

Working with the experts

Agile registration strategies are crucial in Russia, with foreign applicants required to be represented by Russian trademark attorneys who are registered at the RPTO

In Russia, trademark rights arise from state registration of a national trademark or by securing protection of an international mark designating Russia. Therefore, registration strategy is crucial to securing trademark rights in Russia.

Protected signs and ways to secure trademark protection

The Civil Code defines a 'trademark' as a sign which serves to individualise the goods and services of legal entities and entrepreneurs. In other words, a trademark is a perceptible sign which is capable of distinguishing the goods and services of one party from those of another. Russian law states that any designation, including but not limited to verbal, device, combined and three-dimensional signs, can enjoy protection as a trademark. A trademark can be claimed in colour, colour combinations or monochrome.

This legal definition of protected signs enables registration of both traditional and non-traditional signs in Russia, including three-dimensional, sound, motion and smell marks.

Russia is a first-to-file country; the party which applies first for registration of a trademark has priority rights to register the mark. For this reason it is essential to file trademark applications without delay. This is particularly important given that the Russian trademark system does not formally recognise prior-use rights.

Rights holders can protect their marks primarily through the trademark filing system, both national and international. In particular, a rights holder is entitled to apply for registration of its trademark by way of filing a national trademark application with the Russian Patent and Trademark Office (RPTO).

In addition, Russia is a signatory to a number of international treaties (eg,

the Madrid System) dealing with the international registration of trademarks, whereby rights holders can seek protection of their trademarks simultaneously in a number of designated countries – including Russia – within the framework of a single application.

Moreover, a trademark can enjoy protection as a well-known mark without being registered.

Representation before the RPTO

Under Russian law, foreign applicants must be represented by Russian trademark attorneys who are registered at the RPTO. In order for an application to be filed in the name of an entity residing outside Russia, such entity must appoint a Russian trademark attorney to represent it before the RPTO in all proceedings.

Types of application

Each application can cover only one mark; it is not possible to claim a series of marks or several variants of the same mark within one application. A separate application must be filed for each version of the mark.

Multiclass applications are available; an applicant can claim as many classes as it wishes in one application.

There is no need to file a declaration of use or intent to use along with an application.

Specification of goods and services

When filing an application, the applicant can claim class headings, a list of specific goods or both. The latter is the preferred option, since it encompasses broader protection and registration for goods which are most important to the applicant, and also because class headings do not automatically cover all of the goods specific to a particular class. Aligning the wording of the applied goods

and services with the terms used in the Nice Classification helps to avoid the RPTO requesting further classification.

Examination

Once an application has been filed, it must be examined. Examination is composed of a formal and substantial stage. Currently, there is no time limit for conducting a substantial examination in relation to national applications. However, existing practice suggests that it takes the examiner approximately one year to complete the examination.

With respect to Russian designations of international marks, the examination period is strictly limited to one year.

Traditionally, examination is carried out to establish whether the claimed designation conforms to the registrability requirements. If not, it may be refused on either absolute or relative grounds, or both.

Absolute grounds are based on the substance of the mark itself (ie, its semantic meaning). These grounds include lack of distinctiveness and confusion. Common examples of designations which may be refused due to lack of distinctiveness include simple combinations of letters and numbers which do not possess verbal character and lack specific graphic representation, and those which are descriptive of goods or their origin.

Marks which do not meet the registrability requirements (eg, due to their descriptive nature) are recognised as inherently unregistrable. However, such marks can still be registered and granted protection if they have acquired distinctiveness on the Russian market.

Acquired distinctiveness must reflect widespread and long-term use of the mark worldwide and on the Russian market in particular before the priority date, and must be proven in order to be considered by the RPTO.

Relative grounds consider whether the claimed designation conflicts with any existing third-party rights to an identical or similar sign or neighbouring rights.

In most cases, refusal is based on a risk of confusion of the claimed designation with a registered or applied-for similar third-party prior mark in relation to similar goods.

When checking trademarks for similarities, the RPTO judges the extent to which the marks are similar based on certain criteria, including phonetic and conceptual perception and graphic representation.

The RPTO is guided by a set of criteria covering the similarity between goods, including type of goods, functional designation, the range of consumers and sales conditions. In general, these criteria are taken into account in the aggregate.

If a trademark is refused on the basis of similarity to a third-party mark, such refusal may be overcome by submitting a letter of consent – giving permission to register the claimed designation – from the owner of the cited mark. The question of whether to accept the consent letter is left to the examiner's discretion. Russian law does not allow consent letters in relation to identical marks.

Existing practice shows that consent letters may not be accepted if they relate to identical or nearly identical marks for which the risk of confusion is extremely high.

A consent letter has a better chance of being accepted if it is granted by a related company, or if it is accompanied by a co-existence agreement entered into between the parties.

The registrability requirements for national and international marks are the same. However, the procedure associated with the registration of international marks differs slightly from that of national applications.

In particular, the examination period for international marks is strictly limited to 12 months. If an international mark is provisionally refused, the RPTO will notify the World Intellectual Property Organisation (WIPO) of the refusal; in turn, the WIPO will communicate the refusal to the applicant or its representative. In such case, the applicant has a six-month period (not extendable) running from the date of issuance of the provisional refusal within which to respond.

The RPTO has recently started issuing statements of protection grants for the Russian designations of international marks for which the examination period has expired without any provisional refusals.

Opposition procedure

There is no opposition procedure in Russia;



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it is impossible to oppose applications while they are pending. This is because the RPTO conducts examinations on both absolute and relative grounds; if it finds any obstacles to registration, it is supposed to cite them against pending applications *ex officio*. In the meantime, it is common practice in Russia to file a so-called informal opposition against pending applications at the examination stage. Although the examiner is not obliged to take the claims into account, practice shows that in most cases, the examiner will take note of such opposition when conducting his or her examination.

Formal oppositions in the form of invalidation actions based on absolute or relative grounds can be filed only after registration of a trademark.

Well-known marks

All designations, regardless of whether they are registered or otherwise protected in Russia or are used in Russia without such registration or protection, may be recognised as well known.

In order for a designation to become well known in Russia, it must meet certain requirements.

First, it must be distinctive.

Furthermore, the rights holder must demonstrate extensive and long-term use of its mark worldwide and specifically in Russia. The use must be extensive enough to result in a close association between the mark and a particular trader and products in the minds of consumers.

If the mark is used to designate specialised products which have a limited range, it is normally sufficient to demonstrate that the mark has become famous among the relevant range of consumers only.

The mark should already be protected as a well-known mark in other jurisdictions (eg, in the country of origin).

In order for a mark to obtain well-known status in Russia, the rights holder must apply for recognition as a well-known mark by filing a special application with the RPTO.

When filing an application, it is imperative to indicate the date on which the rights holder believes that the mark became famous in Russia. It is crucial that this date pre-date priority of any similar marks owned by third parties recorded on the register in relation to similar goods.

Once the RPTO has examined an application for recognition of a trademark as well known, it will issue a decision.

Cancellation proceedings based on non-use

In Russia, a trademark registration becomes vulnerable to cancellation for non-use three years after the registration date. Thus, after expiration of this grace period, any interested third party is entitled to file a cancellation action against the trademark registration on the grounds of non-use. A legitimate interest in pursuing the cancellation action must be proved.

The cancellation action may be based on a mere presumption that a trademark has not been used in Russia. The onus is on the rights holder to prove that its trademark has been used in Russia within three years preceding the date of filing of the cancellation action in order to retain registration.

Although use is obligatory, Russian law provides some exceptions for non-use. These are circumstances beyond the rights holder's control (ie, *force majeure*, personal health and unpredictable political decisions). These circumstances may be used as a defence in the cancellation proceedings.

From December 9 2011 all cancellation actions for non-use are considered by the Moscow Commercial Court. [WTR](#)