provisions on limitation of actions.

As previously mentioned, the Ukrainian courts have a well-established approach in their jurisprudence that the limitation period commences from the moment an individual becomes aware of, or could reasonably be expected to become aware of, the infringement or the identity of the infringer. This latter point is of particular significance, as without such knowledge, it would not be possible to initiate legal proceedings against the specific infringer. The general limitation period is set out in Article 257 of the Civil Code of Ukraine and is three years.

The Grand Chamber concluded that the limitation period for invalidation of a trademark certificate is three years from the date on which the owner of a well-known trademark became aware, or could not have been unaware, of the infringement of their rights by the use of a registered competing mark. The owner may become aware of such use, for example, as a result of a competitor introducing products under such a mark. Subsequently, a period of three years should be calculated as described; however, a minimum of five years must be calculated from the date of registration of the competing trademark.

This approach is applicable in instances where the competing trademark was registered in good faith, as the Paris Convention imposes no temporal restrictions on the cancellation of a registration undertaken in bad faith. In view of this, it is justified that the Grand Chamber also set out some guidelines as to what circumstances the courts should examine to draw conclusions about this aspect of the registration of a competing trademark.

It is noteworthy that the Grand Chamber had to refer to the CJEU's case law to illustrate that, in principle, two competitors can use in good faith the same word that is the central element of both competitors' trademarks.[28]

5 IMPACT OF THE GRAND CHAMBER'S OPINION

5.1. Further Developments in the Case

During the rehearing before the court of first instance, the court focused on the evidence of the use of trademarks containing the 'Citramon' designation by the Firm and the Company. As a result, the court found that due to the long-term use of this designation by many

28 ibid, para 8.68.

manufacturers, including the parties to this case, it had lost its distinctive character. The court concluded that the 'Citramon' designation could be included in the trademark as an unprotected element that does not occupy a dominant position in the trademark's design.[29]

Having found that the designation did not meet the criteria for protectability due to a lack of distinctive character, the court consequently concluded that there was no evidence that the 'Citramon' designation was widely known as a designation for the Firm's products specifically at the time alleged by the plaintiff.

Although the court had already reached the conclusion outlined above, it nevertheless examined the question of when the plaintiff should be deemed to have become aware that the Company was using the 'Citramon' designation. Having established a specific date, the court did not, however, conclude that the statute of limitations for challenging the Company's competing trademark had expired, nor did it examine the issue of whether the Company had registered its trademarks in good faith.

Overall, this may indicate that the court of first instance took into account the Grand Chamber's opinion regarding the sequence in which the issues should be addressed in cases concerning the protection of rights to a well-known trademark: first, it must be determined whether the plaintiff holds the rights to a well-known trademark, and only if the answer to this question is in the affirmative should it be determined whether the opponent's registration of a competing trademark was in good faith and, depending on that determination, whether the statute of limitations applies and, if so, whether it has expired.

The court of appeal, in reviewing the Firm's appeal of this decision, upheld the findings of the court of first instance that the 'Citramon' designation had lost its distinctiveness. Furthermore, in light of this conclusion, it considered the determination of the date from which the Firm should be deemed to have been aware of the Company's use of the competing mark to be erroneous and, in essence, superfluous.[30]

At the end of 2025, the Firm sought a review of these court decisions in the Supreme Court, and in January 2026, on the day of the first hearing on its appeal, the Firm filed a motion to dismiss the case. Under Ukrainian procedural law, a plaintiff may withdraw a claim in the Court of Cassation, even if the decisions of the lower courts were not in its favour. In light of this, the Supreme Court granted the motion, declared the lower courts' decisions invalid, and dismissed the case. This procedural outcome eliminates the preclusive effect of the lower courts' factual findings, which may be significant to the plaintiff. At the same time, the Firm can no longer initiate a similar dispute.

29 See Case no. 910/13988/20 (Commercial Court of Kyiv, 14 May 2025) <https://reyestr.court.gov.ua/Review/127497932> accessed 10 February 2026.

30 See Case no. 910/13988/20 (Northern Commercial Court of Appeal, 2 October 2025) <https://reyestr.court.gov.ua/Review/131156225> accessed 10 February 2026.

Consequently, this case no longer permits a complete examination of the application of the approach established by the Grand Chamber in all its aspects (establishing the characteristics of a well-known trademark, determining the good faith of the registration of a competing trademark, and applying the statute of limitations).

5.2. The Reception of the Grand Chamber's Opinion in the Jurisprudence of the Supreme Court

The Grand Chamber's opinion in *Darnytsia v Lubnypharm* influenced the jurisprudence in disputes related to well-known trademarks immediately following the publication of the ruling.

In another case concerning the protection of rights to a well-known trademark, which was pending before the Supreme Court at the same time, the plaintiff withdrew the claim seeking recognition of its trademark as well-known following the publication of the Grand Chamber's opinion. As for the remaining claims, the case was also remitted to the court of first instance for a new trial.[31]

In light of the Grand Chamber's opinion regarding the *inter partes* effect of a court decision recognising a trademark as well-known, the Supreme Court also ruled in 2024 that it was correct to dismiss appeals and refuse substantive review of court decisions recognising a trademark as well-known where the appellant was not a party to those proceedings but argued that if such recognition were to have *erga omnes* effect, it would affect its interests. Thus, the Court reiterated that such a decision has no erga *omnes* effect with respect to persons who were not parties to the proceedings.[32]

5.3. The Impact of the Grand Chamber's Ruling on Legislative Changes

It should be noted that, for several years now, there has been an ongoing discussion among intellectual property law experts about the need for comprehensive reform of the Trademarks Act. The IP Office has organised several such discussions.

Most recently, on July 15, 2026, the Ministry of Economy, Environment, and Agriculture of Ukraine published the draft of a revised Trademarks Act.[33]

The draft law fully incorporates the approach established by the Grand Chamber in *Darnytsia v Lubnypharm*. Its Article 12 addresses well-known trademarks and explicitly states, among other things, that '*the recognition of a trademark as well-known is not binding*

31 See Case no. 910/4085/23 (Commercial Cassation Court of the Supreme Court, 16 July 2024) <https://reyestr.court.gov.ua/Review/120485335> accessed 10 February 2026.

32 See Case no. 522/10809/20 (Civil Cassation Court of the Supreme Court, 29 May 2024) <https://reyestr.court.gov.ua/Review/119559718> accessed 10 February 2026.

33 Draft Law of Ukraine 'On Amendments to the Civil Code of Ukraine Regarding Trademarks' (15 July 2026) <https://www.me.gov.ua/view/a32a989e-6a43-43dd-b0bb-5b0c5ee0fe62> accessed 17 July 2026.

on persons who are not parties to the case', which is consistent with the Grand Chamber's approach regarding the *inter partes effect* of a decision in which a trademark is recognised as well-known. The draft's authors even went as far as to provide a degree of detail rarely found in legislation regarding the remedies available to protect trademark owners' rights, since the law of remedies is an area traditionally shaped by case law. Nevertheless, in the same Article 12 of the draft, its authors proposed including the following provision: '*the judicial recognition of a trademark as well-known is not an independent remedy for the protection of a civil right or legally protected interest*'.

6 CONCLUSIONS

The case reviewed by the Grand Chamber demonstrated that the Supreme Court has consistently upheld the approach established in its case law since 2017, emphasising the court's responsibility to provide an adequate and effective remedy.

In considering this case from the aforementioned perspective, it becomes evident that the most appropriate remedy for the court to grant to a plaintiff who asserts ownership of a well-known trademark and has sought court intervention to protect against a competitor's use of a similar registered trademark is the cancellation of the registration of a competing trademark, accomplished by satisfying the claim to invalidate the competitor's trademark certificate and requiring the IP Office to enter that information in the Register. The judicial recognition of a trademark's well-known status is made by the court when considering such a dispute as a condition for granting the aforementioned relief, and not as an independent declaratory judgment.

This approach is advantageous in that it preserves the *inter partes* effect of the court's decision and the implications of the conclusion that the trademark is well-known, and it does not distort the time-limited mechanism for cancelling a good-faith registration of a competing trademark set out in Article 6*bis* of the Paris Convention. Such a distortion would undoubtedly ensue if it were hypothesised that the owner of a well-known trademark could, at any given moment, initiate a standalone claim-based proceeding for the recognition of the trademark as well-known. Consequently, upon the satisfaction of this claim and the granting of recognition as declaratory relief, the limitation period for the subsequent cancellation of the registration of a competing trademark would begin to elapse. This effectively negates any potential defence that may be asserted by a *bona fide* defendant who is the owner of a registered competing trademark, by invoking the limitation period.

The Grand Chamber in *Darnytsia v Lubnypharm* held that in modern commercial litigation, where, apart from bankruptcy proceedings, commercial litigation consists exclusively of claim-based proceedings with their inherent adversarial character and party autonomy, it is precisely within claim-based proceedings that the rights of the owner of a well-known trademark can be protected. However, the Grand Chamber's opinion was formulated in such a way as not to preclude the fundamental possibility of establishing a procedure similar to separate proceedings in civil cases, where the court would be granted procedural authority to involve all interested parties to establish, with *erga omnes* effect, the well-known status of a trademark. The amendments proposed by the IP Office in the draft Trademarks Act are aimed at retaining judicial recognition that operates only *inter partes* in commercial proceedings, which is preferable because this approach generally aligns closely with the purpose of litigation in commercial courts, which is the effective protection of rights against particular infringements by identified parties.

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АНОТАЦІЯ УКРАЇНСЬКОЮ МОВОЮ

Практична нотатка

ВИЗНАННЯ СУДОМ ТОРГОВЕЛЬНОЇ МАРКИ ДОБРЕ ВІДОМОЮ З ЕФЕКТОМ *INTER PARTES* ЯК ЕЛЕМЕНТ МОТИВУВАЛЬНОЇ ЧАСТИНИ СУДОВОГО РІШЕННЯ, А НЕ САМОСТІЙНЕ ДЕКЛАРАТИВНЕ РІШЕННЯ: КОМЕНТАР ДО СПРАВИ «ЦИТРАМОН»

Костянтин Пільков

АНОТАЦІЯ

Вступ. *Українське законодавство у сфері охорони прав на торговельні марки передбачає можливість визнання торговельної марки добре відомою як в адміністративному, так і в судовому порядку. Ці механізми зазвичай розглядаються як альтернативні способи захисту, доступні власнику торговельної марки, кожен із яких має наслідки erga omnes. Велика Палата Верховного Суду мала визначити, чи узгоджується таке розуміння з принципом, згідно з яким судове рішення у господарському спорі є обов'язковим лише для сторін цього спору, тобто має лише ефект inter partes.*

Методи. *У дослідженні використовуються доктринальний та нормативний методи. Порівняльно-правовий доктринальний аналіз, спрямований на з'ясування розвитку доктрини inter partes-ефекту судових рішень у сучасній українській судовій практиці, поєднано з методом аналізу конкретної справи, що ілюструє практичні наслідки виявленої доктринальної проблеми. У статті також застосовуються методи тлумачення та аналізу юридичної аргументації для реконструкції мотивів судового* *рішення. Нормативний аналіз спрямовано на оцінку рішення Великої Палати крізь призму вимог змагального судочинства, встановленого законом обов'язку судів забезпечувати належний та ефективний спосіб судового захисту, а також можливості примусового виконання судових рішень.*

Результати та висновки. *Рішення Великої Палати підтверджує усталений підхід Верховного Суду, який наголошує на обов'язку судів забезпечувати належний та ефективний спосіб захисту. У спорах щодо добре відомої торговельної марки та зареєстрованої торговельної марки іншої особи належним способом захисту є не самостійне декларативне рішення про визнання торговельної марки добре відомою, а визнання недійсною реєстрації іншої торговельної марки із зобов'язанням Українського національного офісу інтелектуальної власності та інновацій внести запис про її скасування. Водночас суд має встановити, що торговельна марка позивача є добре відомою, оскільки це є необхідною передумовою застосування зазначеного способу захисту. Такий підхід забезпечує збереження inter partes-ефекту судових рішень. Він також запобігає обходу строку, передбаченого статтею 6bis Паризької конвенції для скасування добросовісно зареєстрованої торговельної марки іншої особи, оскільки можливість окремого судового провадження щодо визнання торговельної марки добре відомою фактично дозволила б обійти встановлений строк для оскарження такої реєстрації та позбавила б добросовісних власників зареєстрованих торговельних марок права посилатися на сплив установленого строку як на підставу для захисту.*

Ключові слова: *добре відома торговельна марка, ефект erga omnes, доктрина способів правового захисту, добросовісність, inter partes-ефект судового рішення, res judicata.*