



Vladimir Trey

Non-traditional trademarks in Russia

Vladimir Trey, Partner, Trademark Attorney, Gorodissky & Partners, discusses non-traditional trademarks under Russian legislation, and looks specifically into how these laws are enforced.

As in many countries, Russian legislation does not exclude the possibility of registration of non-traditional marks. The Russian legislation provides the possibility of registering different types and combinations of designations in addition to word, graphic and three-dimensional marks.

In recent years, producers and services providers have become increasingly interested in using non-traditional marks in respect of their goods or services. The issues surrounding the legal protection of such marks have thus also become more important. Recently, the Russian trademark legislation has undergone some changes and these amendments have removed some legislative gaps with respect to trademark filing requirements or filing formalities, which limited applicants' ability to secure protection for some kinds of non-traditional marks.

Article 1482 of the Civil Code provides that verbal, pictorial, 3D and other designations or combinations thereof may be registered as trademarks. A trademark may be registered in any color or color combination. The wording "other designations" confirms that the law is liberal in this regard. However, according to the law, marks which are lacking in distinctiveness are not allowed to be granted protection, however, the Russian

legislation provides the possibility of registering marks based on acquired distinctiveness.

In 2015 the new Rules of Trademark Filing came into force, which serve as a kind of guideline for the trademark office while examining trademark applications, and for the applicants for adjusting their applications to the legislation requirements. These new rules deserve special attention in part of non-traditional trademarks and their descriptions and representations in the application materials.

Color

Very recent publications in mass media and review of the publically available Russian trademark register show increasing popularity of color trademarks. By filing applications for color marks, applicants try monopolizing a particular color or a combination of colors. According to the Russian practice if there is a strong association between a color and a particular enterprise, as well as a specific product or service, the color may be granted protection and a trademark. Examples of color marks include Deutsche Telekom's magenta color and Deer & Company's green and yellow color combination. The criterion for such registration is that the color in question be capable of sufficiently distinguishing the product or service and its origin; the color must be associated with the product itself and the producer of the relevant goods / provider of the relevant services.

The practice of the Russian Patent and Trademark Office shows that trademarks consisting of a color per se or a color combination are often considered to be lacking in distinctiveness and they encounter the serious examiners' objections for this reason. A trademark application consisting of a single color or a color combination can be registered only if it has acquired distinctiveness and provided that the applicant can prove that the subject color or color combination functions as the applicant's trademark. To prove this, it is necessary to submit evidence that the color or color combination have been used in Russia before the application filing date.

Résumé

Vladimir Trey, Partner, Russian Trademark Attorney

Vladimir graduated from Moscow State Linguistic University as a linguist, in 2004 graduated from the law faculty of the Russian State Institute of Intellectual Property as a lawyer. Specializes in trademarks, in particular trademark proceedings in Russia and CIS and Baltic states, also under Madrid Treaty on International Trademark Registration and Madrid Protocol. Vladimir is an author of a number of publications and a regular speaker at IP conferences and seminars. "Best Lawyers" ranks Vladimir Trey as a leading practitioner in trademarks in Russia. He is also mentioned by WTR-1000/2015 as notable specialist in trademark prosecution and strategy in Russia and Vladimir got an individual IP Star on trademarks and copyright from MIP (Trade mark and Copyright).



The growing interest in respect of color marks is confirmed by the increasing number of such trademark registrations filed both internationally through Madrid system and nationally to the Russian PTO directly. Last year the Russian State owned bank Sberbak registered its corporate green color (pantone 349) as a trademark for financial services. One of the largest mobile Russian telecommunication companies, MTS, registered red color (pantone 485) as their service mark in class 38 for radio telecommunication services. Another example of registration for colors in telecommunication field is from several years ago when another leading Russian telecommunication provider, Vympelcom-Communications, obtained protection for yellow and black color combination being a part of their “bee colors” advertising campaign. The famous Russian oil and gas supplier Gazprom, the owner of a very large trademark portfolio, which includes a number of non-traditional trademarks, has just obtained protection for blue color (pantone 300CV) for goods and services in classes 01, 04, 35, 37, 39, 40 and 42.

Sound

Producers increasingly use tunes or music to identify their products. For example, a tune which is played when an electronic device is switched on or off may individualize this product and distinguish it

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from similar products available on the market. The registration of sound marks is available in Russia. According to the new rules, the Russian PTO imposes specific filing requirements for sound marks: where a sound is applied for registration as a trademark, a description of this sound or characteristics thereof and additionally (depending on a sound designation type), a musical notation of a melody or a frequency diagram of a sound originating from animate beings or articles, must be provided.

The Russian Patent and Trademark Office publishes information on registered sound marks in its Official Bulletin and on its website. The online publication may contain written notes or downloadable sound files in MP3 format.

Motion and luminous objects, holograms

This type of mark is popular in the entertainment or film production industry to identify services in Class 41 or in the IT sector for consumer electronic products or computer software in Class 9.

Where the applied designation is a luminous or motion one, a video recording - comprising a reproduction of the designation that is to give an exhaustive and clear idea of an amount, character, intensity, and sequence of changes - must be provided on a digital medium, and a printed frame-by-frame reproduction of such a designation must be furnished in addition. Where a luminous designation is applied for registration as a trademark, characteristics of light symbols (signals), their sequence, length of luminescence, and other identifying features may be given in the description of the applied mark.

Examples of registered motion marks include Microsoft’s screensaver or an animated clip that is regularly shown before the feature films of a particular production company commence.

Holographic marks are also available for filing and registration in Russia and they have very similar requirements as above-mentioned motion marks.

Smell, taste, and touch-perceived marks

The new rules do not ignore smell, taste, and touch-perceived marks. As far as tastes and smells are concerned, the question arises in respect of representation or transmission of such a designation, especially since no respective media are available which could store this information for a long lasting period of time. Therefore, a correct description of the applied designations becomes of utmost importance for trademark applications of such a kind. The new rules read that where the claimed designation is a smell-, taste-, or touch-perceived one, characteristics of such a designation, which are requisite for its identification, must be given in the application. This could be a chemical formula, verbal description, or even a sample of the surface, and each should be attached to the application materials.

Position marks

In spite of the fact that position marks have gained popularity in Russia in recent years, especially among clothing and footwear manufacturers, the new rules have left them without attention. Nonetheless, case law study and filing practices show that applications for position marks are accepted and registrations are often successfully granted. An example for that could be Christian LOUBOUTIN's registration for its red sole shoe design, has been granted protection as a trademark as a result of consideration of the applicant's appeal against the examiner's decision of refusal based on lack in distinctiveness. The applicant successfully argued in favor of registration, based on a strong association of the red sole shoes with his name.

Conclusions

Non-traditional trademarks have boundless potential. Nowadays, the Russian legislation provides a solid base for inventive trademark owners, who would like to release their original ideas and obtain legal protection to be able to successfully enforce their rights. The new rules formalize the filing requirements and improve the applicants' abilities for obtaining protection for non-standard kinds of trademarks. The types of non-traditional trademarks listed in the recently adopted rules are not limited to those which are available for filing. The trademarks mentioned in the rules, of course, may be supplemented with new types of marks or combinations. However, the requirement that the trademark must be distinctive remains and it should be always taken into consideration while adopting a trademark. Trademark owners still need to meet the strict legislation requirements for trademark registration in terms of distinctiveness. Furthermore, due to lack of case law the possibility of effective enforcement and the ability to evidence proper use of a non-traditional trademark may be questionable. Trademark practitioners may need new approaches towards assessing similarities between non-traditional marks for successful enforcement thereof, or for determining whether a non-traditional trademark has been used properly or not. It is very likely that the new case law will appear in some time.

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Head Office:
B. Spasskaya Str., 25, bldg. 3
Moscow 129090, Russia
Tel.: +7 (495) 937 6116
Fax: +7 (495) 937 6104/6123
E-mail: pat@gorodissky.ru
www.gorodissky.com



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