

Non-traditional trademarks – a changing picture

The Russian regime does not set down separate regulations to govern applications for non-traditional trademarks, although moves are afoot to improve the legislation

Today in Russia, there is growing interest in non-traditional trademarks. The prosecution practice has developed rapidly and intensively over the past few years. This is illustrated by the number of publications on this issue, as well as the fact that non-traditional trademarks have become a popular topic at many seminars and conferences relating to different aspects of trademark registration and protection. The growing tendency to register these kinds of trademark can be explained by the development of new production technologies and multimedia technologies, which often enter the market aggressively. Producers of goods and service providers must fight for markets and consumers, and alongside advertising and promotion, trademark function is a key means of attracting consumers' attention. An interesting, original and non-traditional trademark is just one way to attract consumers.

The trademark legislation sets down no limitations in respect of what can be registered as a trademark, provided that the sign is distinctive. Article 1482 of the Civil Code, which governs trademarks, provides that verbal, pictorial, three-dimensional and other indications or their combinations may be registered as trademarks. A trademark may be registered in any colour or colour combination. The wording "other indications" confirms that the law is quite liberal in this regard. Nonetheless, the Civil Code provides that a trademark cannot be granted for a designation that lacks the capability to distinguish (Article 1483 of the Civil Code); under the current practice of the Russian Patent and Trademark Office (RPTO), indications that may be deemed 'non-traditional' trademarks are often rejected by examiners as lacking distinctiveness. The law provides for the

possibility of registering a mark based on the fact that the applied designation has acquired distinctiveness – that is, exceptions may be made for designations that have gained the ability to distinguish goods as the result of acquired distinctiveness. Thus, if a trademark is rejected due to a lack of distinctiveness, the applicant can respond to the examiner's objections by arguing that the applied mark is distinctive enough and, if the trademark has been used by the applicant in Russia, evidence of such use can be submitted and considered during examination or at the appeal stage. In such cases evidence of use of the mark in Russia before the filing date is vital. The legislation does not prescribe a list of documents to be submitted, but practice shows that various materials may be used, including shipping and customs documents, invoices and copies of agreements; results of an opinion poll confirming that consumers associate the mark with the applicant and its goods; copies of annual reports (extracts indicating Russia as the country of supplies and the volume of sales); statements or evidence from local distributors and/or local shops, including dated price lists; Russian quality and conformance certificates; and advertising materials. All documents should prove a strong link between the trademark, the products or services and the applicant.

In general, all kinds of trademark except word marks, figurative marks and combination (word and device) marks may be considered non-traditional. As the registration of three-dimensional marks has been common practice in Russia for some time, these types of trademark can now be ranked among the traditional trademarks. More unusual are trademark applications and registrations for colour marks (either colours *per se* or colour combinations), sound marks, texture marks, olfactory

marks, position marks, hologram marks, motion marks and taste marks. This list is not exhaustive and may be added to as new types of mark and combinations of non-traditional marks appear. The list is limited only by the creativity of producers and their desire to obtain protection for the indications that they use to identify their products and services.

Colour marks

Of all non-traditional trademarks, colours and colour combinations attract the most attention from manufacturers and services providers. However, although colour may be easily represented graphically, the distinguishing capability of a mere colour or colour combination is questionable.

According to the Civil Code, a trademark may be registered in any colour or colour combination. In this connection, it can be asked whether a mark consisting of a colour *per se* or a combination of colours, without word or figurative elements, may be protected. Taking into account that the law does not forbid such registration, the answer is affirmative – but the condition for such registration is that the particular colour may have enough distinguishing capability and identify a product (ie, be associated with the producer of the relevant goods). In other words, the colour must have acquired distinctiveness.

The practice of the RPTO shows that trademarks consisting of a mere colour or a combination of colours are considered to lack distinctiveness and are usually rejected during examination for this reason. While the Trademark Register contains marks consisting of mere colours, a trademark application consisting of just one colour or a combination of colours has little chance of being registered. However, in theory, the possibility of registering a colour or

combination of colours as a trademark in Russia exists, provided that the applicant can prove that the colour or combination of colours functions as its trademark and that this trademark has acquired distinctiveness through intensive use in Russia. One such example is the trademark registration by Reckitt Benckiser of its pink colour for Vanish stain remover. This colour mark was registered by the RPTO in 2006 as Trademark 310048.

The RPTO has also granted legal protection to several colour combinations. For example, Deere & Company filed a combination of green and yellow colours for registration as an international trademark designating Russia (among other countries) as Application 883509. Deere is a well-known producer of agricultural appliances and vehicles, which have been painted in green and yellow for many years. The trademark was described as a combination of green and yellow applied to the listed goods, with the green colour applied to the vehicle body and the yellow colour to the wheels. This use of the colours has been intensive and is highly recognisable. This allowed the applicant to overcome the objections raised by the RPTO and obtain legal protection for its trademark.

Thus, although in some cases colour marks have been registered, some issues still remain undecided, as the ability of the trademark owner to enforce its trademark rights in such cases is still uncertain. In regard to ordinary marks, the similarity criteria (eg, phonetics, visual appearance) are easy to check. However, if a colour mark leads to litigation, the absence of comparators may mean that the trademark owner is unable to defend its trademark rights sufficiently.

Sound marks

Sound marks are another good way to capture consumers' attention. Entrepreneurs increasingly use tunes or music to identify their products or services. For example, music that is repeatedly used in advertising or a tune which is played when a device is turned on or off may function as a means of individualisation and may distinguish products. The registration of sound marks is possible in Russia, but there have been few such registrations so far.

The RPTO applies the same requirements to sound marks as it does to ordinary marks. Different forms of expression of sound marks are available – for example, a sound mark may be presented as written notes, an audio file or a



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phonogram. The form of expression may depend on the trademark registration procedure chosen by the applicant: an international filing or a national application. In the latter case, the applicant has more possibilities, since in case of an international filing through the World Intellectual Property Organisation, a sound mark can be presented only as written notes (ie, an applicant cannot register natural or functional sounds). In contrast, a national application for a sound mark filed with the RPTO can be presented in different forms, such as a magnetic tape or a CD with recorded music files or a frequency chart. This allows for the registration not only of different tunes, but also of sounds that do not represent a melody playable on a musical instrument.

In a similar fashion to an ordinary mark, a sound mark must go through all of the examination stages, including substantial examination, where the issue of similarity of the trademark to prior applications or registrations is examined. An examination on absolute grounds is also conducted, and

the registration may be rejected if the examiner finds that the trademark lacks distinctiveness. A sound mark may also be rejected if it misleads consumers or conflicts with public interests and morals.

Information about registered sound marks is published by the RPTO in the *Official Bulletin* and on its website. The online publication of a sound mark usually contains written notes. Occasionally, sound files in mp3 format are available online for download. Examples of registered sound marks include Russian Registration 172216 by Intel Corporation in Class 09 and International Registration 729484 by Deutsche Telekom AG in Classes 09, 16, 25, 28, 35, 36, 37, 38, 39, 41 and 42.

Position marks

Position marks also deserve special attention as the registration of such marks is becoming popular in Russia, particularly among clothing and shoe manufacturers. Several recent cases connected with position marks gave an indirect explanation of the nature of a position mark and its functionality. According to recent practice of the RPTO, if registration of a position mark has been applied for, the description of the trademark should indicate that the applied mark is a position mark, which means that the shape of the product is not subject to separate legal protection and functions only as a representation of the way in which the trademark is affixed to the product. A good example of a position mark is International Registration 902264 by HUGO BOSS Trade Mark Management GmbH & Co KG in Class 25.

Comment

Unlike in some other jurisdictions, the Russian legislation does not set down separate regulations to govern the legal protection and procedural issues connected to applications for non-traditional trademarks. Nevertheless, the need for such regulations is clear and, based on existing practice in Russia and abroad, the RPTO is working on proposals for further improvements to the legislation. [WTR](#)