

Technical and procedural aspects relating to the registration of collective and certification marks

Legal protection for collective marks was introduced in the Russian Federation in 1992 by the Law on Trademarks, Service Marks and Appellations of Origin. As of January 1, 2008, new legislation operates in Russia regulating the legal relations in the field of trademarks – Part IV of the Civil Code of the Russian Federation (hereinafter – Code), which contains Article 1510 and 1511 relating to the legal institution in question. 12 collective marks are currently registered in the country.

In accordance with Article 1510(1) of the Code, a subject of law for a collective mark in the Russian Federation may be an association of people, the creation and activities of which do not contravene the legislation of the State in which it was set up.

Based on the aforementioned Article, a collective mark is a trademark intended to designate goods produced or sold by the persons forming part of said association and possessing single characteristics of their quality or other common characteristics.

The definition of a collective mark is as close as possible to Article *7bis* of the Paris Convention for the Protection of Industrial Property.

In its law enforcement practice, the Office acts on the basis that the possession of a collective mark presupposes the obligation for several persons, that are members of a group, to achieve single characteristics of the quality of the goods produced, their competitiveness and responsibility when enforcing the conditions for use of a mark. The fulfillment of these conditions is necessary, since a deterioration in the quality of a good caused by one of the members of the association may have a negative effect on the reputation of the whole group. The achievement of a single level of quality of goods may be ensured by creating a single raw material base, applying unified production technologies, establishing verification of compliance of the quality of a good and its marking as a collective mark.

The particular feature of a collective mark is manifested in that, in accordance with Article 1510(2) of the Code, the right in a collective mark may not be alienated and may not be the subject of a licensing agreement.

An association which owns a collective mark may not use it. As regards the members of an association, based on Article 1510(3) of the Code, they shall have the right to use not only the collective mark, but also at the same time to make use of their own trademark.

When examining applications for the registration of collective marks in terms of their protectability, the same requirements are manifested as for any trademarks. This means that when registering a collective mark a claimed designation is verified in terms of its compliance with Article 1483 of the Code, which establishes grounds for the refusal of trademark registration.

In accordance with Article 1511(1) of the Code, the regulations for a collective mark shall be attached to an application for registration of the collective mark (contrary to a trademark application). The regulations for a collective mark shall contain the following information:

- the name of the association authorized to register the collective mark in its name;
- a list of the people that have the right to use this collective mark;
- the purpose of registering the collective mark;
- a list and the single characteristics of the quality or other general characteristics of goods which will be designated by the collective mark;
- conditions for use of a collective mark;
- regulations on the procedure for verifying use of a collective mark;
- regulations concerning liability for infringement of collective mark regulations.

Articles 1510 and 1511 of the Code do not answer the question as to whether members of the association using a collective mark should produce one and the same type of products or work on a final single form of the products by producing its components. It is envisaged that the regulations shall contain a specific list of the requisite characteristics, as most users are deprived of the possibility of acquainting themselves with the regulatory technical documents, to which reference may be made in the regulations. In this regard however, the description should preferably include a list of the basic characteristics of quality or other common characteristics of a good, without duplicating the contents of the regulations.

Article 1511(2) of the Code contains a list of information entered in the State Register of Trademarks and a collective mark certificate. The particular feature of the legal institution in question provides an obligation to include information on the persons that have the right to use a collective mark. This information, together with an extract from the collective mark regulations concerning single characteristics of quality and other common characteristics of goods, in relation to which this mark is registered, shall be published by the patent office in its official gazette.

A rightsowner shall inform the office of changes to the collective mark regulations.

As established by Article 1511(3) of the Code, legal protection for a collective mark may be terminated prematurely in full or in part on the basis of a court decision taken at the request of any interested person, in the case of use of the collective mark on goods which do not possess single characteristics of their quality or other common characteristics. The taking of a decision on the above-mentioned grounds is referred to the courts, as a result of the fact that in this situation it is a matter not of the protectability of a designation (in this case the general procedure for both trademarks and collective marks applies), but rather the fulfillment of the requirements of the collective mark regulations in the process of its use in civilian life.

Article 1511(4) of the Code envisages the possibility of converting a collective mark and a collective mark application accordingly into a trademark and a trademark application, and vice-versa. The acts in question are performed on the basis of special rules.

As regards certification marks, the Civil Code of the Russian Federation does not include such marks as part of intellectual property subject matter. On this basis, the performance of work connected with such subject matter is not an obligation of the Patent Office, but lies within the competence of another executive authority.