

Taking a bespoke approach

In the absence of specific trade dress legislation, a number of protections are available to protect a product's visual appearance

Neither the Russian Civil Code nor other statutory regulations or official guidelines refer to or contain a specific definition of 'trade dress'. It is well known in IP practice that the term is widely used to denote a product's visual appearance where this is capable of signifying the product's origin. IP practice suggests that, as a legal term, 'trade dress' should be interpreted broadly to include, in particular: the product label; the design of the product and its packaging - in particular, the colour and shape of the product and its container; and the interior and exterior design of points of sales (eg, outlets or restaurants).

Given this, trade dress functions as a means of individualisation and should enjoy protection under civil legislation.

In Russia, as in many other countries, a product's visual appearance or packaging, including labels, can be protected as a trademark or industrial design. Both forms of protection have their own peculiarities which help to define the scope of protection. How well the protection functions mostly depends on whether the right form of protection is chosen.

Article 1352 of the Civil Code states that an 'industrial design' is an artistic and constructive solution defining the outer appearance of an industrial or handicraft article. Article 1477 defines a 'trademark' as a sign used in trade to distinguish the goods and services of one undertaking from those of another. It is obvious that the two IP rights can fulfil similar functions - owing to their aesthetic properties, both can individualise products and in many cases they bear significant distinctiveness to help attract consumers. However, not all designations can enjoy both forms of protection.

The most common examples of designations that can benefit from trademark protection, but cannot be

granted patent protection as industrial designs, are word and device designations, provided that such devices are not applied to products. Similarly, not all designations that meet the requirements of a registered design can obtain trademark protection. For instance, the Civil Code expressly prohibits the registration of trademarks that are realistic representations of products, where the marks are intended to be used in relation to those products.

According to Russian current practice, the most typical examples of trade dress protection as trademarks include trade dress product labels, trade dress product shapes and trade dress product containers. However, the most recent practice demonstrates an increase in trade dress-related cases where rights holders have preferred to rely on the registration of non-traditional trademarks when seeking protection for trade dress; and some of these cases have successfully achieved adequate protection.

Successful trade dress cases in which rights holders have obtained protection by way of registration of non-traditional marks include the registration of single colour trade dress and interior design trade dress. The former is unique, as under current practice, single colour marks are not considered to be inherently distinctive; the only way to get them registered is to prove that such a mark has acquired the necessary distinctiveness through wide and extensive use on the Russian market before the priority date.

The latter case, according to the publicly available official information sources, met no official objections during examination from the registry and was successfully registered. This suggests that such designations can, in principle, enjoy protection under Russian law.

The most typical trade dress features

that are eligible for trademark and industrial design protection simultaneously are shapes of products and their containers.

It is a common requirement for the registration of trademarks and industrial designs that the shape not be dictated by the need to fulfil a particular function (ie, the shape must be non-functional).

The two rights are compared below.

Authors' rights

Authors' rights are personal non-property rights, which are closely linked to an individual and cannot be assigned. Therefore, unlike the rights to use an industrial design, which can be transferred to another person or entity, authors' rights remain unchanged as long as the industrial design remains valid. At the same time, the Russian trademark system does not recognise authors' rights in relation to trademarks.

Within the trademark system, only two categories of entity are entitled to own trademarks: legal entities or natural persons engaged in business activities. This is in contrast to a requirement established by the industrial design system, whereby the range of possible applicants (owners) is wider and includes authors, employers and assignees of an author or employer.

Number of designations in an application

The patent system provides for an unlimited number of designations in an application, in case such designations are variants of one another or form a set. In contrast, the trademark system states that only one designation can be the subject of an application. Any variants of the trademark in question should be applied for in a separate application.

Novelty for trademarks is established by comparing them to other trademarks that enjoy earlier priority, either registered or

applied for in Russia. A trademark shall not be accepted for registration if it is found to be confusingly similar to a third party's prior national or international marks, where such a mark designates Russia in respect of similar goods or services. This requirement conforms to the local novelty criterion.

With respect to industrial designs, in order to establish the degree of novelty, the Patent and Trademark Office conducts a search of information which has become available worldwide before the priority date. Thus, the industrial design must conform to the worldwide novelty criterion.

Dependence of protection

With respect to trademarks, the scope of protection is defined by the list of goods covered by the mark and the trademark name itself. Trademark searches are carried out among prior marks that cover similar goods and services. This means that a mark may be entitled to protection even though there are third-party prior rights in identical or similar signs, provided that such rights relate to dissimilar goods and services.

The scope of protection for trademarks is defined by Article 1484 of the Civil Code, which states that a trademark owner has the right to forbid others from using the same or similar signs in respect of similar goods and services. In other words, trademark protection extends not only to the sign and the list of goods identified on the trademark registration certificate, but also to similar signs and similar goods. It is not difficult to establish whether the infringing mark is identical to the trademark owner's mark and whether the lists of goods are the same.

The most problematic issue is establishing the extent to which marks, and the goods to which they apply, are similar. Although Russian trademark legislation provides for certain criteria of similarity between marks (eg, phonetic, visual and semantic similarities) and the goods that they cover, all of these criteria suggest that a subjective approach towards similarity assessment applies, which may result in contradictory decisions from different examiners, especially given that there is no common law in Russia.

The Russian trademark system establishes a specific regime for well-known marks. In particular, protection granted to such marks extends to dissimilar goods, provided that the use by a third party of its identical or similar mark is capable of misleading consumers as to the source of the goods and may damage the well-known trademark owner's interests and reputation.

The scope of industrial design

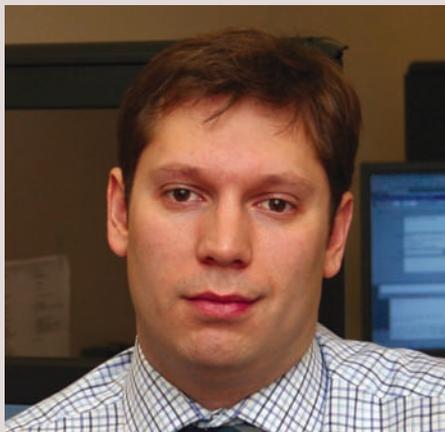


Alexander Vasilets

Partner

VasiletsA@gorodissky.ru

Alexander Vasilets graduated from the Russian People's Friendship University (Moscow) in 1980 as a mechanical engineer. He then continued his studies at the Central Institute of Intellectual Property (Moscow). Mr Vasilets joined Gorodissky & Partners in 1998, where he now specialises in designs, proceedings before the Russian Patent Office and foreign patent offices, and enforcement of design owners' rights.



Alexey Kratiuk

Partner

KratiukA@gorodissky.ru

Alexey Kratiuk graduated from the Moscow State Aviation University in 1998 as a radiotechnique engineer, and then from the Russian State Institute of Intellectual Property in 2002 as a lawyer. He joined Gorodissky & Partners in 1998, and specialises in trademarks and appellations of origin of goods, in particular trademark prosecution in Russia and the Commonwealth of Independent States and Baltic states.

protection is defined by essential features, which are shown in representations of industrial designs and are included in the list of essential features.

Termination of protection

Under Russian law, a trademark becomes vulnerable to cancellation for non-use three years after its registration. Protection may be terminated on the request of a third party if the subject of protection has not been used in Russia for three years preceding the filing date of such a request. The mark is considered to have been used if it has been used by the rights holder itself, its licensee or any other entity under the rights holder's control.

Russian law does not oblige a third party to submit evidence of non-use to initiate a cancellation action. The action can be based on the presumption that the mark has not been used and it is up to the rights holder to submit evidence of use in order to defeat the cancellation action (the burden of proof lies with the defendant). However, Russian law does set out acceptable reasons for non-use, such as *force majeure*. Such circumstances may be taken into account when a rights holder is defending a trademark in a cancellation action. The legal protection conferred by the industrial design registration cannot be terminated early on grounds of non-use.

As far as trademarks are concerned, Russian law establishes no prior use rights. As a general rule, trademark rights arise as a result of state registration of a trademark with the Russian registry. Exceptions are made for well-known marks, which may enjoy protection without first being registered. In contrast, the industrial design system refers to prior use rights as the right of any natural or legal person that used a particular solution in good faith in Russia before the priority date of a third party's application to register an identical industrial design to proceed with such use free of charge, provided that the scope of such use is not extended.

Full or partial assignment of rights is possible in the case of trademarks. The main requirement is that the assignment not lead to confusion on the part of the public. For instance, a partial assignment is not allowed if the remaining goods are similar to those to be covered by the assignee's mark.

Each of the existing forms of legal protection to be applied in relation to trade dress has its own advantages and shortcomings. The question of which is preferable must therefore be considered individually. [WTR](#)