

# Russia

**Russian legislation for trademark protection has certain peculiarities that need to be taken into account when planning to enter the Russian market and choosing a strategy for trademark protection**

## Initial strategies

### Use requirements

The first point to note is that in order to file a trademark application it is not necessary to submit material proving use of the mark, nor even intention to use. This lack of a use requirement theoretically permits any legal person to obtain a trademark registration without actually trading under it.

This was, and may continue to be, a reason for the appearance of 'pirate' registrations. Such registrations were a serious problem; however, they have decreased in number significantly in recent times. Examination now includes an assessment (based on an internet search) as to whether the subject of an application has the potential to mislead consumers as to the real producer of the goods or services. Despite this, 'pirate' registrations remain a possibility and should be taken into account when working out a strategy for trademark protection.

### Types of mark

In accordance with Point 1 of Article 1482 of Part 4 of the Russian Civil Code: "Verbal, pictorial, three-dimensional, and other designations or their combinations may be registered as trademarks." The words "other designations or their combinations may be registered as trademarks" imply that there is no limitation on the kinds of mark available, as long as they meet the requirements for protection.

### Colour of mark

Moreover, Point 2 of Article 1482 also states as follows: "A trademark may be registered in any colour or colour combination". This statement, however, does not mean that protection of a black and white trademark automatically provides protection to a variant of that mark in colour. The owner of a trademark in black and white does not have exclusive rights for all colour variants of the trademark.

## Transliteration and translation

Uncertainty also shrouds the protection of word marks filed in Cyrillic, Latin or other scripts. It is not possible unambiguously to assert that a Cyrillic version of a registered trademark allows the owner to protect the Latin version of that mark. Despite being identical phonetically, such marks differ visually and there is some debate as to whether they can be viewed as similar under trademark law.

The situation becomes more complicated in cases where the word mark has a particular meaning since phonetic and visual perception of a translated version may differ significantly from a transliterated version of the word. Proving similarity of these versions to the extent of confusion is often very problematic and sometimes impossible.

The above considerations are important for the choice of an appropriate trademark registration strategy and it may be necessary to register all possible versions of the mark. However, it must be borne in mind that even this carries its own risks, since if a mark is not used within three years from the date of registration it may become vulnerable to a non-use cancellation action by an interested party.

In addition to the above, it should be mentioned that trademarks written in hieroglyphs are viewed as device marks and not as word marks, since they cannot be understood by Russian consumers. As a result, registering the Cyrillic and Latin versions of a hieroglyphic mark is recommended.

## Goods and services

An important strategic aspect of trademark protection is the proper elaboration of the list of goods and/or services. There is a common misconception among those filing trademark applications in Russia that simply listing the appropriate class heading of the Nice Classification gives protection in respect of all the goods or services within that class. Part 4 of the Russian Civil Code does not permit such an assumption; on the contrary, Point 2 of Article 1481 states clearly and definitively that: "The trademark certificate shall certify the priority of the

trademark and the exclusive right to the trademark with respect to the goods indicated in the certificate."

## Marks lacking distinctiveness

It is of course not possible within the course of one short article to consider all the potential problem areas that should be taken into account when choosing an appropriate trademark filing strategy, but one more peculiarity should be mentioned.

Seeking registration for marks consisting solely of consonant letters only is problematic, since such designations are considered to be non-distinctive and therefore not protectable. Having said this, the situation with regard to such marks, just as with other marks that could be seen as lacking distinctiveness, is not beyond hope. Registration of these marks may be possible if the applicant submits evidence showing intensive use of the marks in Russia. Such evidence should prove that the mark had acquired distinctiveness for Russian consumers.

Although the relevant legislation does not specify the length of time a mark needs to be used to acquire distinctiveness, the current approach suggests that the mark must be used intensively before filing the trademark application (in accordance with national procedure) or claiming protection in Russia for an international registration.

## Prosecution

### Timeframe

The process of registering a mark in Russia usually takes about 14 to 15 months, which includes formal examination (within one month), substantive examination (within approximately 12 months) and the final registration and publication stages (one month).

Of course, where any obstacle for registration is revealed this term is increased and cannot be predicted. The applicant is informed of such obstacles by way of the Examiner's Notification and is given six months in which to file a response. This term is not extendable.

Where the obstacle refers to 'absolute grounds' for rejection (current legislation

does not actually divide the grounds for rejection into absolute and relative grounds), this six-month period is usually enough for gathering the necessary materials – for example, proving distinctiveness or proving lack of descriptive character and so on. However, if a ground for rejection is based on similarity with prior rights there is often insufficient time to overcome the obstacles successfully.

### Dealing with similarity

The following paragraphs outline the steps that can be taken to overcome rejection on relative grounds.

It is possible to obtain a letter of consent from the owner of an earlier mark (registered or pending), but, in practice, an examiner may not accept such a letter where he or she considers the marks at issue to be too similar. This is in spite of the following provision of Point 6 of Article 1483 of Part 4 of the Russian Civil Code: “Registration as a trademark in respect of homogeneous goods of a designation confusingly similar to any of the trademarks referred to in the present subsection shall only be allowed on consent of the right owner.”

This situation generally occurs when the marks contain identical word elements and are almost identical phonetically, since the word element of a mark is considered as having the most impact on the consumer’s perception and memory. It should be noted that even the Federal Court decision of November 26 2007, where the court recognized that obtaining a letter of consent from the owner of the cited mark is an unconditional ground for registration, is not taken into account by the examiners of the Trademark Department or the appellate Chamber of Patent Disputes, which hears appeals from decisions of the Trademark Department.

However, in the case that the cited mark belongs to a related company, the examiner may accept a letter of consent for a closely similar mark, provided such relationship is clearly mentioned in the letter.

It is possible to seek assignment of the cited mark, but the six-month term is sometimes not enough for the necessary negotiations and for the procedure to record the change of ownership.

It might also be possible to reach an agreement with the owner of the cited mark in respect of a voluntary limitation of the list of goods and services, through deletion of those that are identical or homogeneous in the cited registration or application. In practice, however, such an agreement is rare and would also need time to record.



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The most radical but also most effective way of overcoming an earlier right is to obtain cancellation of the cited mark due to non-use (where it actually has not been used), but these cases, which are dealt with by the Chamber of Patent Disputes, take longer than six months (usually between seven and 10 months). The Chamber of Patent Disputes may refuse to consider such a cancellation action if it believes that the sole interest of the party in initiating the claim is to remove an obstacle to its own trademark application.

Where the applicant fails to remove an obstacle for registration within the six-month term, it can appeal to the Chamber of Patent Disputes against the decision to reject the application within three months. But any

problems relating to obstacles to registration must be solved before filing the appeal. Under current practice, the Chamber of Patent Disputes is unlikely to consider new circumstances and facts raised on appeal.

Quite often the situation occurs where the examiner cites a registered mark that is owned by the applicant. For example, the pre-existing Latin script version of a mark may be cited against a new version in Cyrillic or a black and white variant of the mark is cited against a new version in colour. This can happen when the mark owner changes address or name, meaning that the details do not match those on the earlier registration. Such differences often give an examiner reason enough to cite the earlier mark as an obstacle to registration. However, even submitting documents proving the change of address or name is no guarantee that the citation will be withdrawn. To overcome the obstacle, it is necessary to change the name and address in the cited registration. [WTR](#)