

Correspondence of Marks for the Certification purposes: Russian practice and approaches as to Rule 9 (d)(iv) of the Common Regulations

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ROUNDTABLE**

**Geneva
16-17 June
2016**

PLAN

- **Legal basis**
- **Identity:** Rospatent approaches (in particular, as to marks in different scripts)
- **Basic marks:** possible applicant's strategies (marks in different scripts)

Legal basis

- Rule 9 (d)(iv) of the Common Regulations
- Rospatent internal bylaws and regulations

Rule 9 (d)(iv) of the Common Regulations

■ Rospatent is to certify that:

the mark being claimed in the international application is **the same** as in the basic application/registration.

Identity: Rospatent approaches

- Strict approach:

“the same” = “identical”

- It is aimed at ensuring the consistency of the practice and approaches of the Office in the international and national levels.

Identity: Rospatent approaches

- Marks are considered **identical** (“the same”) to each other if all the elements thereof are on all fours.
- **Identity:** phonetic similarity, graphical (visual) similarity, semantic similarity

Identity: Rospatent approaches

Criteria for determining the identity of the marks:

- ✓ general visual impression
- ✓ type of the script
- ✓ typographic treatment (e.g. capital or small letters, block or script letters)
- ✓ lay-out of the letters
- ✓ alphabet
- ✓ colours and combination thereof

Identity: Rospatent approaches

To compare:

- The marks are considered **similar** if they are associated with each other in general, despite of certain differences.
- Similarity is **not acceptable**.

Identity: Rospatent approaches

NOT ACCEPTABLE

- Different alphabets:

АЛЬФА vs. ALFA

- Different scripts:

ЦИТОВИР vs. ЦИТОВИр

Identity: Rospatent approaches

NOT ACCEPTABLE:

➤ Translation:

Черная карта vs. CARTE NOIRE

Черный квадрат vs. Black square

Identity: Rospatent approaches

NOT ACCEPTABLE:

- Colour and layout of the elements:



Банные
штучки

vs.



Basic Marks: Possible Strategies for an Applicant

In case of a national mark in **Cyrillic**, on the international level applicant may:

- claim for the protection of the identical **Cyrillic** mark (transliteration is required);
- apply for the variant thereof in **Latin** on the national level, but there is a risk of the pre-term termination as the result of the nonuse (CC, Art. 1486).

Basic Marks:

Possible Strategies for an Applicant

Consequences of Nonuse of a Trademark

TM may be early terminated as the result of the nonuse continuously within any three years after its official registration.

A request for the pre-term termination may be filed:

- ✓ by any interested person;
- ✓ upon the expiration of the aforesaid three years;
- ✓ provided that the trademark has not been used before such request was filed.

Basic Marks: Possible Strategies for an Applicant

TEFLON *and* ТЕФЛОН

- Variants of trademarks owned by one holder
- The use of a trademark in Latin script was sufficient to prove the use the variant in Cyrillic script.

Basic Marks:

Possible Strategies for an Applicant

- Alternatively, the combination of Cyrillic & Latin signs could be filed as a trademark:

MARUSYA
MARUSJA
MAROUSSIA
МАРУСЯ

Magistr
Магистр

Basic Marks: Possible Strategies for an Applicant

NOT ACCEPTABLE:

**MAPKYC
MARKUS**

vs.

*MAPKYC
MARKUS*

Thank you for your attention!

In case of any questions:

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