

Additional comments on document SCT/22/3 concerning “Technical and procedural aspects relating to the registration of certification and collective marks”

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Rospatent submitted information on the legislation in force in the Russian Federation, which provides legal protection for collective marks, and the information was taken into account by the Secretariat in preparing document SCT/22/3. Discussion of that document took place at the Twenty-Second Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (hereinafter the Standing Committee).

When submitting the information, Rospatent based itself on the specific features of collective marks, intended for goods with unified characteristics of their quality or other general features. On that basis, Russian legislation excludes the possibility of disposing of a right in a collective mark, both in the form of alienation (assignment) and of the granting of a license for its use.

In the opinion of the Russian Delegation, it is forbidden to dispose of a right in a collective mark, owing to the fact that this may have negative consequences, i.e. mislead consumers regarding a good and its manufacturer.

On that basis, it is extremely important for paragraphs 54 and 55 of the document, which will be revised and presented at the Twenty-Third Session of the Standing Committee, to reflect the detailed comments of the Secretariat and the opinions of States on the matter in question.

Another issue, on which comments may have practical significance, relates to the conversion of a trademark application into a collective mark application and vice versa, and also of a trademark into a collective mark and vice versa.

The possibility of the above conversions is provided for by Russian legislation, but this is in no way reflected in document SCT/22/3.

Since, in case of approval of the prepared document at the Twenty-Third Session of the Standing Committee, the document will be published in the form of

reference material on technical and procedural aspects relating to certification and collective marks, the comments on this matter should be included in the above reference material.

As regards the practice of the Russian Office, according to special rules based on legislation, a trademark application may be converted into a collective mark application where a request for such a conversion is submitted, prior to a decision being taken on the converted application and signed by the trademark applicant. The following should be attached to such a request: the rules of the collective mark and a new claim, signed by the head of the association authorized to register the collective mark in his name (rights owner), and satisfying the requirements of rules.

The applicant for the converted application may be included in the list of people having the right to use the collective mark.

Based on legislation and the corresponding rules, a collective mark application may be converted into a trademark application on the basis of a request for such a conversion, submitted prior to a decision being taken on a converted application and signed by the head of the association - collective mark applicant. Consent to convert the application shall be attached to the request by the persons who have the right to use the collective mark, together with a new claim signed by the person authorized to register the trademark in his name, and satisfying the requirements of rules.

The new claim should indicate as the applicant a person who works for the association – the applicant for the converted application and having the right to use the collective mark.

The Office informs the applicant of the results of the examination of the request and, if the request is formulated in accordance with the established requirements, the applicant is informed of the completed conversion, and the priority and application filing date are preserved.

The procedure for converting a trademark into a collective mark or a collective mark into a trademark is also provided for by the corresponding rules.

In accordance with these rules, the rules of the collective mark are attached to the request for conversion of a trademark into a collective mark. The owner of the rights in the converted trademark may be included in a list of the people who have the right to use the collective mark.

Consent for conversion of a mark is attached to the request for conversion of a collective mark into a trademark, by the persons who have the right to use the collective mark. A person who works for the association of the owner of the rights in the collective mark and who has the right to use this mark shall be indicated as the owner of the rights in the trademark.

Information on a completed conversion is entered in the State Register of Trademarks and Service Marks of the Russian Federation, and is published in the Rospatent Official Gazette.

The Annex contains examples from the practice of the Russian Office, which illustrate the provisions commented on.