Additional comments on document SCT/22/2 concerning "Grounds for refusal of all types of marks"

Taking into account the discussion of document SCT/22/2 at the Twenty-Second Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (hereinafter the Standing Committee), the document should be revised for discussion at the Twenty-Third Session of the Standing Committee in relation to the following issues.

The Russian Federation has analyzed the document and encloses its comments and proposals.

1. The example cited in paragraph 11 of the above document relating to the olfactory mark "the scent of bubble gum" for motor oils should be deleted or replaced. The actual wording "the scent of bubble gum" is undefined, does not give the perception of a trademark and, as a result, a trademark characterized in this way does not have distinguishing capacity. Such a designation would not be registered as a trademark in the Russian Federation on the above grounds.

2. Paragraphs 13 and 14 of the document should be illustrated with an example. As an example, we propose the following. Two designations were proposed for registration.

a.

b.

Registration of the above designations was refused owing to the fact that they were unintelligible and, as a result, did not possess distinguishing capacity. It should be noted that each of the above designations is one of the parts of the dissected horizontal word "айсберг" ("iceberg"), written in the original script. However, the conjecture by an examiner, comparing the two designations, did not change the conclusion concerning the fact that each of these designations lacked distinguishing capacity.

3. Paragraph 42 should be supplemented with the following example: in the Russian Federation the designation “business-lunch” was claimed as a trademark for “poison” goods. Registration of the mark was refused owing to the likelihood that consumers would be misled regarding the purpose of the goods.

4. As it is presented, the example cited in paragraph 43 does not illustrate the text of the paragraph in question. Rather, the given example should be included in paragraph 41 of the document, i.e. among “scandalous trademarks”.

5. Paragraph 43 of the document should be supplemented with the following example. A combined designation was claimed for registration as a trademark, consisting of the verbal element “Кижский бальзам” (“Kizha balsam”) and a depiction of the architectural construction representing the subject of the “Кижский погост” (“Kizha churchyard”), which is one of the Russian cultural and natural objects included in the UNESCO World Heritage List. During the process of prosecuting the above application, the applicant received notification of the need to provide the consent of the appropriate competent authority for registration, as a trademark, of a designation similar to an object of national cultural heritage. Since the relevant consent was not provided, registration was refused for the designation in question on the above grounds.

6. The information provided in paragraph 43 can be illustrated by the following example. The designation “MIRONOVKA” was claimed for registration as a trademark, as a derivative of the surname of the President of the Federation Council of the Federal Assembly of the Russian Federation – Sergey

Mikhailovich Mironov, and also the designation “MEDVEDEVKA”, as a derivative of the surname of the President of the Russian Federation – Dmitriy Anatol’evich Medvedev. The above designations were not registered as trademarks, since registration of that kind is contrary to public interests (it may harm the image and interests of the State).

7. In paragraph 52, it should be pointed out that the grounds usually given for refusal should not be refuted on account of acquired distinguishing capacity. Despite the rule in question, there are exceptions: when the form of a good (in the proposed example – a fridge cupboard) contains one original element – a front panel which is not functional. A trademark is a naturalistic depiction of a good (fridge cupboard into whose doors air bubbles move in transparent liquid) with an original non-functional element, which also allows it to be registered as a trademark.

8. As presented, an example with the trademark “Lady Di” does not illustrate paragraph 56 of the document. The example in question should be transferred to paragraph 65 of the document.

9. We propose illustrating paragraph 56 of the document with an example of two combined designations, containing the verbal elements “Янтарь” (“Amber”) and “Дружба” (“Friendship”) in relation to the good “сыр плавленый” (“processed cheese”).

The designations in question were used by many independent producers to mark the above good for a long period of time, which led to them being used universally to designate goods of a specific type, i.e. “processed cheeses” of a particular taste. Subsequently, one of the producers submitted the combined designations containing the verbal elements “Янтарь” and “Дружба” for registration as trademarks. Since at the time the examination was carried out, the examiner did not have information on the actual use of these designations on the market, they were registered as trademarks. At a later date, the parties concerned made a request to the anti-monopoly authority for recognition as invalid of the provision of legal protection for the above trademarks, since the actions of the rights owner relating to registration restricted the possibility for use by other producers of designations containing the verbal elements “Янтарь” and “Дружба” in relation to “processed cheeses”, and therefore constitute acts of unfair competition. The anti-monopoly authority recognized the actions of the rights owner as unfair competition and the provision of legal protection for the trademarks was recognized as invalid.