



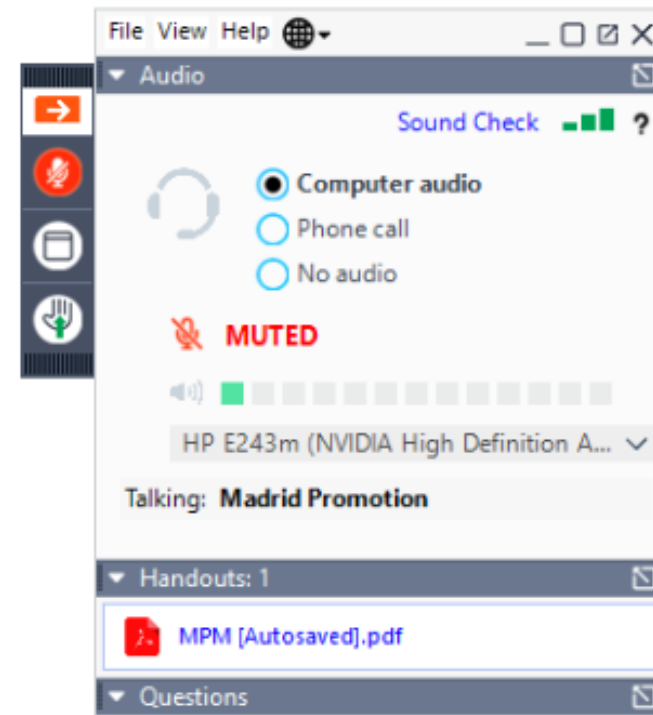
Understanding Examination and Refusal Procedures in the IP Office of Russia

Madrid System Webinar

Olga IVASHCHENKO (Ms.)
Specialist, Quality Management Department
IP Office of the Russian Federation (Rospatent)

Moscow
October 13
2020

How to use GoToWebinar



Structure of the Webinar

- Presentation: Understanding Examination and Refusal Procedures in the IP Office of Russia
- Interactive questions during the webinar
- Questions and answers session at the end
- Presentation slides available for download
- Recording will be uploaded on the [Madrid Webinar page](#)
- Short survey to provide feedback

Understanding Examination and Refusal Procedures in Russia

- General things to know
- Substantive examination
- What to do if you received a refusal

General things to know

- Russia in the Madrid Union
- Types of trademarks
- Classification of Goods & Services
- “Mild” opposition system

Russia Overview: Accession to Madrid system

- Treaty: Madrid Agreement

Entry into force: July 1, 1976

(date of accession by the Soviet Union, continued by the Russian Federation as from December 25, 1991)

- Treaty: Madrid Protocol

Entry into force: June 10, 1997

Declarations made by Russian Federation

- Declaration made under Rule 20bis(6)(b) of the Common Regulations under the Madrid Agreement and Protocol
(recording of licenses provided for in the domestic law, but the recording of licenses in the International Register has no effect)
- Notification made under Rule 27ter(2)(b) of the Common Regulations under the Madrid Agreement and Protocol
(national law does not provide for the merger of registrations of a mark)

Types of trademarks protected in Russia

- Word and Graphic marks
- Combination marks
- Three dimensional marks
- Sound marks
- Color marks
- Position marks
- Collective marks

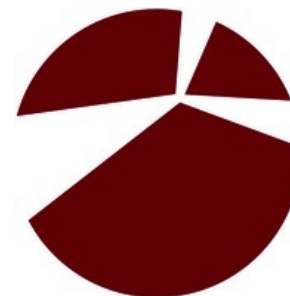
Word marks

PAREMO

ВЫМПЕЛ

SmartPack

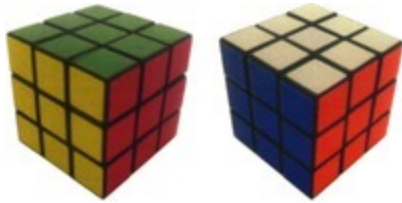
Graphic marks



Combination marks



Three dimensional marks



Sound marks



Color marks



Position marks



- Collective marks

Accepted for registration if all the supporting documentation is provided (art. 1511 of the Civil Code)

- Certification and guarantee marks

Not accepted for registration under the Russian legislation (art. 1231.1 of the Civil Code)

Classification of Goods & Services in Russia

International Classification of Goods and Services under the Nice Agreement

- No local classification system, no subclass system for trademarks
- Class heading does NOT cover the whole class

Similarity of goods and services is determined mostly by the following criteria:

- kind (family) of goods;
- function (purpose);
- material of which it is made;
- area of use and trade;
- branch of activity

Classification of Goods & Services in Russia

- Duplicates of the terms in a list are refused to draw applicant`s attention to the translation (art. 1497 of the Civil Code as technical error)
- Manager of Goods & Services
- Acceptable with no precision:

Class 35: wholesale and retail services

or

Class 09: computer programs

”Mild” opposition in Russia

- Takes place after publication
- Examiner is not obliged to agree with the arguments
- Objection can be submitted during the whole period of examination before final decision

Substantive Examination in Russia

- Grounds for refusal
- Important time limits
- Flow of the examination process
- Legislation

Absolute grounds for refusal (article 1483 of the Civil Code)

- marks are not capable of distinguishing (p.1 of art. 1483):
- have fallen into public domain (well-known definition) from the area of activity

Business Class

- generally accepted symbols and terms



- descriptive (type, quality, quantity, properties, purpose, etc.)

BIOLEATHER

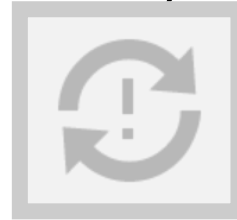
- represent the configuration of goods that is determined exclusively or mainly by the properties or purpose of the goods (p. 4)



*for classes 21 or 33

- simple numbers, letters (consonants), geometrical figures

T1



The indicated elements may be incorporated in the trademark as non-protected elements if they do not prevail (disclamation) or be registered if they have acquired the distinctiveness as the result of their use

BMW

- marks that represent state armorial bearings, flags, state symbols, logos of international organizations (p. 2 of art. 1483)



Such elements may be included in a trademark as non-protected elements provided there is consent of an appropriate competent authority

- The signs shall not be registered as trademarks that are or contain the elements (p. 3 of art. 1483):
- that are false or capable of misleading a consumer in respect of goods, services, place of manufacture or date

CHOCOLATE (for caramel)

Soll
sophie mallebranche
PARIS

kalios
— SINCE 1832 —

- that are contrary to public interests, or to principles of humanity or morality

VORTIOX

(INN: vortioxetine)

Fuck Winter

- marks that are identical or confusingly similar to the official names and images of particularly valuable objects of the cultural heritage of the peoples of the Russian Federation or objects of world cultural heritage (p.4 of art.1483)

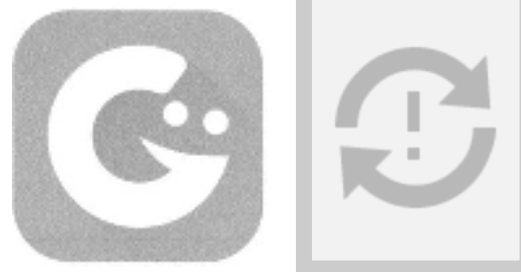


*UNESCO world heritage

Relative grounds for refusal

- marks shall not be registered as trademarks if they are identical, or confusingly similar with the trademarks of third parties with respect to similar goods with an earlier priority (p.6 of art. 1483)

ROXOL – ROKSOL – ROCKSOL



- marks that are identical or confusingly similar to a protected appellation of origin or geographical indication (p. 7 of article 1483)



- marks shall not be registered as trademarks if they are identical, or confusingly similar with the (p.9 of art. 1483):
- a title of work of science, literature, or art, a character, a work of art

One Hundred Years of Solitude

- a name, a pseudonym, a portrait of a well-known person known without the consent of this person



NAOMI CAMPBELL

- an industrial design



QUESTION

Following mark (IRN1464482) was filed from Republic of Moldova:



for the following goods in Class 33:


alcoholic beverages, except beers; alcoholic preparations for making beverages.

ON WHICH GROUND(-S) THE MARK WAS PROVISIONALLY REFUSED?

OPTIONS

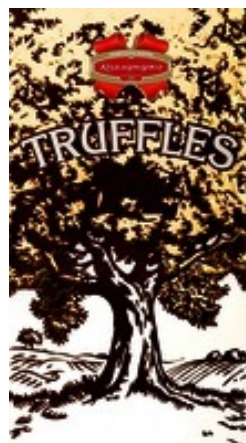
- **A.** p.4 as representing the configuration of goods that is determined exclusively by the properties of the goods
- **B.** p.3 as misleading in the respect of the applicant since French word “fondât” is not in Moldovan
- **C.** p.4 as representing the configuration of goods that is determined exclusively by purpose of the goods + p.3 as misleading in respect of the date

ANSWER

I. Office making the notification: FEDERAL SERVICE FOR INTELLECTUAL PROPERTY (ROSPATENT) 30-1, Berezhevskaya nab., 125993, Moscow, G-59, GSP-3, Russian Federation Fax: +7 (495) 531-63-53 / phone: +7 (499) 240-60-15
II. Number of the international registration: 1464482
III. Name of the holder: VINĂRIA – BARDAR S.A., întreprindere mixtă, fabrică de vinuri
IV. Reproduction of the mark: 
V. Provisional refusal based on an ex officio examination
VI. TOTAL provisional refusal concerning ALL the goods and/or services
VII. Grounds for refusal <p>Absolute grounds: 1. The designation contains the date “1929” which can be false or capable of misleading the consumer concerning the time of manufacture or sale of the claimed goods due non receipt by designated Office documents confirming the holder's right to use this date in the designation as production date of the goods. 2. The designation that applies for trademark registration is devoid of any distinctive character because it represents a form of bottle that is defined exclusively or mainly by the properties or intended purpose of the goods.</p> <p>Disclaimer required for the following element or elements of the mark that are not protectable: 1929, FONDAT.</p> <p>N.B. A disclaimer states that the owner will not claim exclusive rights to the specified element or elements that are not protectable in the mark apart from the mark as a whole. A</p>

QUESTION

Following mark (IRN1449915) was filed from Belarus:



for the following goods in Class 30:

Cocoa; confectionery; waffles; confectionery for decorating Christmas trees; pastries; peanut confectionery; almond confectionery; caramels; sweetmeats; liquorice [confectionery]; peppermint sweets; crackers; candy; cocoa beverages with milk; chocolate beverages with milk; chocolate-based beverages; cocoa-based beverages; pastilles [confectionery]; cookies; fondants [confectionery]; pralines; gingerbread; cake powder; sugar confectionery; cakes; tarts; halvah; chocolate.

ON WHICH GROUND(-S) THE MARK WAS PROVISIONALLY REFUSED?


OPTIONS

- **A.** p.7 as identical to a protected appellation of origin
- **B.** p.1 as descriptive for a certain part of goods + p.3 as misleading in the respect of another part
- **C.** p.3 as misleading in the respect of the applicant since English word “truffles” is not in Belarusian

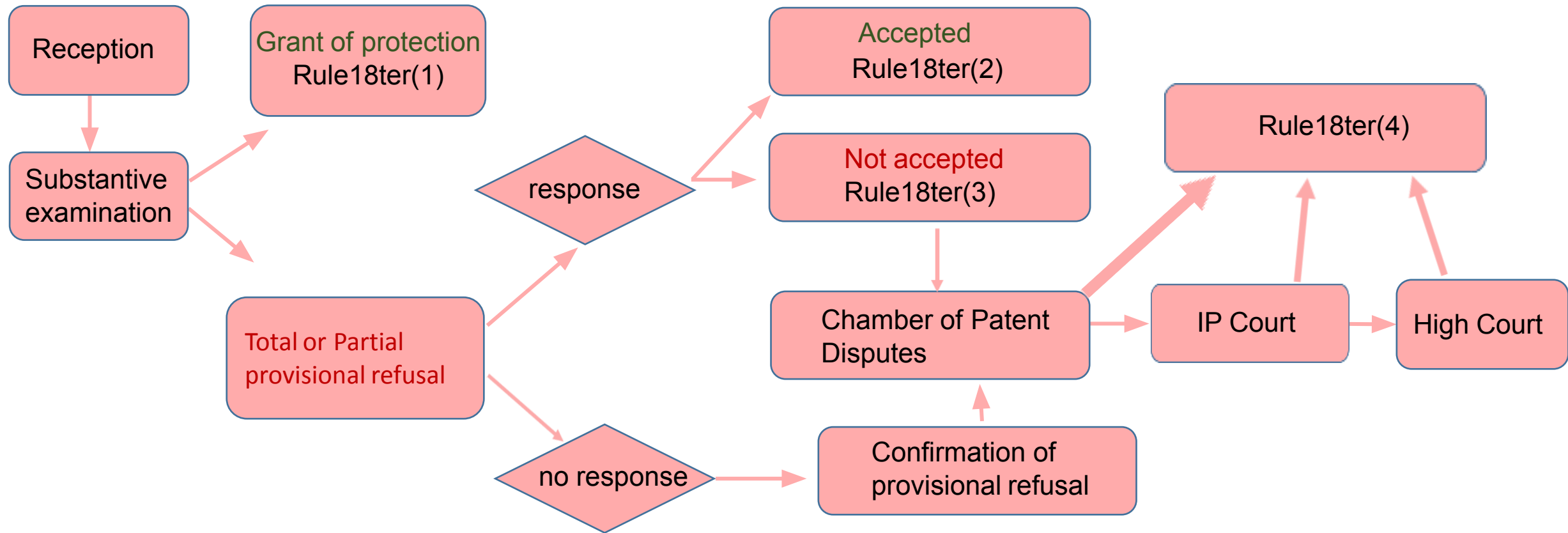
ANSWER

PROVISIONAL REFUSAL OF PROTECTION

Rule 17(1)

I. Office making the notification: FEDERAL SERVICE FOR INTELLECTUAL PROPERTY (ROSPATENT) 30-1, Berezhkovskaya nab., 125993, Moscow, G-59, GSP-3, Russian Federation Fax: +7 (495) 531-63-53 / phone: +7 (499) 240-60-15
II. Number of the international registration: 1449915
III. Name of the holder: Joint Venture Joint-Stock Company "Kommunarka"
IV. Reproduction of the mark: 
V. Provisional refusal based on an ex officio examination
VI. TOTAL provisional refusal concerning ALL the goods and/or services
VII. Grounds for refusal Absolute grounds: The word "TRUFFLES" of the designation that is applied for trademark registration is the indication a kind of goods of a certain type (namely, it's a type of chocolate confectionery, traditionally made with a chocolate ganache centre coated in chocolate, cocoa powder or chopped toasted nuts), so it is a false indication of the type and properties for all goods that are declared in the list.

Flow of trademark registration procedure in Russia



Important time limits

- **12 months**

from IB notification date - sending a notification of provisional refusal or granting decision

- **6 months**

from issuance of refusal - preparation and submitting response to the provisional refusal

- **10 years**

from filing date - period of validity, unlimitedly renewable

- **3 years**

from registration date - after expiration of this period the trademark can be cancelled due to non-use (no declaration of use is required)

Legislation

- Civil Code – part IV (intellectual property)
- Common Regulations under the Madrid Agreement concerning the international registration of marks and the Protocol relating to that Agreement

How to avoid a refusal

- consider the absolute grounds
- preliminary search to avoid refusals under the relative grounds
- make sure names and addresses of the applicant are the same
- make sure you do not have identical registration already
- if you have a date in a mark make sure you can prove the use

What to do if you received a refusal from Russia



Step 1: read the document you received

MADRID AGREEMENT AND PROTOCOL
PROVISIONAL REFUSAL OF PROTECTION

Rule 17(1)

I. Office making the notification: FEDERAL SERVICE FOR INTELLECTUAL PROPERTY (ROSPATENT) 30-1, Berezhevskaya nab., 125993, Moscow, G-59, GSP-3, Russian Federation Fax: +7 (495) 531-63-53 / phone: +7 (499) 240-60-15
II. Number of the international registration: 1489766
III. Name of the holder: MODERN MEADOW, INC.
IV. Reproduction of the mark: BIOLEATHER

V. Provisional refusal based on an ex officio examination

VI. **TOTAL** provisional refusal concerning **ALL** the goods and/or services

VII. Grounds for refusal

Absolute grounds: **The designation "BIOLEATHER" that is applied for trademark registration is devoid of any distinctive character, because it is a sign or an indication which may serve, in trade, to indicate the kind, properties and/or composition of the goods that are claimed in the list.**

VIII. Corresponding essential provisions of the applicable law [(see text under XII and Annex 1)]:

ARRANGEMENT ET PROTOCOLE DE MADRID

Page 2 of 5

1483 (1)(3).

IX. Information relating to subsequent procedure:

(i) TIME LIMIT for submitting your response and requesting review: **SIX (6) MONTHS** from the date of the notification of provisional refusal indicated under X. Please note that the extension of the time period established for response is NOT permitted.

(ii) Authority to which such request for review or appeal should be made: **Federal Service for Intellectual Property (ROSPATENT)**

(iii) Indications concerning the appointment of a representative:

Under Article 1247 of Part IV of the Civil Code of the Russian Federation “citizens permanently residing out of the territory of the Russian Federation and foreign legal entities shall exercise proceedings with the federal executive authority for the intellectual property through **patent attorneys**, registered by this federal authority, unless otherwise provided for by an international treaty of the Russian Federation”.

Information Search for Russian Patent Attorneys: http://www.fips.ru/sitedocs/patpov_en.htm

X. Date of the notification of provisional refusal: **24/03/2020**

XI. Signature of the Office making the notification:



Prokof'eva Natal'ja Petrovna

XII. Corresponding essential provisions of the applicable law:

Civil Code of the Russian Federation (as amended up to Federal Law No. 35-FZ of March 12, 2014)

(for excerpts see Annex 1)

Annex 1

**Civil code of the Russian Federation
(excerpts)**

WIPO | MADRID
The International
Trademark System

Step 2: find a trademark attorney

<https://rospatent.gov.ru/ru/patent-attorneys/search>

Step 3: pay the services (no official fees)

Ways to overcome a refusal

- Filing written arguments
- Removing the earlier obstacles (cancellation; shorten the list)
- Submitting the Letter of Consent
- Considering double registration
- Submitting the evidence of distinctiveness acquired through use

But, at the end....

...find a representative & pay



Resources

- Rospatent website

<https://rospatent.gov.ru/en/>

- Civil Code of Russia (part IV, English)

<https://www.wipo.int/edocs/lexdocs/laws/en/ru/ru004en-part4.pdf>

- Russia Overview on WIPO website

https://www.wipo.int/directory/en/details.jsp?country_code=RU

- Madrid Goods & Services Manager

<https://webaccess.wipo.int/mgs/index.jsp?lang=en>



Q&A Session about the Webinar

Olga Ivashchenko (Ms.)
Specialist, Quality Management Department
IP Office of the Russian Federation (Rospatent)

Keep Updated on the Madrid System

- Visit the [Madrid Website](#)
- Access [Madrid Webinars](#) records and stay tuned for new topics
- Play our [Madrid “How-to” videos](#)
- Subscribe to [Madrid Notices](#)
- Contact us: [Contact Madrid](#)



THANK YOU
FOR YOUR ATTENTION!