

# Russia

**Part IV of Russia's Civil Code provides for the registration of an array of non-traditional trademarks. But graphical representation may be an issue in some cases**

Article 1482 of Part IV of the Russian Civil Code (in force since January 1 2008) provides that the following types of mark may be registered on their own or in combination:

- word marks;
- picture marks;
- three-dimensional marks; and
- other indications or their combination.

Trademarks can be registered in any colour or combination of colours.

Further, Article 1483 of Part I of the code prohibits the registration of signs that lack distinctiveness.

## Colour marks

A trademark may be registered in any colour or colour combination as long as it is distinctive.

However, neither the Civil Code nor regulations of the Patent and Trademark Office (PTO) specifically cover the registrability of trademarks that consist of colours without any word or figurative elements. Therefore, one can assume that the registration of a colour *per se* is not prohibited.

The applicable test for applications to register a single colour or a colour combination is the general distinctiveness test. However, in practice the PTO tends to consider that marks consisting of a single colour or a combination of colours alone lack distinctiveness and are thus not protectable. While the Trademark Register contains marks in colour, including combinations of colours, a single colour or a combination of colours appears to have very little chance of being registered. To obtain a registration, the applicant would have to prove the acquired distinctiveness of the colour or combination of colours by submitting evidence of its extensive use in Russia. Evidence of use before the filing date would be most important. Evidence could include the following documents:

- shipping and customs documents, including invoices and copies of the

delivery forms displaying the mark and mentioning its owner;

- a survey confirming that the colour is known to consumers as a trademark (ie, as a designation of origin), and is associated with the applicant and the goods to which the colour is applied;
- copies of the applicant's annual reports showing that the goods are sold in Russia and the volume of such sales;
- statements or other evidence from local distributors and/or local shops, including dated price lists;
- the Russian quality and conformance certificates;
- copies of dated advertising materials;
- information about the applicant's attendance at trade fairs in Russia and abroad; and
- extracts from the Russian media and other materials.

## Three-dimensional marks

Article 1483 of Part IV of the Civil Code prohibits the registration of designations that represent the shape of goods where the shape is determined exclusively or mainly by the properties or purpose of the goods. This is probably because such marks can be considered to lack distinctiveness. Accordingly, the key aspect of the examination of a three-dimensional sign is to determine:

- whether the shape results from and is defined exclusively by its functional purpose; or
- whether the shape is an original design which gives the mark distinctiveness.

A shape that is unique and special may be recognized as distinctive and registrable, even if it is functional. Also, if the shape has been intensively and widely used in Russia before the filing date, the applicant may be able to prove that the shape has acquired distinctiveness and thus obtain a trademark registration for the shape.

For instance, Mortier Catering NV applied to register the shapes of lidded plastic containers in respect of goods in Class 29 of the Nice Classification – namely, “meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits

and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; food products made on the basis of aforesaid goods and included in Class 29, including paste and other paste products” (Applications 2005713885 and 2005713882).

The PTO rejected the applications on the grounds that they lacked distinctiveness, since they represented three-dimensional objects the shapes of which were considered:

- not original;
- defined exclusively by their functional purpose; and
- to be widely used for similar goods (ie, paste products) on the market.

Mortier appealed to the Chamber of Patent Disputes. Mortier's main arguments were that:

- it already held a registration for a similar mark; and
- other companies had registered analogous shapes as trademarks.

The Chamber of Patent Disputes dismissed these arguments. It held that the shapes for which Mortier was seeking registration were the shapes of containers in which products were sold – in this case, containers with covers for paste products. In the chamber's opinion, the shapes were unoriginal and defined exclusively by their functional purpose in relation to the goods in Class 29. The shapes did not feature enough original elements to be considered characteristic of Mortier's goods. Accordingly, the chamber found that the shapes lacked distinctiveness and upheld the PTO decision.

Further, practice shows that trademark applications representing the shape of a bottle for goods in Class 32 or 33 (beverages) can be refused registration on the grounds that the shape lacks distinctiveness and is the traditional shape of a bottle (ie, is an unoriginal form of container or vessel in which the products are usually sold) defined exclusively by its functional purpose. The shape of a bottle for goods in Class 21 (bottles) could also be considered to lack distinctiveness and to represent realistic images of such products. In this case,

arguments that the applications consist of original shapes and as a whole form original compositions that could distinguish the applicants' goods from similar goods of different manufacturers could be taken into consideration. Besides, Russian legislation provides protection to signs that have acquired distinctiveness through extensive use in Russia. Therefore, documents showing that such signs were used in Russia before the filing date and that the signs have become known to consumers as a result of such use can be taken into consideration and increase the applicants' chances of obtaining protection for such marks.

### Sound marks

The requirements to register sound marks are similar to those applicable to the registration of ordinary marks. However, the representation of sound marks may be different – for example, it can consist of an audio file, a phonogram or a musical score. The potential to register a sound mark under Russian law is higher than under international procedures since the latter allow only musical scores as a representation of sound marks. The presentation of a musical fragment only in the form of musical notation does not always give a full impression of the mark and does not fully identify the musical phrase since the musical phrase will sound different if played on different instruments. The Russian PTO accepts audio files in different forms, including tapes and CDs. This gives applicants the possibility to register not only musical marks which can be represented graphically on a score, but also natural sounds (eg, surf sounds, bird sounds, growls) and functional sounds (eg, engine sounds).

Not all elements of a sound mark will always be registrable. Elements that lack distinctiveness in respect of the goods and/or services for which registration is sought will be considered unprotectable.

The sound mark must contain no element that:

- could be considered as misleading in respect of the manufacturer of the goods and/or service provider; or
- is contrary to public interest or morals.

During the examination of an application for a sound mark that includes words or graphical elements, the PTO will evaluate the degree of similarity of such elements with registered marks and pending applications. The examination lasts between 12 and 14 months and if there are no obstacles, the registration is issued.



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Alexander Nesterov graduated in law from the Moscow Military Academy in 1995, specializing in criminal law. He then worked as a lawyer for Russian state organizations. In 2001 Mr Nesterov joined Gorodissky & Partners, where he specializes in and advises on the protection of trademarks and appellations of origin of goods, with a particular emphasis on trademark proceedings in Russia, the Commonwealth of Independent States and the Baltic states. Mr Nesterov speaks Russian and English.

There are currently over 30 sound marks, held by Russian and foreign owners, on the Russian Trademark Register.

### Light marks

The requirements to register light marks are the same as those for ordinary marks. However, an application to register a light mark must include its characteristics such as sequence of light, the duration of the glow and other features.

### Olfactory marks

As mentioned above, Article 1482 of Part IV of the Civil Code provides that verbal, pictorial, three-dimensional and other signs or combinations thereof may be registered. 'Other signs' refers to sound, light and other marks and combinations thereof – that is, the law does not specifically mention that olfactory marks can be registered, neither does it directly prohibit the registration of such marks. No special requirements apply to the examination of olfactory marks. However, marks must be able to be represented graphically. This raises the question of whether a word description could be considered an adequate graphical

representation for olfactory marks. For example, as discussed above, an application to register a light mark must contain the characteristics of the light symbols, their sequence, the duration of the glow and other features. An application to register a sound mark must contain either a musical score or a phonogram. Thus, if a musical score is considered an adequate graphical representation for a sound mark and a word description is considered an adequate representation for a light mark, then it is likely that the PTO would consider a word description acceptable for olfactory marks. However, no olfactory mark has yet been applied for in Russia and so only time will tell what difficulties applicants of such marks will face. [WTR](#)