Correspondence of Marks for the Certification purposes:
Russian practice and approaches as to Rule 9 (d)(iv) of the Common Regulations

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PLAN

- Legal basis

- **Identity**: Rospatent approaches (in particular, as to marks in different scripts)

- **Basic marks**: possible applicant’s strategies (marks in different scripts)
Legal basis

- Rule 9 (d)(iv) of the Common Regulations
- Rospatent internal bylaws and regulations
Rule 9 (d)(iv) of the Common Regulations

Rospatent is to certify that:

the mark being claimed in the international application is the same as in the basic application/registration.
Identity: Rospatent approaches

- Strict approach:

  “the same” = “identical”

- It is aimed at ensuring the consistency of the practice and approaches of the Office in the international and national levels.
Identity: Rospatent approaches

Marks are considered **identical** ("the same") to each other if all the elements thereof are on all fours.

**Identity:** phonetic similarity, graphical (visual) similarity, semantic similarity
Identity: Rospatent approaches

Criteria for determining the identity of the marks:

✓ general visual impression
✓ type of the script
✓ typographic treatment (e.g. capital or small letters, block or script letters)
✓ lay-out of the letters
✓ alphabet
✓ colours and combination thereof
Identity: Rospatent approaches

To compare:

- The marks are considered similar if they are associated with each other in general, despite of certain differences.

- Similarity is not acceptable.
Identity: Rospatent approaches

NOT ACCEPTABLE

- Different alphabets:
  АЛЬФА vs. ALFA

- Different scripts:
  ЦИТОВИР vs. ЦИТОВИР
Identity: Rospatent approaches

NOT ACCEPTABLE:

➤ Translation:

Черная карта vs. CARTE NOIRE

Черный квадрат vs. Black square
Identity: Rospatent approaches

NOT ACCEPTABLE:

- Colour and layout of the elements:

![Logo 1](image1)

vs.

![Logo 2](image2)
Basic Marks:
Possible Strategies for an Applicant

In case of a national mark in Cyrillic, on the international level applicant may:

- claim for the protection of the identical Cyrillic mark (transliteration is required);

- apply for the variant thereof in Latin on the national level, but there is a risk of the pre-term termination as the result of the nonuse (CC, Art. 1486).
Basic Marks:
Possible Strategies for an Applicant

Consequences of Nonuse of a Trademark

TM may be early terminated as the result of the nonuse continuously within any three years after its official registration.

A request for the pre-term termination may be filed:

✓ by any interested person;
✓ upon the expiration of the aforesaid three years;
✓ provided that the trademark has not been used before such request was filed.
Basic Marks:
Possible Strategies for an Applicant

**TEFLON** and **ТЕФЛОН**

- Variants of trademarks owned by one holder
- The use of a trademark in Latin script was sufficient to prove the use the variant in Cyrillic script.
Basic Marks:
Possible Strategies for an Applicant

- Alternatively, the combination of Cyrillic & Latin signs could be filed as a trademark:

  MARUSYA
  MARUSJA
  MAROSSIA
  МАРУСЯ

  Magistr
  Магистр
Basic Marks:
Possible Strategies for an Applicant

NOT ACCEPTABLE:

MAPKYC  vs.  MARKUS
Thank you for your attention!

In case of any questions:

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