

Gorodissky & Partners

Marks for a new generation

Non-traditional marks are modern and in vogue, but the possibility of effective enforcement and the ability to evidence proper use of a non-traditional mark are questionable in Russia

A trademark is an important instrument that allows producers to individualise and advertise their products. The more creative that a producer is in presenting its product, the greater the chance that its product will succeed on the market. The right choice of trademark can improve the likelihood of the product gaining popularity and achieving significant sales. In recent years, producers have become increasingly interested in using non-traditional marks in respect of their goods or services. The issues surrounding the legal protection of such marks have thus also become more important.

Russian legislation provides a solid base for the realisation of original ideas in the trademark sphere, as it allows for the possibility of registering different types and combinations of designation in addition to word, graphic and three-dimensional (3D) marks. There is thus great scope for trademark applicants, provided that their marks are inherently registrable.

In Russia, the number of trademark filings and registrations has been rapidly increasing in recent years. Most applications concern word, stylised or device marks, or a combination thereof. As in most countries, Russian legislation does not exclude the registration of 'non-traditional' marks. However, legislative gaps with respect to trademark filing requirements or filing formalities do not limit applicants' ability to secure protection for non-traditional marks. That said, enforcement can also be challenging, due to a lack of case law.

In some jurisdictions, trademark offices deny registration because some types of mark cannot be graphically represented. There are no such limitations in Russia. Article 1482 of the Civil Code provides that verbal, pictorial, 3D and other indications or combinations thereof may be registered as

trademarks. A trademark may be registered in any colour or colour combination. The wording "other indications" confirms that the law is liberal in this regard.

However, marks which are lacking in distinctiveness are not eligible for registration. Although the legislation lists certain designations which should be recognised as lacking in distinctiveness, in some cases this criterion is not definitive and remains at the discretion of the trademark office. Furthermore, Russian legislation provides the possibility of registering marks based on acquired distinctiveness.

While Russian legislation does not prohibit the registration of non-traditional trademarks, the case law is not well developed. It is difficult to state definitively which types of mark are traditional and which are non-traditional, given that there are no stipulations in the law. In general, all types of trademark, except word marks, figurative marks and combination marks, may be considered non-traditional. As the Civil Code specifies 3D marks as a type of trademark that may be registered, 3D marks are considered as common marks, despite the fact that in some jurisdictions, 3D marks are not eligible for registration. It is impossible to generate a comprehensive list of non-traditional marks as new types are constantly being created. Non-traditional marks include colours (either colours *per se* or colour combinations), sounds, textures, scents, position marks, holograms, motion marks and taste marks.

This list is not exhaustive and may be supplemented with new types of mark or combination marks.

Colour marks

A colour may not be monopolised by a particular enterprise. However, if there is a strong association between a colour

and a particular company and a specific product or service, the colour may be registrable. Examples of colour marks include Deutsche Telekom's magenta colour and Deer & Company's green and yellow colour combination. The criterion for such registration is that the colour in question be capable of sufficiently distinguishing the product or service and its origin (ie, the colour must be associated with the product itself and the producer of the relevant goods).

Russian Patent and Trademark Office (RPTO) practice shows that trademarks consisting of a colour *per se* or a colour combination are often considered to lack distinctiveness and are commonly rejected during examination for this reason. A trademark application consisting of a single colour or a colour combination can be registered only if it has acquired distinctiveness, and provided that the applicant can prove that the subject colour or colour combination functions as its trademark. The colour or colour combination should have been used in Russia before the application filing date. An example of such a registration is Reckitt Benckiser's registration of a particular shade of pink for its well-known cleaning product Vanish, which is extremely popular in Russia. This colour has been used intensively and is highly recognisable in Russia.

However, colour marks face significant hurdles on the road to registration. Further, although in some cases colour marks have been registered, some issues remain unresolved – namely, the rights holder's ability to enforce its rights. In the case of ordinary marks, phonetics, visual appearance and meaning of words are easy to compare. If a colour mark forms the basis for litigation, it can be difficult to defend such mark due to the absence of similarity criteria between colour shades.

Sound marks

Sound marks are another effective way to engage with consumers. Entrepreneurs increasingly use tunes or music to identify their products or services. For example, music that is repeatedly used in advertising or a tune which is played when a device is turned on or off may function as a means of individualisation and may distinguish products effectively. The registration of sound marks is possible in Russia, but this type of mark is not popular, despite the fact that numerous producers have sounds which are associated with their product or business.

The RPTO imposes specific filing requirements for sound marks. Different forms of expression of sound marks are available – for example, a sound mark may be presented as written notes on a stave, an audio file or a phonogram. The form of expression may also depend on the trademark registration procedure chosen by the applicant – that is, an international filing or a national application. The latter option is recommended when an applicant is seeking to register natural or functional sounds, which cannot be represented as written notes. A Madrid international filing does not provide for such a possibility. However, a national application for a sound mark filed with the RPTO can be presented in different forms, such as recorded on a cassette tape or CD or shown on a frequency chart. This allows for the registration not only of different tunes, but also of sounds that do not represent a melody playable on a musical instrument.

A sound mark undergoes substantive examination, where its similarity to prior applications or registrations is examined. Examination on absolute grounds is conducted, and the registration may be rejected if the examiner finds that the mark lacks distinctiveness. A sound mark may also be rejected if it misleads consumers or conflicts with public interests and morals. There are examples of cases in which sound marks were refused protection due to their similarity to a musical composition written by a person other than the applicant, where the applicant failed to confirm that it had copyright for the melody or authorisation from the composer or his or her successors to use that melody.

The RPTO publishes information on registered sound marks in the *Official Bulletin* and on its website. The online publication may contain written notes or downloadable sound files in MP3 format.

Position and motion marks

Position marks have gained popularity in



Vladimir Trey
Partner
TreyV@gorodissky.ru

Vladimir Trey graduated from Moscow State Linguistic University in 2000 as a linguist. In 2004 he graduated from the law faculty of the Russian State Institute of Intellectual Property as a lawyer, joining IP law firm Gorodissky & Partners in 1999. He specialises in trademarks, in particular trademark proceedings in Russia and the Commonwealth of Independent States, as well as the Baltic states. He also handles trademarks under the Madrid Treaty on international trademark registration and the Madrid Protocol. Mr Trey speaks both English and German.

Russia in recent years, especially among clothing and footwear manufacturers. An indirect explanation of the nature of a position mark and its functionality has developed in case law: the shape of the product is not subject to separate legal protection and functions only as a representation of the way in which the trademark is affixed to the product. An example of a position mark registered in Russia is Adidas's three-stripes mark, as used on shoes, caps and sportswear.

Unlike some trademark offices in other jurisdictions, the RPTO accepts motion marks for registration. This type of mark can be used, for example, in the entertainment industry to identify services in Class 41 or in the IT sector for consumer electronic products or computer software in Class 9. Given that Russian legislation states that a trademark is used properly if it is affixed to a product, a motion mark cannot be used for products in Class 12 (vehicles) or Class 5 (pharmaceutical preparations), unless future advancements in product packaging allow

moving images to be incorporated into packaging. Examples of registered motion marks include Microsoft's screensaver or an animated clip that is regularly shown before the feature films of a particular production company commence. A Russian example of a motion mark is a moving image consisting of four consecutive frames depicting a man who is removing a 'grey veil' from his clothes (Registration 442442). The trademark is registered for goods in Class 3.

Combinations of non-traditional mark

An example of a specific non-traditional mark is an image of a refrigerator whose door is transparent and includes air bubbles moving about in a fluid (Registration 282174).

A recent example of a combination of non-traditional marks is 'leather aroma' (Russian Registration 470375). According to the description of the mark in the original application, the applicant applied to register "a combination of image, word, tactile, sensor and olfactory elements". Further, the description reads that "tactile characteristics are easily recognizable and associated with the original leather material. Olfactory characteristics represent the smell of natural leather which can be recognized by everybody based on his/her own feelings". However, the publication of information on the registration of this mark in the online register did not include any notes that this was a tactile, sensory or scent mark. Furthermore, on examining the list of services for which it was registered ("practical training [demonstration]; arranging and conducting of colloquiums, conferences, workshops [training], seminars; video film production; publication of electronic books and journals online; educational services"), it is difficult to imagine how this mark is used in practice to provide such services.

Unlike in some other jurisdictions, Russian legislation does not lay down separate regulations that govern the legal protection and procedural issues associated with applications for non-traditional trademarks. The above examples show that many possibilities for registration exist. Nonetheless, it seems that sometimes there is no clear understanding of the benefits and consequences of trademark protection. Due to lack of case law, the possibility of effective enforcement and the ability to evidence proper use of a non-traditional mark are questionable. Therefore, the choice of which form a trademark should take should be considered carefully and reasonably. Nonetheless, non-traditional marks are modern and in vogue; this is why they are termed 'new-generation marks'. WTR