

Playing the language game

In Russia, a number of factors need to be considered when registering a mark, with particular care needed when considering the language and scripts to file applications for

In Russia, in order to file a trademark application, it is not necessary to submit material proving use of the mark or even intention to use. However, before filing a trademark application, certain general points should be taken into account in order to ensure that proper protection for the trademark is obtained. According to Article 1482(1) of Part 4 of the Civil Code, “word designations, device designations, three-dimensional and other designations or their combinations may be registered as trademarks”. The phrase “other designations or their combinations may be registered as trademarks” implies that there is no limitation on the types of mark available. Such designations may be sound, sensor trademarks, film clips, or combinations of these. Moreover, Article 1482(2) states that “a trademark may be registered in any colour or colour combination”. However, this statement does not mean that protection of a black-and-white trademark automatically provides protection to a variant of that mark in colour. The owner of a trademark in black and white does not have exclusive rights for all colour variants of the trademark.

However, the approach of the Russian Patent and Trademark Office (PTO) is changing, as can be seen from the recent decisions of the Chamber of Patent Disputes, which is now a department of the PTO. For example, in accordance with recent decisions of the Chamber, use of a trademark in black and white covers its colour variant registered as a trademark. At the same time, where an owner wishes to change a colour-registered trademark into a black-and-white mark, the PTO will not allow such a change, which it considers a significant amendment of a registered trademark.

Uncertainty also shrouds the protection of word marks filed in Cyrillic, Latin or other

scripts. It is impossible unambiguously to assert that a Cyrillic version of a registered trademark allows the owner to protect the Latin version of that mark. Despite being identical phonetically, such marks differ visually and there is debate as to whether they can be viewed as similar under trademark law. The situation becomes more complicated in cases where the word mark has a literal meaning, since the phonetic and visual perception of a translated version may differ significantly from that of a transliterated version of the same word. Proving similarity between these versions to the extent of confusion is often problematic and sometimes impossible.

These considerations are important when choosing an appropriate registration strategy. It may be necessary to register all possible versions of a mark: black-and-white and colour variants, and Latin, Cyrillic and Russian versions. However, even this strategy carries risks, since if a mark is not used within three years of the date of registration, it may become vulnerable to a non-use cancellation action. In addition, trademarks written in scripts other than Cyrillic and Latin, for example as hieroglyphs, are viewed as device marks and are not considered to be word marks, since they cannot be understood by Russian consumers. As a result, registering the Cyrillic and Latin versions of a mark written in non-Latin script is recommended.

These recommendations apply to marks which consist of combinations of word, device and other elements. In accordance with Russian legislation, a mark is protected as it is registered. Given that a registered combined trademark does not safely protect each element of a combination, parties would be advised to register each element separately, as well as registering combined trademarks as a whole.

An important strategic aspect of trademark protection is the proper elaboration of the list of goods or services. There is a common misconception among those filing trademark applications in Russia that simply listing the appropriate Nice Classification heading gives protection in respect of all goods or services within that class. Part 4 of the Civil Code does not permit such an assumption.

On January 1 2011 the examination procedure for trademark applications changed. In place of the two trademark departments which dealt with formal examinations and substantive examinations, the PTO has been re-organised. The Department of Formal Examination is responsible for formal examinations (ie, national trademark applications). It checks that the correct fees have been paid, that application forms have been filled in correctly and that the relevant designations have been described accurately. Meanwhile, the Department which prepares trademark applications for substantive examinations checks that the wording of the terms of the relevant goods and services and the classification reference are correct. The substantive examination department carries out examinations checking designations against the applicable registrability criteria.

The International Registrations Department is responsible for examining international registrations and applications only. Previously, such examinations (apart from formal examination) were conducted by a single Trademark Department.

This new scheme is intended to improve efficiency in processing the large number of trademark applications which are filed with the PTO every year. The new scheme may increase the number of inquiries undertaken or examiner's notifications

issued in respect of national trademark applications, since the different departments will check that applications have been correctly classified and that they comply with the provisions of Russian legislation. Nevertheless, the intention is to retain the examination approach.

The applied designation is checked in respect of so-called 'absolute grounds for registration'. The most common grounds for refusing an application are that it lacks distinctiveness or has descriptive character, or is made up of widely used symbols or terms. By way of illustration, designations which consist of consonants only will be rejected for registration due to lack of distinctive character. The applicant may submit materials to prove the intensive use of the designation in Russia before the date of filing (for national applications) or the date on which protection was claimed in Russia (for international registrations). These materials should prove that the designation has acquired distinctive character as a result of its intensive use by the applicant in Russia.

Although the relevant legislation does not specify the duration for which a mark must be used in order to acquire distinctiveness, the current approach suggests that the mark must be used intensively before a trademark application may be filed (in accordance with national procedure) or protection claimed in Russia for an international registration.

If a sign is misleading or capable of confusing consumers in respect of the goods or with regard to their manufacturer, this also constitutes grounds for refusal. In this regard, examiners may use the Internet to search for information. Where an internet search shows that a trademark has been used by a party other than the applicant, the examiner may notify the applicant, which must then demonstrate, for example, that the information cannot be considered reliable, or that the trademark use is in fact related to the applicant.

Article 1483 sets out other grounds for rejection. However, examinations are not conducted in respect of all of these grounds. For example, no examinations are conducted with respect to trade names, copyrights or agent relationships. However, if the examiners reveal information related to such grounds, the facts in question may be considered to be misleading to consumers in respect of the goods or the manufacturer.

Another ground for rejection applies where a mark is identical or confusingly similar to a trademark that has previously been registered or applied for in respect of



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homogeneous goods and services. Similarity is considered in respect of each element of a sign. The main criteria for considering the similarity of word marks are phonetic, visual and semantic. For marks which lack inherent meaning, phonetic considerations are the most important.

Devices and three-dimensional designations are considered in terms of similarity with regard to exterior form, the existence of symmetry, meaning, type and character of designation, and colour of designation. However, word elements are considered by the examiners to be the most important factor in determining confusing similarity. Where an identical trademark is found to exist, the scope of homogeneous goods or services is considered to be significantly wider.

Russian trademark legislation allows for the registration of similar marks, provided that the owner of the senior mark (registered or pending) consents. However,

an examiner may not accept such a letter where the marks at issue are considered to be too similar. This is despite the provision of Article 1483(6) of Part 4 of the Civil Code, which states: "Registration as a trademark in respect of homogeneous goods of a designation confusingly similar to any of the trademarks referred to in the present subsection shall be allowed only on consent of the right owner."

This situation generally occurs when the marks contain identical word elements and are almost identical phonetically, since the word element of a mark is considered as having the greatest impact on the consumer's perception and memory. However, where the cited mark belongs to a related company, the examiner may accept a letter of consent for a similar mark, provided that such relationship is clearly mentioned in the letter.

It may also be possible to reach an agreement with the owner of the cited mark in respect of a voluntary limitation of the list of goods and services. However, in practice such agreements are rare.

The most radical – and effective – way of overcoming a senior right is to obtain cancellation of the cited mark due to non-use. The proper interest in initiating such non-use cancellation actions must be proved by the applicant before the Chamber of Patent Disputes, which may refuse to consider a cancellation action if it believes that the sole interest of the party in initiating the claim is to remove an obstacle to its own trademark application.

The process of trademark application examination in Russia usually takes between 14 and 15 months. Where any obstacle to registration is revealed, this timeframe is extended. Where the applicant fails to remove an obstacle for registration in time, it has three months to appeal to the Chamber of Patent Disputes against the decision to reject the application. However, any problems relating to obstacles to registration should be solved before the appeal is accepted for consideration.

Often, the examiner cites a registered mark that is owned by the applicant. For example, the pre-existing Latin script version of a mark may be cited against a new version in Cyrillic. This can happen when the mark owner changes address or name, meaning that its details do not match those on the earlier registration. Such differences often give an examiner reason enough to cite the earlier mark as an obstacle to registration. In such instances, it is necessary to change the name and address in the cited registration. [WTR](#)