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# TRADEMARK PROTECTION STRATEGIES IN RUSSIA

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## INTRODUCTION

The Russian civil code defines a trademark as a sign which serves to individualize goods and services of legal entities and entrepreneurs. In other words, a trademark is a perceptible sign which is capable of distinguishing goods and services of one undertaking from those of another. The Russian law says any designations including but not limited to verbal, device, combined, three dimensional signs can enjoy protection as trademarks. A trademark can be claimed in color, color combination or just in black & white.

Russia is the first to file country. That implies that those who first apply for registration of a trademark gain priority right to get the mark registered. For this reason, it is very essential to file trademark applications without delay even though the trademark owner does not intend to use its trademark in the Russian market right now. This is very important due to the fact that the Russian trademark legislation does not recognize prior use rights (as a general rule the exclusive right to use a trademark in our country

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arises as a result of state registration).

So what options are available for the trademark owners to get their marks protected in Russia?

Firstly, this can be done through the trademark filing system, both national and international one. In particular, a trademark owner is entitled to apply for registration of its trademark by way of filing a national TM application with the Russian Patent and Trademarks Office (Russian PTO). The second option takes note of the fact that Russia is a signatory to a number of International Treaties, especially is a member state to the Madrid system dedicated to the international registration of trademarks whereby the trademark owners can seek protection of their trademarks simultaneously in a number of designated countries, including Russia within the framework of one application.

Finally, in Russia, a trademark can enjoy protection as a well-known mark which may not necessarily be a registered designation.

National TM application is supposed to be filed with the Russian PTO (also known as Rospatent) being an administrative body empowered to examine applications, issue respective decisions upon the results of such examination and conduct some other activity.

Under the Russian law, foreign applicants are to be represented by Russian trademark attorneys duly registered at the Russian PTO. Therefore, in order for an application to be filed in the name of an entity residing outside Russia, this entity is supposed to appoint its Russian agent to represent him before the Russian PTO in all proceedings.

Whenever an application is filed, it has to be examined. The examination in Russia is composed of the formal and substantial stages. It should be noted that there is no time limit for the substantial examination in relation to national applications, although the current practice suggests that it takes the examiner about one year to complete examination.

There are some post-examination stages that a national trademark application may have to pass in order to get registered.

So, the substantial examination is followed by the examiner's decision which may be in form of a registration decision in full, registration decision for a part of the applied goods (and consequently, refusal for the rest part of goods) and refusal decision affecting all the applied goods.

The registration decision for all the applied goods makes it necessary to pay the registration fee to have the mark registered.

The situation where the mark has been partially accepted for registration suggests that the applicant has two options—either to pay the registration fee to get the mark registered for the non-objected goods or to

appeal against this decision with the higher instance division of the Russian PTO (until October 1, 2014 the appeal was to be filed with the Russian Chamber of Patent Disputes).

Finally, the final refusal, if issued, can be appealed to the higher instance division of the Russian PTO unless the applicant decides to abandon the refused application.

The decision issued by the Russian PTO as a result of consideration of the appeal is not final and can be disputed further with the IP Court.

## I. PARTICULARITIES OF EXAMINATION IN RUSSIA

In Russia only one trademark can be subject of an application. It is impossible to claim a series of marks or several variants of the same mark within one application. For each of the version of the mark, a separate application must be filed.

In Russia multiclass applications are available. It means that you can claim as many classes as you want in one application.

It is very important that unlike some other jurisdictions, there is no need in Russia to file a declaration of use or intention to use along with filing an application.

When filing an application, it is possible to claim Class heading, the list of specific goods or both class heading and specific goods. The latter is a more preferable option since it allows to obtain broader protection and seek registration for goods which are the most important to the producer.

It should be kept in mind that under the current Russian practice Class heading simply designates the fields to which the applied goods/services may relate in general and do not cover all the goods/services listed in a given Class.

So what mark to protect? It depends on what mark the applicant intends to use in the Russian market. For instance, if it is a label, then it is strongly recommended to protect the label as it is as well as the main distinctive elements of the label separately to better safeguard the applicant's interests and increase enforceability of his TM rights.

In Russia Cyrillic script is used and it is quite different from Latin characters. In this connection here arises the question as to whether it is so important to get the mark protected both in Latin and Cyr. characters.

Similarly there is yet another question: whether it is essential to protect the marks in both colors and black and white.

In order to answer these questions, it should be kept in mind that in Russia a trademark is protected in the same way it is registered.

It means that the trademark protection for the mark in Latin does not automatically extend to all other scripts. The same applies to the color of the mark.

Each time when a potential infringer uses the same mark in a different color or in a different script, you have to prove that the respective marks are confusingly similar to be able to use your trademark rights against infringer and sometimes this is a matter of dispute.

Therefore in order to make the trademark owner's position stronger, it is recommendable to get the mark registered in the same form as it is intended to be used in the Russian market and obtain additional protection for its main equivalents (for instance, for the Russian transliteration and translation and for the mark in black & white).

With respect to hieroglyphs marks, it is worth noting that these are perceived as figurative marks by an average Russian consumer and therefore the Russian examination in relation to such marks is normally conducted based on the same principles and requirements as those being attributed to figurative marks.

So what happens next after a trademark application is filed. It has to be examined. Traditionally, the examination in Russia is carried out to establish whether the claimed designation conforms to the registrability requirements. If not, it may be rejected on either absolute or relative grounds or on both absolute and relative grounds.

#### *A. Absolute Grounds*

Absolute grounds are those which take note of the substance of mark itself, its semantic meaning. These grounds basically include:

- Lack of distinctiveness
- Misleading and capability of confusing
- Confusing similarity to or identity with state symbols and marks
- Reproduction of full or abbreviated names of international or intergovernmental organizations or their symbols
- Reproduction of the official names or images of the most valuable objects of Russia's and worldwide cultural heritage.

With respect to the lack of distinctiveness, the most typical examples of designations which may be refused on these particular bases include simple combinations of letter and numeral elements which do not possess verbal character and lack specific graphic representation as well as designations which are descriptive of goods or their origin.

The marks which do not meet the registrability requirements (for instance because of their descriptive nature) are recognized as not inherently registrable. However, those marks can still be registered and granted protection provided they have acquired distinctiveness in the Russian market.

The acquired distinctiveness must be documentarily evidenced in order to be taken into consideration by the Russian authorities.

Normally, the Registry requests that the applicant should submit any documents attesting to the widespread and long-lasting use of the mark worldwide and especially in the Russian market before the priority date.

The evidence to be submitted may be composed of the following information and documents attesting to the extensive and longstanding use of the mark in the Russian market:

1. Results of an opinion poll;
2. Documents confirming supplies of goods/providing services in Russia such as supply and distributorship contracts together with the evidence of their fulfillment, shipment documents, etc.;
3. Information about volume of sales, territory of sales, amount of consumers in Russia;
4. Agreements with Russian companies/customers together with the evidence of their performance;
5. Advertising and promotional materials;
6. Other relevant evidence.

Misleading is yet another ground for refusal earlier mentioned above.

Normally, we talk about misleading when a trademark consists of a false sign. Misleading must be obvious and for this reason there should be no problem in arguing misleading. For instance a beer label which makes clear reference to the name of a particular product (beer) is likely to be rejected on the basis of misleading if applied for goods other than beer.

The capability of misleading is much more complicated, since it is based on the likelihood of the mark to be perceived in the consumer's mind as a false indication. Here all the circumstances surrounding the case are to be taken into account such as possible associations that the mark produces when viewed as a whole, whether or not consumers will believe those associations, whether the mark is famous among the respective range of consumers etc.

If the marks give birth to associations or connotations which do not look realistic when compared with the goods for which protection is sought those marks are considered to bear fanciful character and are eligible for protection.

*B. Other Grounds for Refusal*

These basically include:

- Identity or confusing similarity to the prior trademarks (both registrations and applications) owned by third parties in relation to similar goods.
- Identity or confusing similarity to well-known marks.
- Identity or confusing similarity to third parties' neighboring objects (industrial design, appellation of origin, company name, commercial designation).
- A trademark may also be refused protection if it incorporates protected means of individualization of other persons (and confusingly similar signs) as well as copyrighted objects owned by third parties, names, pseudonyms (or derivatives thereof), pictures, facsimiles of famous persons, industrial designs owned by third parties as elements of the trademark (this particular provision is not applied to applications which were filed before October 1, 2014).

Those grounds belong to the so-called category of relative grounds which basically allow to understand whether the claimed designation is in conflict with any existing third parties' rights in the same or similar sign or neighboring objects.

In most cases, we deal with refusal based on confusing similarity of the claimed designation with third parties' prior marks registered or applied for registration in relation to similar goods.

When conducting similarity checks between trademarks, the Russian PTO judges the extent to which the marks are similar by certain criteria, which basically include phonetic perception and conceptual perception as well as specifics of graphic representation.

There also exist criteria of similarity between the goods which the Russian authorities are guided by in their practice. These are type of goods, their functional designation, range of consumers, sales conditions etc.

As a general rule, all those criteria are to be taken into account in the aggregate.

If a trademark is refused on the basis of similarity to third parties' marks, such a refusal may be overcome by way of submission of a consent letter (a kind of permission to register the claimed designation) obtained from the owner of the cited mark. The Russian law does not allow to accept the consent letters in relation to identical marks. As regards similar marks, the question as to whether to accept the consent letters is left to the examiner's discretion.



Our current practice shows that the consent letters are normally not accepted if they relate to identical or nearly identical marks for which the risk of confusion is extremely high.

The consent letter has better chances 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 respective parties.

## II. NON-TRADITIONAL MARKS

In Russia non-traditional marks are entitled to protection. More specifically, these are color marks, 3D marks, position marks etc.

### A. *Colour Marks*

Although color itself is not considered to be inherently registrable as a general rule, because it lacks distinctiveness, in some case it may function as a trademark provided, it has acquired necessary distinctiveness through extensive use in the Russian market. It goes without saying that the use must be not only extensive, but quite long to enable the applicant to claim that its mark has come to be associated in the consumer's mind with a specific trader. The Russian practice suggests that it is rather a complicated task to prove that a colour mark has obtained secondary meaning because the Russian law is quite vague as to the nature and sufficient amount of evidence in support of acquired distinctiveness to be treated as a persuasive proof. That is why there is still a small number of colour marks that were successfully registered in Russia.

All those registrations became possible as a result of submitting persuasive evidence in support of acquired distinctiveness.

### B. *Positions Marks*

It is not just a sign. On the contrary, it is a sign having particular position. When filing applications for registration of position marks, it is imperative to indicate their position on the product by way of highlighting the sign on the background of the depiction of the product usually presented in dotted line. Trademark protection if granted to the position mark will not extend to the appearance of the product.

In a recent case related to seeking protection for red color of the sole of



the shoe in connection with IR No.1031242, the mark was provisionally refused protection due to lack of distinctiveness. However, the applicant managed to persuade the Russian authorities that he was not seeking to monopolize red color in relation to footwear in general, rather his intention was to protect a unique design of the sole of the shoe which became quite famous and recognizable among consumers all over the world. In support of his claims, the applicant filed evidence of notoriety of the mark. All these arguments and evidence resulted in the refusal being waived thus paving the way for the refused application to proceed to grant in Russia.

Here some questions arise. The first and the main one is how to determine the scope of protection. As applied to color marks, how wide is the range of colors which are confusingly similar to a particular one which enjoys protection. What if we talk about various colors, not just shades of one and the same color?

Besides, since color per se is not inherently registrable, it becomes vulnerable to potential attacks on part of third parties which may try to invalidate the registration of a color mark on the basis of lack of distinctiveness.

As applied to position marks, the question here is how to enforce the trademark rights if the infringer uses the same or similar sign on a product which looks quite different in a different position.

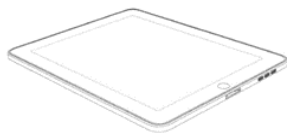
Unfortunately, it is impossible to give the exact answers to these questions right now, because the legislation is quite vague in this point and above all there is too little practice of consideration of such issues in our country.

### *C. 3D Marks*

3D mark is yet another category of non-traditional marks which are recognized by the Russian law.

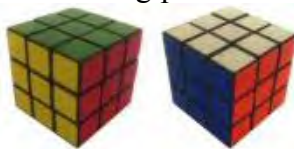
These basically include product and container shapes. The main requirement to be met is that the shape must not be functional that is to say dictated by the need to perform a particular function. In other words, the shape must not be traditional and there should exist alternative forms in the market.

In a recent case concerning an application to register the shape of the iPad tablet, the application (application



No.201075426 ) was refused protection as the applied shape was recognized quite traditional for such devices. The existence of some distinctive elements of the mark such as transition of the black side of the device from flat shape into flattened ellipse was found invisible and insufficient to influence the overall impression.

In another case related to seeking protection for mechanical puzzle toy



design (IR No.1045962 ), the application was provisionally refused protection based on the fact that it was allegedly descriptive of a particular type of toys. The applicant, however, has managed to have the refusal overturned by arguing that the proposed shape was quite unique as it featured composition solutions that were invented in 1970s and have been known since then as those associated with Rubik's cube, a very famous puzzle toy offered by a particular trader. The applicant was quite successful in demonstrating alternative shapes of mechanical puzzle toys of similar designation produced by third parties.

### III. GENERAL RECOMMENDATIONS

Bearing in mind that Russia is the first to file country, it is crucially important to get trademarks registered without delay.

Although seeking protection is an important task, it is also important to retain protection. In this connection, it should be kept in mind that in Russia use of a trademark is obligatory (a registered trademark becomes vulnerable for cancellation for non-use three years after the registration date) and its non-use may result in early termination based on non-use upon request of an interested third party. In Russia, the burden of proof lies with the trademark owner in the cancellation for non-use proceedings. The proof of use must be specific to Russia. This makes it necessary to use a trademark in accordance with use requirements and keep all the documentation related to the use of the mark (such as contracts, shipment documents, marketing authorization, promotion materials and other relevant documentation) in place to be able to produce such evidence as a proof of genuine use.

Furthermore, it is very important to keep all the recorded information about trademark owner (e.g. its name and address) updated. Therefore, if there are any changes in respect of the name or address of the trademark

owner, those changes are to be formally recorded, since otherwise such amendments may not be taken into account by the Russian authorities.

The same applies to any amendments to the trademark.

Finally, it is strongly recommendable to periodically search the registers for potential third parties' similar marks covering similar goods and taking the appropriate actions (whether in form of written observations or formal oppositions) against such marks, if necessary.

#### CONCLUSION

As the present article shows in Russia both traditional and non-traditional trademarks can enjoy protection. Although there is some specifics for certain categories of trademarks in terms of registrability and availability requirements, the main requirements for all those marks are basically the same—the marks must be distinctive and non-misleading and at the same time there must be no confusion between those marks and third parties' signs and neighboring objects.

Both obtaining and retaining trademark rights in Russia are very important elements of the trademark protection strategy which may depend on various circumstances including those related to the appropriate type of trademark protection, intended use of a trademark in the Russian market, marketing strategy and others.



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