

The Trademark Lawyer

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Natalia Radchenko

Trademarks in the Eurasian Economic Union: The facts

Natalia Radchenko, Gorodissky & Partners, investigates the current situations and perspectives of trademarks and appellations of origin of goods in the EAEU. Despite being a complex process, Radchenko believes in the benefits.

Eurasian Economic Union (hereinafter EAEU or Union) is the international economic integration organization founded under the Treaty on the Eurasian Economic Union entered into force on January 1st, 2015. As of the end of August 2015, EAEU members are: Belarus, Kazakhstan, Russia, Kyrgyzstan and Armenia.

Every EAEU country-member participates in all major international treaties regarding trademark protection: Paris Convention for the Protection of Industrial Property, Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, Singapore Treaty on the Law of Trademarks, Madrid Agreement Concerning the International Registration of Marks and Protocol Relating to the Madrid Agreement. Aside from that, Russia, Kyrgyzstan, Armenia and Kazakhstan are members of WTO and are bound with obligations under TRIPS agreement. In view of the circumstances stated above, legislation of EAEU members is mostly uniform, which makes cooperation in the field of intellectual property much easier.

There are various procedures that might be used to obtain a trademark protection on EAEU territory. First, every EAEU country-member provides trademark protection for both residents and non-residents on the basis of national trademark registration.

In Russia, legislation concerning trademark protection, similar to the intellectual property legislation in general, is concentrated in Part IV of the Civil Code since 2008. In other EAEU countries, civil codes include only general provisions regulating legal protection of all intellectual property and some basic provision concerning certain types of subject matters. In these countries, questions concerning legal protection of trademarks are addressed in detail in special laws.

In Armenia, it is the law “On trademark” (2010); in Belarus – “On trademarks and service marks” (1993); in Kazakhstan – law “On trademarks, service marks and appellations of origin of goods” (1999); in Kyrgyzstan - law “On trademarks, service marks and appellations of origin of goods” (1998).

Résumé

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Natalia graduated from the Moscow Bauman State Technical University as electromechanical engineer, and later, from the Central Institute of Intellectual Property (Moscow). In 2003 she became a Master-at-law and started her career in the R & D Electro-Technical Institute (Moscow) as an engineer.

From 1989 Natalia worked for the Russian PTO, starting as an examiner at the Department of Theory and Practice of Intellectual Property Protection and became a Vice-Chairwoman of the Chamber of Patent Disputes in 2004. Natalia was a member of Qualification Commission of the Russian PTO and a tutor of the WIPO World Academy internet-based distant learning “Introduction to IP”. She was also a member of the WIPO Committee of IPR protection, has a number of publications, particularly on trademarks, and regularly gives presentations at IP conferences and seminars.

Similarities of National trademark related legislations of EAEU member-countries

- Legal protection is granted to a trademark on the basis of its state registration; the exception is protection of well-known trademarks that are granted due to the provisions of Paris Convention
- Examination of applications is performed in two stages: formal (preliminary) examination and examination of a sign claimed as a trademark (substantial examination)
- Substantial examination includes reviewing of both absolute and relative grounds
- Division of an application is possible before a decision on the parent application is adopted
- There are similar conditions and procedures for establishing trademark priority, including convention and exhibition priority
- PTO's decisions and trademark registrations may be opposed in administrative and/or judicial bodies.



Differences in national trademark protection systems of EAEU countries

In Russia and Armenia, applications are published and any interested person may submit to the trademark office their oppositions against registration of a trademark under the said published application. Moreover, in Armenia such oppositions are considered in a special procedure including payment of a fee and adopting a decision based on results of the said consideration on the application examination stage, while in Russia an expert merely takes notice of filed oppositions and there is no specific procedure for considering them.

In Armenia and Belarus, if the applicant disagrees with a decision on his application, additional examination may be carried out upon the applicant's request. If the applicant disagrees with a decision adopted on the basis of additional examination, he can appeal the decision in the body of appeal of the PTO.

In Kazakhstan, unlike other EAEU countries, protection of well-known trademarks is limited in time. Well known trademark certificate's term is 10 years, and if the trademark owner wishes to renew the trademark protection for the next 10-year period he has to prove that the mark is well-known once again. Furthermore, in Kazakhstan, there is a provision prohibiting registration of the same trademark in the name of another person within one year after the expiration or termination of protection of the said mark.

Similarly, in Belarus, if a trademark was registered in the name of one person it is possible to register such mark in the name of another person, no earlier than 6 months after the previously registered trademark is terminated or expired. Laws of other EAEU countries do not contain similar provisions.

In Kazakhstan and Kyrgyzstan, a term for examination of a sign claimed as a trademark is fixed by law, and is 9 and 12 months from the filing date respectively. Moreover, in Kyrgyzstan expedited examination within 6 months from the filing date is available upon filing the relevant request and payment of a relevant fee. In Armenia

and Russia, a one month term for formal examination is prescribed by law and the average term of consideration of trademark applications is about 12 months. There are no set timeframes for examination in Belarus and the actual timeframe for considering trademark applications is about 24 months.

In all EAEU countries it is provided that the legal protection of a trademark may be terminated due to its non-use. Specifically in Belarus, Kazakhstan, Kyrgyzstan and Russia, a three-year term (starting from the registration date) for the admissible non-use of a trademark is established, while in Armenia a five-year term is provided (according to Eurasian Economic Union Treaty, all EAEU countries should apply 3-year non-use term, therefore it is likely that Armenia will change its legislation in this part). In Armenia, Belarus, Kyrgyzstan and Russia cases on early termination of trademark protection due to non-use are handled by courts and in Kazakhstan – by an appeal body of PTO.

Costs

Currently the minimum costs that include fees (i.e. excluding attorney's fees and other disbursements) for registration of a trademark, in respect of 3 ICGS classes in five EAEU member-countries under national procedure, are no less than \$2,825 (Armenia – \$330, Belarus – \$750, Kazakhstan – \$235, Kyrgyzstan – \$980 and Russia – \$550).

Aside from national registration, trademarks can obtain protection on the territory of EAEU member countries on the basis of Madrid International Trademark Registration System. Assuming the same initial data, in order to obtain protection of a trademark on the territory of all EAEU countries, a trademark owner from a country that is a party to Protocol Relating to the Madrid Agreement (for example Japan or USA) has to pay an international registration fee in the amount of CHF 2,025 (upon subsequent designation) or CHF 2,378 (in case of new international application), or CHF 800/1,153 respectively, if the trademark owner is from a country that is a party to both Madrid Agreement and the Protocol, i.e. Italy or Morocco.

Regional system of trademark protection in EAEU is still to be elaborated. Time will show if it will be more convenient and/or cheaper.

Draft Treaty on Trademarks

Regional trademark and service mark protection system, providing establishment of Union Trademark as well as regional system for protection of appellations of origin of goods (geographical indications), will be regulated under the Treaty on Trademarks, Service Marks and Appellations of Origin of Goods of the Eurasian Economic Union drafted under the auspices of the Eurasian Economic Commission (EEC).

In general, this draft Treaty does not provide for creation of a regional trademark office, rather it provides for collaboration of all EAEU countries' PTOs, in examining of an application for registration of a Union Trademark, which would be valid in all EAEU countries simultaneously. The Draft Treaty also provided that the Eurasian Economic Commission will manage the Unified Register of Union Trademarks. Disputes regarding infringement of exclusive rights to Union trademarks on the territory of any Union's country will be handled in accordance with national legislation of this country, and the liability for the infringement of Union Trademark will be the same as for infringement of a trademark registered under the national procedure, or an international registration valid in that country.

In order to register a Union Trademark it will be necessary to file a single application in PTO of any EAEU country, at the applicant's option. Union Trademark application is to be filed in Russian regardless of what PTO is chosen by an applicant as a filing office. Applicant from countries outside EAEU shall act through patent attorneys registered in the corresponding filing office.

Preliminary (formal) examination will be carried out only by the filing office and the filing fee will be equal to the fixed in that filing office. In case of positive result of preliminary examination, the application will be published on the EEC's official site. After that, interested persons will be able to provide the filing office with their observations regarding registration of the claimed trademark.

Examination of a sign claimed as a trademark will be carried out by each national office of EAEU countries. The third parties observations, if submitted, would to be considered by all national PTOs during the examination of the claimed mark. In the course of examination, both absolute and relative grounds for refusal will be checked.

On the basis of national PTOs' opinions, the filing office will either adopt a decision to register a Union Trademark, or notify the applicant of the grounds for refusal communicated to the filing office by national PTOs. Any national PTO's refusal to register the claimed mark may be appealed in accordance with the respective country's procedure for such an appeal.

In case of positive opinions from all national PTOs, the filing office will make a Decision of Registration of a Union Trademark and enter the mark into the Unified Register of EAEU Trademarks.

Draft Treaty provides that it will be possible to oppose a registered Union Trademark in a competent body of any EAEU country in accordance with procedure set forth by respective country's legislation, but only on the grounds provided by the Treaty. Meanwhile, if a Union Trademark is ruled invalid by a decision of any competent body, the trademark owner will be entitled to file a national trademark application (or applications) preserving the priority date of the invalidated registration.

The exclusive right to a Union Trademark will be valid for 10 years from the filing date, with an option of multiple renewals each time for 10 more years. In order to renew a Union Trademark registration it will be necessary to file a request to the filing office and pay renewal fees set forth in each of EAEU countries.

Draft Treaty provides that a Union Trademark registration may be terminated early due to non-use. At the same time, use of the Trademark at least on the territory of one of the EAEU countries, would be recognized as sufficient use for the purposes of maintaining the registration.

Minimum costs that include fees for examining the application and registration of a Union mark in respect of 3 ICGS classes (excluding attorney's fees and other disbursements) are about \$1500 to \$1850, depending on the chosen filing office.

Regional trademark protection system provided by the draft Treaty provides the following advantages comparing to the national trademark registration systems:

- It will be possible to file an application for registration of a Union Trademark to any EAEU member-country's PTO
- On the basis of one application, a Union Trademark certificate will be issued, certifying the trademark owner's exclusive right on the territory of all Union countries
- Expenses on fees will be lower, since both filing fee and fee for registration and issuance of a certificate should be paid only in respect of one PTO – that is, the filing office.





Current procedures for obtaining trademark protection in EAEU countries as well as EAEU regional trademark system, which most likely will be implemented in the near future, will allow the applicant to choose the optimal strategy for obtaining trademark protection.

Protection of appellations of origin of goods (geographical indications) in EAEU countries.

EAEU countries have national registers of protected appellations of origin, including both appellations related to geographical objects inside that country and appellations related to the objects on other countries' territory. New entries are registered in those Registers by national offices under the procedures set forth by national laws. The procedures provide filing an application for registration of an appellation of origin, and granting the right to use the said appellation or filing

an application for granting the right to use the registered appellation of origin.

EAEU's Draft Treaty provides recognition of appellations of origin registered in EAEU countries as appellations of origin protected on the territory of all EAEU countries. It will be carried out by registration of the nationally-registered appellations of origin into the Unified Register of Union Appellations of Origin and issuance of a unified certificate of protection.

Under the Draft Treaty, the Union countries shall not be obliged to protect another country's appellations of origins that are not protected, or ceased to be protected, in that country.

In order to obtain protection to appellations of origin on the Union territory, applicants from EAEU countries will file corresponding applications to their national PTOs. Applicants from other countries may choose any EAEU country's PTO as their filing office. Procedure of registration of appellation of goods in EAEU countries' national PTOs and fees for filing an application are set forth by the each EAEU country's legislation, while a fee for registration of appellation of origin in the Unified Register will be determined as a sum of registration fees of all Union countries. For each appellation of origin registered in Unified Register the right holder will be granted with a single document certifying both protection of appellation of origin and his right to use it on the Union territory.

Draft Treaty, therefore, did not provide for examining appellations of origin applications by each national PTO of EAEU countries. In fact, Union countries recognized as valid on the Union territory appellations of origin protection are granted by a filing office upon payment of the respective fees by the applicant. This procedure will simplify obtaining of protection for appellations of origin on the territory of EAEU.

“ EAEU's Draft Treaty provides recognition of appellations of origin registered in EAEU countries as appellations of origin protected on the territory of all EAEU countries. ”

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