

## GROUNDINGS FOR REFUSAL OF TRADEMARK REGISTRATON

As of January 1, 2008, Part IV of the Civil Code of the Russian Federation (hereinafter – the Code) was introduced in Russia. Chapter 76 of Part IV of the Code includes paragraph 2 “Right in a trademark”, which contains Article 1483 establishing the grounds for refusal of State registration of a trademark.

These grounds may be divided into absolute (paras 1-5) and relative (paras 6-9).

In accordance with Article 1483(1) of the Code, State registration of designations not possessing distinguishing capacity as trademarks shall not be permitted.

Based on the corresponding rules and established practice in the field of trademarks, the following designations may in particular be included among those not possessing distinguishing capacity:

- those representing individual letters, figures which do not have a normal graphic form, combinations of letters of a non-verbal nature; lines, simple geometric figures, and also combinations thereof, not forming compositions providing a different level of perception in qualitative terms, separate from the perception of their individual elements;
- realistic or diagrammatic images of goods claimed for registration as trademarks for the designation of these goods;
- three-dimensional objects, the form of which is determined exclusively by their functional purpose;
- generally adopted names representing, as a rule, simple indications of goods claimed for designation of these goods: generally adopted abbreviated names of organizations, companies, sectors, and abbreviations thereof.

At the same time, Article 1483(1) of the Code establishes a prohibition on registering as trademarks designations consisting only of the following elements:

(1) those which have entered general use to designate goods of a particular type. Such designations include designations used for specific goods which, as a result of their long-term use for one and the same goods or good of the same type by different manufacturers, have become indications of a specific type of good (for example, “roofing material”, “thermos”, “cellophane”, “nylon” etc.);

(2) generally adopted symbols and terms.

Generally adopted symbols include, as a rule, designations symbolizing the sector of the economy or area of activity in which are included goods contained in a list of goods for which trademark registration is requested; fixed designations used in science and technology, lexical units, characteristic of specific fields of science and technology;

(3) Those characterizing goods, including those indicating their type, quality, quantity, feature, purpose, value, and also the time, place and method of production or sale.

Such designations include in particular simple names of goods (bread, beer, paper etc.); designations of the category of quality of goods; indications of features of goods (including those of a laudatory nature), material or composition of raw materials, weight, volume, price of goods, date of production of goods, data on the history of creation of products, names of companies by type, addresses of manufacturers of goods and intermediate firms, designations consisting partially or wholly of geographical names, which may be perceived as indications of the place of business of the manufacturer of a good;

- constituting a generally adopted form of goods, which is determined (functionally defined) exclusively or mainly by a feature or purpose of a good, or by its type.

In this regard, the possibility of refusal of trademark registration for the designations examined is based on Article 6*quinquies* B(2) of the Paris Convention for the Protection of Industrial Property (hereinafter – the Paris Convention), bearing in mind that such designations are deprived of any distinguishing features or consisting exclusively of signs or indications which may serve in trade to designate a type, quality, quantity, purpose, cost, or place of origin of products or time of their manufacture, or which have become generally adopted in common language or in the competition and established trade customs of the country where protection is requested.

Despite the established prohibition on the registration of the elements examined above, the Code provides that they may be included in a trademark as non-protectable elements, if they do not occupy a dominant position therein.

When defining whether a non-protectable element occupies a dominant position in a designation, its semantic and/or spatial meaning is taken into account.

If an element occupies a dominant position, it is concluded that the State registration of a claimed designation as a trademark is not possible.

The legislation in force in the field of trademarks provides for an exception to the general approach outlined above. It is not applied in relation to designations which have acquired distinguishing capacity (secondary meaning) as a result of long use. Such an exception relates to the provision of the aforementioned Article 6*quinquies* C-(1) of the Paris Convention, which establishes the following:

“in determining whether a mark is eligible for protection, all the factual circumstances must be taken into consideration, particularly the length of time a mark has been in use”.

For example, literal combinations such as “TDK” (for cassettes), “BMW” (for cars) and “BP” (for petrol) may be included in the named designations.

The proof of a designation acquiring distinguishing capacity shall be presented by the applicant. Such proof may, in particular, include information on the length and intensity of use of the designation, the scale of a territory on which a good is sold and the well-known nature of a designation.

Article 1483(2) of the Code establishes a prohibition on the registration as trademarks of the designations provided for by Article 6<sup>ter</sup> of the Paris Convention. On that basis, registration as trademarks is not permitted for designations identical or similar to State symbols (coats of arms, flags, and emblems of States), as in the opposite case such registration would infringe the rights of the State in distinguishing signs of its sovereignty.

As regards the Russian Federation, in 2000 the following Federal constitutional Laws came into force:

“on the State Anthem of the Russian Federation”, “on the State Coat of Arms of the Russian Federation” and “on the State Flag of the Russian Federation”, which contain special provisions regulating the question of use of the State symbols of Russia.

The existence of a provision contained in the above-mentioned Article 1483(2) is also aimed at preventing registration and use as trademarks not only of State symbols, but also of the names and symbols of international and intergovernmental organizations.

The exclusion to the above rule may include situations where designations such as the United Nations, WHO, UNESCO, WIPO, images of the Red Cross and Red Crescent, Red Lion and Red Sun etc. are included in a trademark as non-protectable elements as a result of the consent thereto of the corresponding competent authority.

For example, in the case of inclusion, in a designation claimed for registration, of the Olympic symbol representing five interwoven rings in a single color or multicolored form, the Olympic flag and Olympic slogan (“faster, higher, stronger”), such consent must be obtained from the International Olympic Committee (IOC).

As with most legislative systems in the world, Russian legislation does not permit the State registration as trademarks of designations representing or containing elements which are false or liable to confuse a user regarding a good or its manufacturer (Article 1483(3)(1) of the Code).

Such designations include, in particular, designations generating in the consciousness of a user a perception of a particular quality of a good, its manufacturer or place of origin, which does not correspond to reality.

The designation is recognized as false or confusing, if at least one of its features is false or liable to confuse.

In practice, the inclusion of designations in the “false” category does not give rise to difficulties. Among the most widespread, one may mention cases where the name of a geographical subject, which does not correspond to the applicant’s place of business, is included in a mark. For example, the image of Saint Basil’s Cathedral in Moscow is used, while the applicant is in Saint Petersburg; the mark contains the collocation “washing powder”, while the designation is declared for the whole list of goods in class 3 of the International Classification of Goods and Services (ICGS); and the collocation “natural silk”, contained in a designation, is declared for registration in relation to goods made of synthetics.

Article 1483(3)(2) of the Code prohibits the registration as trademarks of designations contravening the public interest, principles of humanity and morality.

As a rule, this includes designations representing or including words, expressions (slogans), pictures, three-dimensional and other designations or combinations thereof, which, both in themselves and where they are used as trademarks, contravene legislation relating to the public order, and/or may cause indignation among members of society on the basis of generally adopted moral standards. For example, anti-State slogans, unethically acceptable national and/or State symbols (coats of arms, flags, signs), historical and cultural monuments, representing the property of nations; family names, first names, pseudonyms and derivatives thereof, portraits and facsimiles of famous people (based on a list of goods for the marking of which they are intended), designations of an inhuman nature, offending human dignity, religious feelings, including words and pictures of an indecent nature; and words, the writing of which infringes the rules of Russian orthography.

A provision, permitting refusal of registration as the aforementioned designations, corresponds to Article 6-*quinquies* of the Paris Convention.

Despite the existence in legislation of rules aimed at not permitting the registration of designations contravening public interests, Article 1483 of the Code includes a special provision establishing additional obstacles to such registration. These obstacles are defined in paragraph 4 of that Article and relate to designations, identical or similar to the point of confusion to official names and pictures of particularly valuable objects of the cultural heritage of the peoples of the Russian Federation, or objects of the world cultural or natural heritage, and also to pictures of cultural values, preserved in collections, compilations and funds, if registration is requested on behalf of persons who are not their owners, without the consent of the owners or of persons representing the owners, to the registration of such designations as trademarks.

Article 1483(5) of the Code includes a provision which satisfies the requirement of Article 23 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). It contains an essential requirement to prohibit registration, without expert evaluation, of geographical indications to accompany wines and spirits, if the names of goods do not originate from (are not produced on) the territory of the corresponding geographical subject. This standard is contained in the Code as follows: “In accordance with an international agreement to which the Russian Federation is party, State registration as trademarks shall not be permitted for designations representing or containing elements which are protected in one of the States parties to this international agreement as designations, allowing wines or spirits to be identified as originating from its territory (produced within the borders of the geographical subject of this State) and having a particular quality, reputation or other characteristics which are defined mainly by their origin, if the trademark is intended to designate wines or spirits which do not originate from the territory of the given geographical subject”.

The requirement for a prohibition on registration as trademarks of designations which may infringe the rights of third parties in industrial property subject matter, copyright, or a personal non-proprietary right, provided for by Article 6-*quinquies* (B)(1) of the Paris Convention, is implemented through Article 1483(6) and (7) of the Code, which contain relative grounds for the refusal of trademark registration.

In this regard, such grounds may be divided into two groups: firstly – designations for which an examination is conducted, and second – designations in relation to which an examination is not conducted, but the fact that they are registered may constitute grounds for

challenging and recognizing as invalid the grant of legal protection for a trademark, as per Article 1512 of the Code.

In the process of implementing Article 1483(6) of the Code, designations are taken into account, identical or similar to the point of confusion to trademarks of other persons in relation to goods of the same type, for which registration is claimed and which have an earlier priority (if an application for State registration of a trademark is not withdrawn or is not recognized as withdrawn), trademarks of other persons, protectable in the Russian Federation, including in accordance with an international agreement to which the Russian Federation is party (Madrid Agreement and the Protocol Relating thereto) and which have an earlier priority, and also with trademarks recognized, in accordance with the procedure established by the Code, as well-known in the Russian Federation.

Registration as a trademark for goods of the same type of a designation similar to the point of confusion to any of the trademarks indicated in this paragraph is allowed only with the consent of the rightsowner.

A designation is considered identical to another designation, if it coincides with it in relation to all elements.

If, in comparison with another designation, a designation has individual features, but on the whole is associated with it, it is considered similar to the point of confusion to that designation.

Identity or similarity based on legislation shall be determined taking into account the similar nature of goods.

In line with global practice, the Code allows the possibility for the applicant to grant so-called “written consent”, i.e. “authorizations” from a patent owner for prevailing rights in the registration of the designations mentioned above. However, a claimed designation and a trademark must not be identical. The corresponding rule is contained in the last paragraph of Article 1483(6) of the Code.

Article 1483(7) of the Code establishes a prohibition on registration for any goods, of a trademark where a claimed designation is identical or similar to the point of confusion to an appellation of origin, and the applicant does not possess the exclusive right to use this name.

In addition, if an applicant has such a right, registration of a trademark may be made in relation to the same goods, for the individualization of which an appellation of origin is registered, but in that connection the name will be included in the trademark as a non-protectable element.

A second group of relative grounds for the refusal of trademark registration is listed in Article 1483(8) and (9). It defines designations which may not be registered, as the Code refers to them as means of individualization belonging to third parties.

In connection with the rule established in paragraph 8, a prohibition on registration is established in relation to goods of the same type for designations, identical or similar to the point of confusion to a trade name or commercial designation (or individual elements of such a name or designation), protectable in the Russian Federation, or to the name of a selection

achievement entered in the State Register of Protectable Selection Achievements, the rights to which have arisen in the Russian Federation for other persons earlier than the date of priority of a registered trademark.

The provisions contained in Article 1483(9) of the Code are aimed at not permitting the registration as trademarks of designations which are known in the Russian Federation as the subjects of rights of third parties, in particular as subjects of copyright and a personal non-proprietary right.

Reference is made to the names of works of science, literature or art, characters or quotations from such works, works of art or fragments thereof, well known in the Russian Federation at the date of filing of an application for State registration of a trademark, without the rightsowner's consent, if the rights in the corresponding work have arisen earlier than the date of priority of registered trademarks.

The specifications contained in the aforementioned rule relate also to first names, pseudonyms or designations derived therefrom, portraits or facsimiles of persons well known in the Russian Federation at the application filing date, without the consent of these persons or of their heirs.

Based on Article 1483(9)(3) of the Code, an obstacle to the registration of a trademark may be the possession by another person of the rights in an identical industrial design, sign of correspondence or domain name, the rights in which have arisen earlier than the date of priority of the trademark.

In connection with industrial designs, firstly possible clashes are borne in mind in the case of registration of three-dimensional designations (three-dimensional objects) and labels, which may be the subject of protection as both a trademark and as an industrial design.

In accordance with Article 1483(10) of the Code, the grounds examined above for refusal are applied when dealing with the possibility of granting legal protection for trademarks, in accordance with international agreements to which the Russian Federation is a party.

Examples of designations, in relation to which the grounds contained in the provisions of Article 1483 of the Code are applied, are given in Appendix III.

**Examples**

<p><b>PTT</b></p>	<p>Application No.2007740239</p>	<p>Designations which do not have distinguishing capacity, as they constitute individual letters and figures which do not have a typical graphic representation; a combination of letters of a non-verbal nature.</p>
<p><b>A321</b></p>	<p>Application No.2006730254</p>	

	<p>Application No.2007739340</p>	<p>A designation which does not have distinguishing capacity, as it constitutes a simple geometrical figure.</p>
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	<p>Application No. 2007713446</p>	<p>Designations which do not have distinguishing capacity, as they constitute a realistic image of a good for which registration is claimed as a trademark to designate this good.</p>
	<p>Application No. 2007716841</p>	
	<p>Application No. 2006723294</p>	

	<p>Application No.2006725889</p>	<p>A designation which does not have distinguishing capacity, as it constitutes a three-dimensional object, the shape of which is determined exclusively by its functional purpose.</p>
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<p><b>НПО ДЕОСТ</b></p>	<p>Certificate No. 355739</p>	
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	<p>Certificate No. 359741</p>	<p>Designations “NPO”, “OOO”, “FARM”, which do not possess distinguishing capacity, as they constitute generally accepted abbreviations and acronyms.</p>
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	<p>Certificate No. 186843</p>	<p>Designation “nylon”, which has entered general use to designate goods of a specific type.</p>
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	<p>Application No. 2007734206</p>	<p>% - generally accepted symbol</p>
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	<p>Certificate No. 248196</p>	<p>“ampere” – generally accepted term</p>
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	<p>Certificate No. 240278</p>	<p><i>Designations consisting of elements characterizing goods, including those indicating their type, quality, quantity, property, purpose, value, and also the time, place and method of their production or sale.</i></p>
	<p>Application No.2005706267</p>	

	<p>Certificate No. 289204</p>	
	<p>Certificate No. 264760</p>	<p>Inclusion in a trademark of State symbols: i.e., the State coat of arms of the Russian Federation as a non-protectable element with the consent of the corresponding competent authority</p>

	<p>Application No.2007726371</p>	<p>Inclusion in a trademark of State symbols: i.e., the State flag of Switzerland as a non-protectable element, possible with the consent of the corresponding competent authority.</p>
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	<p>Application No.2006715821</p>	<p>The claimed designation includes a graphic element, coinciding with the official emblem of the International Federation of Red Cross Societies. Registration as a trademark is impossible without the consent of the International Federation of Red Cross Societies.</p>
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	<p>Certificate No.190885</p>	<p>Depiction of the heraldic sign – emblems of the Armed Forces of the Russian Federation are a non-protectable element of a designation.</p>
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	<p>Application No.2007724341</p>	<p>The verbal element “coffee”, included in the claimed designation, indicating a specific type of good, is false in relation to part of the claimed goods, such as “tea, rice, yeast, salt, mustard; pepper, vinegar”.</p>
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<p>edelweiss </p>	<p>Application No.2007726371</p>	<p>Registration as a trademark for a Russian applicant of a designation including the State flag of Switzerland, able to mislead a user regarding the manufacturer of goods or the person providing services.</p>
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	Application No.2007736440	Contravention of public interests, principles of humanity and morality – registration of a designation with a verbal element “Vinukorennaya manufaktura” in relation to the services of a “crèche”.
БИЗНЕС ЗАВТРАК	Application No.2007739971	Contravention of public interests, principles of humanity and morality – registration of a designation with the verbal element “breakfast” in relation to goods of “poisons”.
	Application No.200712227	Designation similar to the point of confusion to the subject “Kizhskiy Pagost”, included in a list of Russian cultural and natural objects included in the UNESCO world heritage list.
ДАР БАЙКАЛА	Application No.2007713547	Designation similar to the point of confusion to the subject “Lake Baykal”, included in the list of Russian cultural and natural objects, included in the UNESCO world heritage list.
ORWELL	Application No.2008701813	Similar designations: «ORWIL» - certificate No.274453 «ORWELL» - international registration No.702783.
VAZ	Application No.2007738233	Similar designations: “AVTOVAZ” – well-known mark No. 45 “AVTOVAZ” – certificate 182030

	Application No.2007714350	Designation similar to the appellation of origin "Vologodskoye Kruzhevo".
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