

DE BERTI ■ JACCHIA

De Berti Jacchia Franchini Forlani
studio legale

Atypical Trademarks in Russia

Olesya Nalimova

1. The Russian legislation allows registration of atypical trademarks, meaning trademarks other than word, device and shape, and provides for certain technical rules for the filing of applications. So far, atypical registrations in Russia have consisted of rare examples of sound, light, holographic, position, motion and single colour or combination of colours trademarks. Registration of the more exotic taste and smell trademarks, never took place and remained an unexplored challenge.

The main legislative act on IP, the RF Civil Code (Part 4), art. 1482 on “Kinds of Trademarks”, does not expressly mention atypical trademarks, but rather provides for a broad and open rule: “word, figurative, shape and *other designations* and their combinations can be registered as trademarks”.

The Regulations on drafting, filing and examining trademark applications¹ (“Regulations”) define *other designations* through an exhaustive list comprising sound, light, motion, holographic, tactile, position, olfactory and taste designations, and designations only consisting of a single color or several colors. The Regulations furthermore provide for technical requirements for each kind of *other designations* and entitle the Trademark Authority (Rospatent) to request additional materials from the applicant in case of insufficiency of the “characteristics that allow defining a trademark in the RF Trademark State Register” and “if the materials presented by the applicant do not sufficiently reflect the particular features of the designation”.

Most atypical designations, due to their inherent characteristics, would be considered non-distinctive and, therefore, as a general rule, excluded from registration, unless they acquired distinctiveness as a result of their use (RF Civil Code, art. 1483). The Regulations specify that the applicant should prove that “the designation was perceived by consumers as a designation intended to individualize goods of a particular producer before the filing date”.

Below, we will give a closer look at trademarks consisting of a single colour or several colours and sound trademarks, which are presently the most common among atypical registrations in Russia, and will also address the less successful attempt to secure olfactory registrations.

2. From the point of view of technical representation, ***trademarks only consisting of a single colour or several colours*** (“colour trademark”) are the simplest among atypical trademarks. Like in other jurisdictions, the description of a colour designation should be accompanied by a code of an international colour

¹ Full title: “Regulations on drafting, filing and examining documents which constitute grounds for legally significant activities on the State registration of trademarks, service marks and collective marks. Requirements for documents contained in an application to the State registration of trademarks, service marks and collective marks, and documents attached to them and their forms. Procedure for transformation of an application for the State registration of a collective mark to the State registration of a trademark, service mark and vice versa. List of data indicated in a form of a trademark (service mark) certificate, form of a collective mark certificate, and forms of a trademark (service mark) certificate and a form of a collective mark”, established by Decree no. 482 of the RF Ministry of Economic Development of 20.07.2015

identification system chosen by the applicant. However, the distinctiveness test would be stricter than ordinary, as the colour designation should demonstrate a quite high level of notoriety among Russian consumers. Practise shows that the application of a colour to a particular part of a product, in other words, combining a colour and a position in a trademark, in some cases improves the distinctiveness of the designation and the chances for registration.

A classic example is the registration of Christian LOUBOUTIN's red colour (Pantone number 18.1663TP) applied to the sole of a shoe (IR 1031242) for ladies footwear. As a result of the substantive examination, the Rospatent rejected the application based on lack of distinctiveness and explained that "a colour or colour combination of a shoe cannot be subject of an exclusive right, and should be capable of free use by all shoes manufacturers". The Chamber for Patent Disputes ("the Chamber"), however, upon opposition by the applicant, quashed the decision and granted protection to the trademark (2012). The Chamber observed that the red color of the sole was not functional and amounted to a feature of design and, therefore, securing the exclusive right to use such color by one manufacturer would not affect the interests of other manufacturers of ladies footwear. The Chamber held, based on extensive materials presented by the applicant, that the red shoe sole was recognizable by Russian consumers as a distinctive attribute of LOUBOUTIN's ladies footwear which is well-known and popular in Russia. The applicant presented, among other evidence, the results of a nation-wide survey, copies of publications and advertising in Russian fashion magazines, statistics of the company's website visits, number of followers in social media, letters from Russian publishing houses and international fashion experts, sale volumes in Russia, information on anti-counterfeit measures in Russia, and many other.

Similarly, registration IR 883509 representing a combination of green and yellow colors for agricultural and forestry machinery, where the green color (Munsell 9.47 GY3.57/7.45) was applied to the vehicle and the yellow color (Munsell 5.06 Y7.63/10.66) to the wheels, in the name of Deere & Company, was at first rejected by the Rospatent and subsequently granted by decision of the Chamber (2009). The Rospatent had concluded that the designation was not distinctive as "it was solely comprised of a combination of two colors not forming any composition that could supply a new perception different from the perception of its comprising elements separately, and was not original or fanciful". The applicant, like in the previous case, presented exhaustive evidence of the long-term and extensive use of the green and yellow colors for professional machinery that became its distinctive feature on the market and resulted in creating an association in the Russian consumer's mind between an agricultural machine made up of a green vehicle and yellow wheels and the applicant.

Other examples of Russian color registrations include a pink colour trademark (no. 310048) for bleaching and cleaning agents in the name of Reckitt Benckiser, producer of "Vanish", a blue colour trademark (no. 561631) for a wide range of goods and services in connection with oil and gas industry in the name of Gazprom, and a green colour trademark (no. 556088) for bank services in the name of Sberbank.

On the contrary, the Chamber upheld the Rospatent's refusal to register a pink colour (Pantone 677 C, edition 2010) for medical implants in the name of CeramTec GmbH, IR 1109076 (2014), stating that a pink color cannot serve as a trademark, and the applicant had failed to prove that the color had acquired distinctiveness with respect to the product, as the applicant only presented declarations that could not be considered evidence of acquired distinctiveness.

3. The largest number of registrations for atypical trademarks in Russia is that of **sound trademarks**. There are sixty-six national sound registrations at present. It is significant that the national online trademark search request form contains a separate field for sound marks, the only one for atypical registrations (there is a field for a shape or dimensional trademarks but, in the same way as in the European Union, they are not considered "other trademarks" by Russian legislation).

The main challenge of a sound registration is its identification and fixation. An overall glance at the list of existing registrations shows that the practice for presenting a sound trademark has varied since the first registration in 2002. Some registrations contain only a digital sound recording sample, other only a musical notation² or spectrogram³, and some have both. A few registrations additionally provide a word description of notes and accents. The Regulations (2015) require that all of the above should be presented, a sound recording sample on a digital media, description of a sound(s) or their characteristics, along with a musical notation for a melody (music work) or a spectrogram for a sound produced by a living creature or object. Nevertheless, legal commentators still express concern with regard to the precise identification of sound trademarks through each of the above technical means. The problem with a musical notation is that the melody will sound differently where performed by different instruments or human voices, whilst a phonogram cannot be reproduced in the State Register nor attached to the trademark certificate.

High standards of acquired distinctiveness are also imposed on sounds. There is an opinion that only a serious advertising campaign may result in the recognition of a sound designation being capable of individualizing a product. For instance, sound registration no. 361468 for advertising slogan "Das ist Thomas" of the vacuum cleaner manufacturer Robert Thomas, became renowned and immediately associated with the vacuum cleaners originating from the German producer in the mind of Russians consumer through frequent TV commercials.

This, however, would not be the case for sound trademarks in movie, broadcasting or media industries that may naturally reach wide audiences in the process of rendering their services. Examples of such trademarks are national

² **Musical notation** is any system used to visually represent aurally perceived music played with instruments or sung by the human voice through the use of written, printed, or otherwise-produced symbols (https://en.wikipedia.org/wiki/Musical_notation).

³ **Spectrogram** is a visual representation of the spectrum of frequencies of sounds or other signal as they vary with time or some other variable (<https://en.wikipedia.org/wiki/Spectrogram>).

registrations no. 213565 for a radio “Chanson” ringtone in the name of Regional Radiochannel, and no. 625790 for the world famous Twentieth Century Fox ringtone. Curiously, these are, respectively, the oldest and the newest sound registrations in Russia.

4. There are no registered **olfactory or taste trademarks** in Russia at present. However, Russian legislation made an attempt to define the technical requirements for filing smell and taste trademarks. The Regulations prescribe that “olfactory and taste designations should be characterized clearly and fully in a way that should be sufficient for objective identification of a trademark in the RF Trademark State Register in order to avoid relativity in the process of identification, and for perception of such trademark without the need for samples”. The applicant should submit a word description of the smell or taste and their “precise and clear characteristics”, including a description of the composition, chemical formula, and other information that, in the applicant’s view, would produce the fullest and objective record of the scope of protection. In case of an olfactory designation, the applicant should present the smell characteristics, as well as a composition or chemical formula characterizing the source of smell.

A trademark application for the smell of “freshly chopped garlic” (no. 2011705919) filed by a Russian private entrepreneur for goods of 03, 29, 30 and 32 classes was accepted by the Rospatent with a simple word description “garlic smell” and an accompanying letter (content unknown). However, the application was later rejected as a result of substantive examination on the grounds that the smell of freshly chopped garlic was not distinctive for certain goods of classes 29 and 30, as it indicated their qualities and composition, but was capable of misleading the consumer with respect to the rest of the goods. The Chamber upheld the Rospatent’s decision and concluded that a smell is an inherent quality of goods belonging to classes 03, 29, 30, 32 and characterizes these goods. Therefore, a smell designation was not distinctive for such goods, as it was perceived as one of their feature, namely their smell. On the one hand, a smell of garlic was widespread and traditional for certain goods (meat, vegetables, snacks), but on the other hand, for other goods (dairy, coffee, sugar) it was not typical and would mislead the consumer.

5. The above examples of atypical registrations and attempts of obtaining registration for non-standard designations show that the future practice will need to focus on establishing more advanced technical means and guidelines for representing and fixing sound, taste and smell trademarks. Moreover, a distinctiveness test should be elaborated with respect to each category of atypical trademarks. The (hopefully) increasing number of non-standard registrations will bring a new challenge to the definition of similarity. Should it be based on a pure perception by human sense? Then, two sound designations could be found confusingly similar if perceived consonant despite of the difference between their musical notations. Or, should a more formal and objective approach apply, where olfactory trademarks are compared by their chemical formulas despite of similarity in their perception? In any event, it is likely that, with the advance of technical progress, more complex solutions will be developed, according to logics other than those of the mere comparison between standard, word and device, trademarks.