

Russia

Part IV of the new Civil Code establishes the basic regime for the protection of pharmaceutical trademarks in Russia. Rights holders must also be aware of legislation governing the use of medicines, and practice at the Patent and Trademark Office and the courts

When choosing a designation to use as a trademark for a pharmaceutical product the decision should be based on the requirements in Russian legislation on trademarks and the Law on Medicines, the latter requiring state registration of any pharmaceutical preparation for the purposes of its import, production or sale in the Russian Federation.

On January 1 2008 Part IV of the Russian Federation Civil Code came into force, which superseded the earlier Law on Trademarks, Service Marks and Appellations of Origin. The code establishes a number of grounds for rejecting designations to be used for pharmaceutical products. The following paragraphs describe these grounds in detail and the interplay between the code and other relevant legislation.

Lack of distinctiveness

Designations that lack distinctiveness or consist only of the following elements cannot be registered as trademarks:

- Signs that are in general use to indicate the type of goods at issue;
- Signs that are generally accepted symbols and terms;
- Signs that are descriptive as to the kind, quality, quantity, feature, purpose or value, or time, place or means of production or sale, of goods; and
- Signs representing the form of goods determined exclusively or mainly by the nature or purpose of the goods.

However, these provisions do not apply where a trademark has acquired distinctiveness as a result of its use. The Civil Code does not define the term, geography and intensity of such use. But according to the practice of the Russian Patent and Trademark Office (PTO), it is necessary to prove that a mark has been intensively used in Russia before filing a

trademark application (or claiming protection for an international registration).

Misleading elements

Designations that consist of or comprise the following elements cannot be registered as trademarks:

- Signs that are false or mislead consumers in respect of the nature of the goods or their manufacturer; and
- Signs that are contrary to the public interest, principles of humanity and morals.

Confusing similarity

Designations that are identical or confusingly similar to the following signs are prohibited from registration as trademarks:

- designations with earlier priority in Russia which apply to homogeneous goods;
- prior registered trademarks (including those protected in Russia under the Madrid System); and
- trademarks that are recorded as well known in Russia.

However, even if the PTO considers the mark to be similar to an earlier trademark, the owner of the later mark may be able to register the mark provided that it obtains written consent from the owner of the earlier similar mark. This exception refers to similar but not identical marks.

Case law from the Chamber of Patent Disputes of the PTO, which has competence to rule on objections against trademark registrations, suggests that a difference in one letter between conflicting pharmaceutical trademarks is usually insufficient to eliminate any likelihood of confusion. This can be the case even when the initial letters are different. Thus, the chamber held in 2006 that the trademarks KARSIL (Registration 214489) and DARSIL (Registration 231866) (both in Cyrillic characters) were confusingly similar. Differences in other letters may not dispel confusion where the designations are phonetically similar. For instance, the Chamber of Patent Disputes considered in 2008 the marks MIOZIM (Registrations 151521, 189455, 248463 and 260238 and

International Registration 84573) and MEZIM (Registration 309264) (both in Cyrillic) to be confusingly similar.

In addition, marks having identical prefixes or suffixes may be deemed confusingly similar. For example, the Chamber of Patent Disputes held in 2006 the marks CEBRILYSIN (in Cyrillic) (Registration 212305) and CEREBROLYSIN (Registrations 66189 and 105288) (in Latin and Cyrillic characters) to be confusingly similar. However, it did not come to the same conclusion with regards to the marks CEPHABOL (Registration 186263) and ENCEPHABOL (Registration 69003 and International Registration 82668) (both in Cyrillic), despite the fact that one mark is fully incorporated into the other.

When designations under comparison include identical descriptive elements (suggestive of the use for the drug or the condition it is designed to treat), but differ in some other elements, then this may be sufficient to overcome any likelihood of confusion when the marks are assessed as a whole, notwithstanding that the differing elements may be 'weak' elements. Thus, the Chamber of Patent Disputes refused in 2007 to recognize any similarity between DIABETON (Registration 76656 and International Registration 804956) (in Cyrillic) and DIABETRIN (Registration 293503) (in Cyrillic and Latin characters) registered for homogeneous goods in Class 5 of the Nice Classification.

Similarity with company and trade names

Part IV of the Civil Code also prohibits the registration of designations that are identical or confusing similar to a company name or trade name protected in Russia, where the rights in the name are earlier in time than the priority date of the applied-for trademark. Therefore, in addition to conducting a search for registered and pending third-party trademarks, companies seeking to protect a new pharmaceutical mark must also make a preliminary search of the Uniform State Register of Legal Entities to reveal any potentially conflicting firm names.

The Civil Code does not specifically require PTO examiners to assess whether a proposed trademark registration is likely to cause confusion with a prior registered firm

name at the examination stage. However, should the examiner identify the existence of such a name and be of the opinion that the applied-for designation will mislead consumers as to the manufacturer of the goods, the examiner may refuse to allow registration of the designation as a mark, provided that the owner of the earlier registered firm name manufactures homogeneous goods to those covered by the mark.

Similarity with pharmaceutical names

A search should also be made of other relevant databases such as the State Register of Medicines. This will indicate whether a third party has registered an identical designation as a drug name in compliance with the Law on Medicines. In such case the examiner may consider that the proposed registration will mislead consumers in respect of the manufacturer of the drugs at issue and the examiner may refuse registration as a result.

Pursuant to the Law on Medicines, medicines can be manufactured, sold and used in the Russian Federation only if they are registered with a competent state body (at present, the Federal Service for Supervision in Healthcare and Social Development). To obtain state registration of a drug, the applicant must provide the competent state body with the original name if such name is registered as a trademark in compliance with trademark law.

The Russian Federation Ministry of Healthcare and Social Development (which coordinates and controls the Federal Service for Supervision in Healthcare and Social Development) adopted Recommendations on Rational Selection of Drugs Names in 2003. These recommendations outline the procedure applicable when examining the visual and phonetic similarity between names; in particular, they provide that the compared names should differ at least in three letters in any combination. However, this rule is not mentioned in the Regulations for Drafting, Filing and Consideration of Trademark and Service Mark Applications of 2003, which are followed by the PTO in the course of examination of trademark applications. Therefore, complying with the recommendations will not guarantee that the selected name will be registered as a trademark. Further, the registration of a drug name on the State Register of Medicines does not guarantee the registration of the name as a trademark.

Part IV of the Civil Code does not provide any special provisions regulating international non-proprietary names (INNs).



Viacheslav Rybchak
Trademark attorney
RybchakV@gorodissky.ru

Viacheslav Rybchak graduated from the Moscow State University of International Relations in 1998 specializing in international private law and IP law. He joined Gorodissky & Partners that year and now counsels clients on all matters relating to trademarks and appellations of origin in Russia, the Commonwealth of Independent States and the Baltic states.



Ludmila Serova
Partner
seroval@gorodissky.ru

Ludmila Serova graduated from the Moscow State University of Mining in 1977 as a mechanical engineer. She then attended the Central Institute of Intellectual Property (Moscow). After working for a few years as an engineer, Ms Serova worked as an examiner with the Russian Patent Office. She then worked at major IP firms before joining Gorodissky & Partners in 1998. Her practice includes all matters relating to trademarks.

Nonetheless, it is safe to assume that the PTO will refuse registration where a mark is identical to an INN. However, this may not be the case where the mark is merely similar to an INN as this is not expressly prohibited by the Civil Code.

Non-use of a pharmaceutical mark

The procedure for cancelling a pharmaceutical trademark on the grounds of non-use has some peculiarities. For example, the competent body for hearing such disputes (the Chamber of Patent Disputes) will take into account the fact that the rights holder is engaged in the pharmaceutical industry and as a consequence must fulfil certain additional legal requirements, such as those regulating the introduction of pharmaceuticals into circulation. Under Article 16 of the Law on Medicines, drugs may be released for circulation in Russia only if the packaging includes the following information in Russian:

- the drug name;
- the INN; and
- the name of the manufacturer.

Drugs are allowed for distribution only when they are supplied with drug information sheets (annotations), which should also contain the above data in Russian.

Accordingly, while a drug name may be registered as a trademark in Latin characters, the Law on Medicines requires that the manufacturer place a Cyrillic transliteration of the name on the packaging and information sheets. This inevitably raises the following question: does use of the Cyrillic transliteration equate to use of a trademark registered in Latin characters?

The Chamber of Patent Disputes issued a decision in 2006 for the trademark BRONCHITUSSEN VRAMED, which may go some way to answering this question. It held that:

- the use of the Cyrillic transliteration of a drug name constituted appropriate use of the respective trademark registered in Latin characters; and
- such use is substantiated by the Law on Medicines.

However, Russian courts do not have to follow precedent; thus, the approach taken in this particular decision will not necessarily be applied in future cases. Nevertheless, to secure better protection for an original drug name in Russia it is recommended to register the Cyrillic version of the Latin name as a separate mark. **WTR**