

G-NEWS

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PATENT AND TRADEMARK ATTORNEYS
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Green Services or “Color Revolution”



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A trademark may be anything but for the most part the trademarks are words, images or combinations thereof. The laws of some of the countries allow registration of 3D, sound, smell and color trademarks. The last one is especially tricky. WIPO conducted a poll among patent offices. Some of them ignored the poll. Out of those who agreed: 48 offices of 79 replied that they could accept color trademarks for registration. Other patent offices directly forbid registration of color or are tacit about it.

If we look back in time the Russian laws on trademarks beginning from 1992 and onwards were quite liberal. They allowed registration of word, figurative, 3D trademarks and other designations or their combinations. A color may well be “other designation”, in theory. Not so in practice. Years have gone without any noticeable progress in this direction. The basic rationale behind the registration criteria is that a trademark should be distinctive. Historically, it was a generally accepted principle that the color per se has no distinctive capability and thus it is not possible to register a color as a trademark.

So what difficulties stand in the way of registration of color? If we examine the Russian and foreign practice we may note that the main reason of rejection of color trademarks is that there is a presumption that the color per se does not ensure distinctive capability. This is related to the fact that the color is a characteristic of a material object and not the object itself » page 2

while a trademark application should define the object. Thus proceeding from the basic assumption that the color per se is not protectable the applicant will have to prove that the color designation acquired distinctiveness and is associated with certain goods (packaging) or services and their manufacturer (provider). The Russian PTO routinely rejected trademark applications, e.g. No 2012728853 which represented a rose color without specific graphic character



According to the standard approach of the Russian PTO a color per se cannot individualize the goods or services. In response to that the applicant argued that the rose color distinguishes the goods produced by him so that the consumer when choosing a product is guided by the color of the packaging. However the

Russian PTO dismissed that argument stating that it is of a purely declaratory character. No information was provided confirming that the goods whose distinctive feature is the rose color had been produced by the applicant and were known to consumers on the priority date of the application. To add insult to injury the Russian PTO stated that the packaging of rose color is characteristic for baby girls cosmetics and is used by many producers.

Hence, as shown above, the situation with the registration of color trademarks is ambiguous. On the one hand there is no ban in the law, on the other hand it is assumed that the color does not have distinguishing capability. This is the problem which confronts the applicants wishing to obtain a color trademark. One of the consequences of this dilemma is that the applicant has to put in much effort (time and money) to prove that his claimed designation has acquired distinguishing capability. An expensive public poll is almost a *conditio sine qua non* among other measures.

The applicant should be prepared to provide information on the duration and intensity of use of the designation, on the territory and the scope of sales of goods marked with that designation. He should disclose information on how much he spent on advertising and for how long the publicity campaign lasted, show

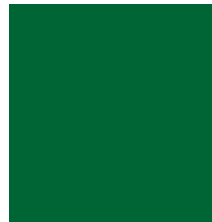
Gorodissky & Partners conducted through an agency a public poll which gave predictable results. The respondents were shown the claimed designation and 97% of them said it was Sberbank.

the extent to which the consumers are aware of the claimed designations and the manufacturer of goods (provider of services) and provide much more other evidence of use of the color mark.

A question apart which additionally complicates the efforts of the applicant is that the color may be perceived by the consumer differently depending on the surface on which the color is applied, be it paper, plastic, cloth or metal. The perception depends also on the light under which the color is looked at and also the viewers may have different perception depending on the anatomy of their eyes. Hence the examples of use of the trade-

mark may not be uniform but have different shades of the same color. Should it be the case the applicant should be prepared to conduct additional investigation or a public poll to find out how the consumers perceive the color if it slightly differs in its shades.

This was the ambient environment in which Gorodissky & Partners engaged when it applied for a color service trademark registration on behalf of Sberbank, its client. Sberbank is the largest Russian savings bank which provides services to dozens of millions of people in Russia and abroad. The trademark application was filed in 2012 under No 2012705389 and represented a green color



Even before the examination began Gorodissky was confronted with unexpected difficulty: another bank (Center Invest Bank) learned from the media that Sberbank had filed a trademark application representing the green color. The Center Invest Bank sent a complaint to the Russian PTO arguing that it had

long used the green color in its registered trademark and asked to discontinue examination of the Sberbank application. The study of the complainant's trademark revealed however that the trademark of the complainant was not the color per se but a combined trademark having an image and words. Different colors, including green, were used in the trademark.

The first reaction of the Russian PTO to the application filed by Gorodissky & Partners was expectably negative. It stated in its official action that the claimed designation was not distinctive because it could not individualize a specific legal person. Gorodissky objected and referred to the Civil Code Article 1483 which provides that this argument is not valid if the designation acquired distinctiveness as a result of intensive use. Sberbank was founded in 1841 and since then was a leader according to the scope of banking services. It keeps savings of almost half of the Russian population. It also serves the largest Russian corporations and state enterprises. Aside from Russia Sberbank operates in many foreign countries including Central and Eastern Europe (e.g. Sberbank Europe AG). The operation of Sberbank is inseparably linked to the use of green color in its activities. As far back as in the 20s of the last century the bank actively used the green color in its advertisement of services. Gradually it became one of the basic elements individualizing its activities. All branches of the bank used green color on the date of filing the trademark application. It was used in advertisements, on furniture, the walls were painted green, all the employees of Sberbank (more than 200,000) wore clothes which included green elements.

All men wear green ties and ladies wear green scarves. Sberbank spent much money on advertising. Only in 2010 – 2011 it spent about 4.5 billion rubles on advertising. All cash machines whose number is over 80,000 are green exactly as the trademark application. It should be noted that the cash machines are omnipresent: they are installed not only in the Sberbank offices but in big shops, airports, railway stations. In short, all the territory of Russia is covered with the branches and cash machines of Sberbank. In addition, the Internet site of Sberbank (www.sbrf.ru) is also predominantly green. Besides, Sberbank has already

Events

(conferences, seminars, news)

8.02.2016 // MOSCOW

Gorodissky & Partners joined the Russian Franchise Association (RFA). The RFA was created in 1997 to support business and protect the interests of its members as well as to create a more favorable legal and economic environment for the spread of franchising in Russia.

3.03.2016 // KIEV

Trademark Attorneys Maxim Kravchenko and Alla Bocharova (both from Gorodissky & Partners, Kiev), attended the Roundtable "Development of examination procedure of applications for trade and service marks" hosted by the IP State Service of Ukraine. The acute issues of establishing priority under application for registration of trade and service marks and also development of procedure of filing opposition against trademark registration were in the focus of discussion.

16.03.2016 // ALMETYEVSJK

Albert Ibragimov, Russian and Eurasian Patent Attorney, Regional Director, Anton Khomyakov, PhD, Patent Agent and Airat Galimov, Patent Agent (all from Gorodissky & Partners, Kazan), gave series of lectures in Almetyevsk, Republic of Tatarstan, on protection of technical innovations in the field of oil exploration, production and transportation for CEOs, engineers and inventors from oil and gas producing companies of the region.

22.03.2016 // TOKYO



Photo: Cover of the manual

Third edition of "IP Management in Russia" in Japan. A new manual covering all aspects of registration, disposal and enforcement of intellectual property rights in Russia has been written by a team of lawyers and patent/trademark attorneys of "Gorodissky" for JETRO (Japan External Trade Organization). Co-authors of the book are: Nikolay Bogdanov, Alexander Vasilets, Natalia Stepanova, Vladimir Biriulin, Ilya Goryachev, Sergey Medvedev, Evgeny Alexandrov, Olga Yashina, Anton Melnikov. The Chief Editor was Vladimir Biriulin.

This unique IP manual in the Japanese language is published in 5000 copies and is distributed among Japanese industrial companies and organizations.

30.03.2016 // EKATERINBURG

Elena Baikovskaya, Russian Patent Attorney, Ekaterina Solonitsina, Senior Lawyer, and Andrey Starodumov, Lawyer (all of Gorodissky & Partners, Ekaterinburg), spoke at the seminar "From idea to innovations: how to get an exclusive right to the intellectual activity result and to use it in competition" held by Gorodissky & Partners in cooperation with the Sverdlovsk Regional Entrepreneurship Support Fund and the Sverdlovsk Venture Fund in Ekaterinburg.



Photo: During the seminar

4.04.2016 // MOSCOW

Sergey Medvedev, PhD, LL.M., Senior lawyer (Gorodissky & Partners, Moscow), gave a lecture on "Protection of Brand as IP Asset: brand identifiers, counterfeiting and brand protection" at the advanced marketing studies "Brand Management" for marketing specialists at the Higher School of Marketing and Business Development of the Higher School of Economics (HSE). The lecture highlighted legal and practical aspects of trademark registration, trademark use and non-use, disposal of trademark rights, the aspects on counterfeiting/parallel imports and other issues. Sergey also cleared the main difference between trademarks and trade names and described certain problems of protection of corporate identity and business reputation. Around 30 students specialized in advertising and marketing attended the lecture.



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