

Embracing the new

While fluid marks are an eye-catching marketing technique, protection should be obtained for all versions of any trademarks currently in use or expected to be used in future

Fluid trademarks are a relatively new concept for Russian consumers. In general, a trademark is considered as a static word term, graphic sign or combined designation that is used to identify and distinguish the products or services of one rights holder from those of others. The idea of rebranding, where rights holders commonly update their trademarks with new design, graphic or word elements, is familiar to consumers.

A fluid trademark is not static. The principal idea is not to replace the original mark, but to use it in a number of variants that coexist with the mark as originally registered. A fluid mark allows the rights holder to make significant and continual changes to a registered trademark; by making such changes, the rights holder can refresh its mark, which helps to keep consumers interested in the goods or services with which it is associated. Fluid trademarks are commonly considered as more eye-catching and interesting compared to trademarks that remain static over a long period.

According to Article 1482 of Part IV of the Civil Code (in force since January 1 2008), the following types of trademark can be registered:

- verbal;
- pictorial;
- three-dimensional;
- other indications; and
- a combination of any of the above.

A trademark may be registered in any colour or colour combination.

The code contains no explicit provisions in respect of fluid trademarks. In addition, the code contains no special provisions in respect of slogans; they are therefore regarded as akin to word marks and accordingly, all requirements applicable to

word marks are also applicable to slogans.

This article considers the problems that rights holders could face in Russia and the factors of which they should be aware if they are thinking of incorporating fluid trademarks into their branding strategy.

Use of a trademark

The purpose of a trademark is to distinguish the goods or services of one entity from those of others. Marks most suitable for use as fluid marks are those which are already well known. Consumers should be able to recognise a trademark as originating from a particular rights holder, so that when it is presented in a variant form, it is understood by the public at large as belonging to the same rights holder.

Regardless of prior reputation, if a rights holder creates a variant of its mark by adding new graphics or word elements, it could come up against problems connected with the appropriate use of the mark as laid down in the code.

Article 1486 implies (but does not state directly) that it is mandatory for a rights holder to use the registered mark as a condition of retaining the rights in that mark.

Article 1486 further provides that legal protection of a trademark may be terminated prematurely in respect of all or part of the goods for which it is registered in connection with non-use for three consecutive years after its registration (provided that the trademark has not been used right up to filing of the termination request).

In accordance with the code, a trademark is considered 'used' if it is affixed to the goods (or their packaging) for which it is registered by either the rights holder or a licensee, provided that the licence agreement concluded between the two parties has been duly registered with the Russian Patent and Trademark Office (RPTO).

A trademark is protected by law only in exactly the same form in which it is registered. For example, registration of a trademark in Latin covers only the Latin version and no other version in different alphabets, including Cyrillic.

Therefore, in order to retain its rights to a trademark and successfully defend the mark against any third-party cancellation actions based on non-use, the rights holder must use the mark in accordance with the issued registration certificate.

However, according to Article 1486, rights holders are permitted to use a modified version of their trademarks. The use of a trademark with minor changes which do not alter its distinctive character is considered as 'use'; such use will not lead to invalidation of the trademark registration and will not limit the protection granted to the mark.

The problem lies in determining whether changes made to the original registered trademark are considered significant. Neither the code nor any other regulations contain provisions in this respect. A rights holder must decide whether the modified trademark has lost its original character and whether additional graphic or word elements have created a materially different impression of the mark among consumers. This approach is rather subjective; therefore, the issue of whether changes are significant is often left to the discretion of a competent body (eg, the courts).

Alternatively, it is possible to file a request with the RPTO to incorporate any changes into the original registered trademark. Acceptance of such changes by the RPTO could serve as confirmation that the changes are not significant, since if any changes markedly altered the level of perception of a mark, they would be refused registration. Whether it is practical

to register changes to a trademark each time and whether such an approach would suit the purpose of fluid trademarks is another matter, however.

Companies wishing to use different versions of their original registered trademarks without registering each version as a separate trademark could risk losing their registered trademarks if cancellation actions based on non-use are filed and it is determined that changes to the registered trademark have altered its distinctive character. A similar problem could arise in cases where evidence of use relies on use of a significantly altered form of the registered trademark by a licensee.

Thus, whether use of a trademark in an altered form as compared to the original registered version constitutes proof of appropriate use remains under debate. If a trademark is used in a different form from that which was originally registered, it will be considered whether the changes are significant enough to alter the distinctiveness of the original. Therefore, for the purpose of proving appropriate use and in order to avoid cancellation based on non-use, it is recommended to register trademarks in all of the various forms in which they are used or will be used in the future.

Risk of infringement

If a trademark is being used with additional elements which are not protected by the original registration or a separate registration, the rights holder could face third-party infringement actions against such use.

Article 1229 of the code provides that the rights holder may, at its discretion, permit or prohibit other parties from using the results of its intellectual activity or means of individualisation. Absence of a prohibition should not be considered as consent. Third parties may not use the corresponding result of intellectual activity or means of individualisation without the rights holder's consent. Unauthorised use is unlawful and is liable to punishment under the existing code and other statutes.

Article 1484 provides that no one has the right to use similar indications of a registered trademark without the rights holder's permission with respect to the same or similar goods or services which the trademark has been registered if, as the result of such use, likelihood of confusion will arise.

Before applying changes to a registered trademark and using it with additional elements, rights holders should search the RPTO database in order to determine whether prior rights exist in respect of such word,



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graphic or combined elements. Whether it is practical to conduct such searches if changes to a trademark are being implemented on a regular basis is another question.

On the other hand, if a rights holder is using variant forms of its registered trademark which incorporate unregistered graphic or word elements, it cannot prevent third parties from using identical or similar elements for identical or similar goods or services, unless such elements are subject to copyright protection.

The code establishes the criteria under which a work can be protected by copyright and related rights, moral and economic rights and instances in which free use of a work protected by copyright and related rights is permitted without the rights holder's consent. The code provides that copyright protection must not be conditional on compliance with any formality. Protection is granted to any original work (or portions of works, including titles) of science, literature or art which is the result of creative activity, irrespective of the purpose or merit of such works.

Cases related to copyright are complicated and require the submission of

different types of document in order to prove the work's copyright-protected status. In addition, issues regarding proving ownership of copyrighted subject matter could arise. Therefore, it seems prudent – as with issues concerning the use of trademarks as discussed above – to obtain protection for all expected variations of a trademark.

Conclusion

Best practice for rights holders with regard to fluid trademarks would be to file and obtain protection for all versions of any trademarks currently in use and those expected to be used in the future. [WTR](#)