



МИНИСТЕРСТВО
ЭКОНОМИЧЕСКОГО РАЗВИТИЯ
РОССИЙСКОЙ ФЕДЕРАЦИИ
ФЕДЕРАЛЬНАЯ СЛУЖБА
ПО ИНТЕЛЛЕКТУАЛЬНОЙ
СОБСТВЕННОСТИ
(РОСПАТЕНТ)

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На № _____ от _____

World Intellectual
Property Organization
Geneva,
E-mail: sect.forum@wipo.int

Dear Sirs,

Please, find attached the reply to Circular letter C.8664 with comments and practical examples of the Federal Service for Intellectual Property (Rospatent) regarding areas of convergences (document SCT/37/8, paragraph 14).

Yours sincerely,

Director of
International Cooperation
Department

Pavel Spitsyn

Encl.

It should be noted that there is significant convergence of approaches of the Russian Federation to approaches reflected in doc. SCT/35/4 (№ 1, 2, 5 and 6).

Area of convergence № 1 - there is convergence in the term definition “country name” reflected in par. 5-7 of doc. SCT/35/4. In the Russian Federation so that to provide legal protection to a trademark that contains a country name the term “country name” should contain generally accepted or short name of the state used in the official diplomatic context; translation and transliteration of the name as well as use of the name in abbreviated form and as an adjective.

Area of convergence № 2 – Refusal to register if the trademark is considered to be descriptive there is convergence with regard to assessment of descriptive character of the trademark that contains a country name. Due to doc. SCT/35/4 in those countries where there is no express prohibition on trademarks registration that consist of a country name or contain such names, the registration of country names as trademarks is not allowed in case such trademarks do not have distinctive character (that is descriptive). A trademark or element of a trademark is considered to be descriptive if it only informs about the objective characteristics of goods and services for which the trademark is used.

Similar requirement of the distinctive character of the trademark as a requirement of its registration as well as the criteria of assessment of descriptive character of the trademark or included elements in it foreseen by § 1 of Article 1483 of the Civil Code of the Russian Federation.

It should be noted that granting of legal protection to trademarks that consist or include a country name falls under general requirements foreseen by Article 1483 of the Civil Code. A country name can be included in a trademark as an unprotected element that does not dominate in the trademark. Since 2014 a new provision came into effect with regard to § 1.1. of Article 1483 of the Civil Code of the Russian Federation that abridges disclamation, in particular a country name, in case if the applied for registration sign acquired the distinctive character as a result of its use or a country name in the aggregate with other elements that do not have distinctive character forms a combination as part of the applied sign that has distinctive character.

Area of convergence № 5 – Invalidation and Opposition Procedures

In doc. SCT/35/4 it is stated that a trademark that consists of or contains a country name after invalidation of exclusive right should be considered as if it had never been registered before. And in doc. SCT/35/4 two situations of invalidation of legal protection applied in different countries are considered. Due to Article 1513 of the Civil Code of the Russian Federation legal protection of a trademark is recognized to be invalidated completely, in particular, if the legal protection was provided with failure to comply with the requirements of § 1 and 3 of Article 1483 of the Civil Code of the Russian Federation and it results in invalidation of the certificate and record in the National trademark registry.

Due to Article 1491 of the Civil Code of the Russian Federation in case of legal protection of a trademark is recognized to be invalidated completely the trademark is considered as if it had never been registered before.

So consequences of invalidation of the trademark registration foreseen by the Civil Code of the Russian Federation are similar to consequences of most countries (§ 27-29 of doc. SCT/35/4).

Area of convergence № 6 – Use as a trademark

In doc. SCT/35/4 it is said that appropriate legal means should be made available for interested parties to prevent the use of country names if such use is likely to deceive the public, for instance as to the nature, quality or geographical origin of the goods or services and to request the seizure of goods bearing false indications as to their source.

It should be noted that § 3 of Article 1483 of the Civil Code of the Russian Federation provides for express prohibition on trademarks registration that include or contain the elements that are false or capable of misleading a consumer in respect of goods or their producer. Signs that contain country names fall under the prohibition as well.

Failure to comply with this requirement results in dispute of legal protection to a trademark due to Article 1512 and 1513 of the Civil Code of the Russian Federation.

According to Article 10bis of Paris Convention for the Protection of Industrial Property any act of unfair competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition. The same approach is defined in Article 14 of the Federal law «On competition» that provides for the prohibition for unfair competition that is misleading of a consumer, intentional development of false expression about the goods (consumer performance, quality, quantity) including its production features (character, means, location) as well as its producers.

At the same time our comments regarding area of convergence № 6 should be added with the reference to legislation concerning advertising (Article 5 of the Federal Law «On Advertising») and consumer protection legislation (within federal state consumer rights supervision, Article 40 of the Federal Law of the Russian Federation «On Protection of Consumers»).

Examples of registrations are given below:

Area of convergence № 1



- certificate 452879 «Russian league of martial arts» in the name of All-Russian Union of Public Association "Russian league of martial arts", Moscow (registered completely);



- certificate 358132 «Russian challenge» **Russian Challenge** in the name of CJSC "Media Arts Group", Moscow (registered completely);

Russian X-Challenge

- application 2015710957 «Russian X-challenge» in the name of LLC "MCA Communications", Moscow (workflow management has not been completed).



- application 2016712483, «Russia» in the name of Joint-stock company "Airline company "Russia", Saint-Petersburg;



- certificate 603423 «Russia» in the name of Joint stock company "Airline company "Russia", Saint-Petersburg;



- certificate 521868 «Russia hd» in the name of Federal Unitary Enterprise "All-Russian State television and radio broadcasting company", Moscow;



- certificate 467151 «APEC Russia 2012» in the name of Administrative Department of the President of the Russian Federation, Moscow;



RUSSIA 2018

- certificate 552416 «Russia 2018» , certificate

RUSSIA 2018

471195

, certificate 471074

RUSSIA 2018

in the name of

Fédération Internationale de Football Association (FIFA), Zurich, Switzerland;



- certificate 445929 «Russia 2» in the name of

Federal Unitary Enterprise "All-Russian State television and radio broadcasting company", Moscow;



- certificate 445927 «Russia 2» in the name of Federal Unitary Enterprise

"All-Russian State television and radio broadcasting company", Moscow;



- certificate 445925 «Russia 24» in the name of

Federal Unitary Enterprise "All-Russian State television and radio broadcasting company", Moscow;

Area of convergence № 2

Due to absence of the actual example that can illustrate this case we can simulate it with the following example:

For example, there is application filed for examination that is a country name, for example, Cuba, with regard to goods (Class 29 of International Classification of Goods and Services). The applicant is a Cuban company. There will be a refusal to register the trademark due to subparagraph 1 §3 of Article 1483 of the Civil Code.

Area of convergence № 3

Example:

ITAL

- application № 2015715611 «Ital» in the name of LLC
"SEQUOIA 2000", Kharkov, Ukraine (decision of refusal).



- international registration 1205678 «Jamaica» in the name of
JAGOVITAMINId.o.o., Croatia (decision of refusal).