

# Russia

Gorodissky & Partners

## Choosing the right protection

Trade dress in Russia can be protected as a trademark or an industrial design, and in many cases as both. The question of which form of protection is preferable must be considered carefully

**Neither the Russian Civil Code** nor other statutory regulations or official guidelines contain a specific definition of ‘trade dress’. In IP practice, the term is widely used to denote a product’s visual appearance – that is, its packaging and other elements used to promote a product where these are capable of signifying its origin. IP practice suggests that ‘trade dress’ should be interpreted broadly as a legal term to include the product label, the design of the product and its packaging and the interior and exterior design of points of sale.

Trade dress can be said to function as a means of individualisation and should thus enjoy protection under civil legislation.

### Trademark or industrial design?

In Russia, a product’s visual appearance or packaging, including labels, can be protected as a trademark or as an industrial design. Both forms of protection have their own peculiarities and how well the protection functions depends on whether the right form has been chosen.

Article 1352 of the Civil Code states that an ‘industrial design’ defines the outer appearance of an industrial or handicraft article. Article 1477 defines a ‘trademark’ as a sign that is used in trade to distinguish the goods and services of one undertaking from those of others. While both can fulfil similar functions, not all designations can enjoy both forms of protection.

The most common examples of designations which can benefit from trademark protection but not patent protection as industrial designs are word and device designations, which are not applied to products. Similarly, not all designations which meet the requirements of an industrial design can obtain trademark protection. For instance, the Civil Code expressly prohibits the registration of trademarks which are realistic representations of products – such

designations can be protected as industrial designs only.

According to Russian practice, the most typical examples of trade dress objects which can enjoy protection as trademarks include trade dress product labels, trade dress product shapes and trade dress product containers – all traditional means of individualisation. However, recent practice shows a trend in rights holders registering non-traditional trademarks in order to protect trade dress, with some notable successes.

Russia’s largest bank, Sberbank, obtained protection for its trade dress by registering a shade of green (Russian Registration 556088) covering banking services in Class 36. Another example is All Saints Retail Limited, United Kingdom, which succeeded in protecting the interior design of its shops by registering a representation of sewing machine strings placed in the shop window (Russian Registration 447940) covering retail services.

The first case is unique, as under existing Russian IP practice, single colour marks are not considered inherently distinctive; the only way for them to be registered is to prove that the mark has acquired the necessary distinctiveness through wide and extensive use on the Russian market before the priority date.

According to publicly available official sources, the second case met with no official objections during examination and successfully proceeded to registration. This suggests that such designations can, in principle, enjoy protection under Russian law.

Another interesting case in which the outer appearance of a part of an article was successfully protected as a non-traditional trademark involves the registration of a position trademark International Registration 1031242 in the name of Christian LOUBOUTIN for ladies’ footwear in Class 25.

The mark – which is based on the red colour of the sole of the shoe – was

provisionally refused protection due to lack of distinctiveness. However, the applicant managed to persuade the Russian authorities that he was not seeking to monopolise the colour red in relation to footwear in general – rather, his intention was to protect the unique design of the shoe’s sole, which had become quite famous and was readily recognisable by consumers all over the world.

The most typical trade dress objects eligible for trademark and industrial design protection simultaneously are shapes of products and their containers. It is a common requirement for both rights that the shape be non-functional.

The two IP objects are compared below in order to outline their common and distinct particularities.

### Differences and similarities

#### Applicants

Within the trademark system, only two categories of entity are entitled to own trademarks: legal entities or natural persons engaged in business activities. This is in contrast to the industrial design system, whereby the range of possible applicants includes authors, employers and assignees of an author or employer.

#### Number of designations

The patent system provides for an unlimited number of designations in an application; in contrast, the trademark system states that only one designation can be the subject of an application.

#### Novelty criterion

Novelty for trademarks is established by comparing them to third parties’ prior marks registered or applied for in Russia, as well as to prior neighbouring objects which enjoy protection in Russia (eg, trade names, designs or commercial designations). This requirement conforms



to the local novelty criterion.

With respect to industrial designs, in order to establish the degree of novelty, the Patent and Trademark Office conducts a search of available information before the priority date – conforming to the worldwide novelty criterion.

### Scope of legal protection

The scope of protection for trademarks is defined by Article 1484 of the Civil Code, which provides that trademark protection extends not only to the sign and the list of goods identified on the trademark registration certificate, but also to similar signs and goods.

The most problematic issue is establishing the extent to which marks and goods are similar. Although Russian trademark legislation provides for certain criteria of similarity, all of these suggest a subjective approach towards similarity, which can result in contradictory decisions, especially given that there is no common law in Russia.

The Russian trademark system establishes a specific regime for well-known marks. In particular, protection granted to such marks extends to dissimilar goods, provided that the use by a third party of its identical or similar mark is capable of misleading consumers.

The scope of industrial design protection is defined by a combination of essential features. A design is considered to have been used if the allegedly infringing article reproduces all its essential features or a combination of these to create the same overall impression on an informed consumer as that created by the original design.

### Non-use

Under Russian law, a trademark becomes vulnerable to cancellation for non-use three years after registration. The mark is considered to have been used if it has been used by the rights holder itself, its licensee or any other entity under the rights holder's control. Thus, use of a trademark is mandatory and non-use may result in early termination.

The legal protection conferred by an industrial design registration cannot be terminated early on grounds of non-use. However, if an industrial design is not used or is used insufficiently by the



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patent owner for four years from the date of grant, any party which has been refused a licence to the design may file suit seeking a compulsory simple (non-exclusive) licence.

### Duration of legal protection

Pursuant to Russian civil legislation, a trademark registration remains valid for 10 years from the filing date; protection may be renewed for an unlimited number of 10-year periods subject to payment of the renewal fees. Industrial designs are valid for five years from the filing date and may be renewed four times (ie, up to 25 years in total). The holder of an industrial design must also pay annuities to maintain the patent.

### Prior use rights

As far as trademarks are concerned, Russian law establishes no prior use rights. Trademark rights usually arise as a result of registration, although well-known marks may enjoy protection without first being registered. In contrast, the industrial design system allows any natural or legal person which has used a particular solution in good faith in Russia before the priority date of a third party's application to register an identical industrial design to proceed with such use free of charge, provided that the scope of such use is not extended.

### Assigning rights

Full or partial assignment of rights is possible in the case of trademarks. The main

requirement is that the assignment not lead to confusion in the minds of the public. For instance, a partial assignment is not allowed if the remaining goods are similar to those to be covered by the assignee's mark.

Unlike the trademark system, the industrial design system does not allow for the partial assignment of rights.

### Authors' rights

Authors' rights are personal non-property rights, which are closely linked to an individual and cannot be assigned. Therefore, unlike the rights to an industrial design – which can be transferred to another person or entity – authors' rights remain unchanged as long as the industrial design remains valid.

The Russian trademark system does not recognise authors' rights.

### Conclusion

Trade dress can benefit from different forms of protection, each with its own advantages and shortcomings. The question of which one is preferable must be considered individually and depends on the specific circumstances of each case. The same object (eg, a label or product shape) can enjoy protection both as a trademark and an industrial design simultaneously, which may result in a collision of trademark and design rights over the same object. Such clashes can be avoided if the appropriate and adequate form of protection of the object is chosen, taking note of its nature and the specifics of the situation. **WTR**