

## Distinctiveness of Trademarks: the latest trends and developments in Russia.

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**In Russia, as in other jurisdictions, distinctiveness is a key registrability criterion that a trademark must meet in order to get registered. Russian law states that a designation will be refused protection if it lacks distinctive character.**

As a general rule, a designation should be considered as being devoid of distinctiveness if it represents itself as a simple letter, simple non-stylised combinations of letters that are not perceived as words, simple geometrical figures or lines or combinations thereof that do not form a composition having a completely different level of perception as compared with that of the figures or lines if viewed separately. Also, non-protected are those designations that bear descriptive character, especially descriptive signs that denote nature, properties, purpose and other characteristics of goods.

As regards non-traditional marks such as shape/design marks, Russian law makes it clear that a designation featuring the shape/design of a product or its packaging shall not be allowed to proceed to grant if the shape is a functional one, in particular, if it is exclusively or predominantly due to the properties and purpose of goods. Russian law further asserts that realistic depictions of products are deemed non-distinctive if these are applied for registration with respect to those products.

The law, however, provides for some exceptions from those strict requirements. In particular, it states that inherently non-distinctive signs can still be granted protection if they have acquired necessary distinctiveness through intensive use on the Russian market.

The acquired distinctiveness is to be proved and confirmed with documents to enable the brand owner to rely on the respective claims when arguing the

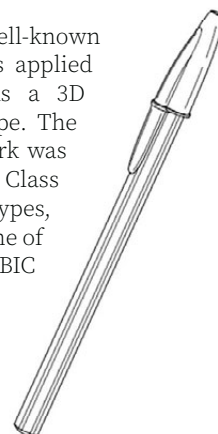
**“The documents submitted by the brand owner are to be considered in the aggregate and, when examined entirely, should give an idea as to the scale and intensiveness of use of the mark as applied”**

protectability of its mark for registration purposes. Under official regulations adopted in Russia, the documents that could be filed in support of the acquired distinctiveness should disclose factual information as to the scale and length of use of the mark that is sought to be protected, in particular information as to the territory of sale of the branded goods, turnover and sales figures attributed to the applied goods, brand awareness information including survey results, media publication and promotional materials and others. The documents submitted by the brand owner are to be considered in the aggregate and, when examined entirely, should give an idea as to the scale and intensiveness of use of the mark as applied, especially on the Russian market before the priority date. The documents are to be taken into account if they clearly demonstrate that the mark is perceived by consumers as a means of individualisation of a particular trader.

The current practice in Russia suggests that proving distinctiveness is a complex task. In some cases, even a stainless global reputation, goodwill, and awareness associated with the mark alone may not suffice to persuade authorities that the mark has gained secondary meaning in the local market.

One of the recent trademark cases perfectly illustrates the complexity of the task and shows the current trends crystallised in the Russian practice.

The case concerns a well-known design of a BIC pen that was applied for registration in Russia as a 3D mark featuring the pen's shape. The application to register the mark was filed in respect of goods in Class 16, namely pens of different types, especially ball pens, in the name of the French stationary maker BIC S.A.



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Upon examination, the application was refused protection due to non-distinctiveness. In particular, the examining attorney concluded that the mark was a realistic depiction of a product and was intended to be used on such a product. Moreover, it was stated that the mark featured a shape of the product that was allegedly quite traditional for the market due to its functional nature.

The applicant appealed against the refusal decision based on the acquired distinctiveness claim. The applicant, in particular, referred to the history of the brand owner and the brand itself, drawing attention to the fact that the company was founded in 1945 and that in 1950, a ball pen was invented and introduced on the global market under the brand name BIC CRYSTAL. Sometime later, the pen became increasingly popular worldwide, with annual sales reaching approximately 500 million items and holding roughly 60% share of the pen market. By 2006, the BIC CRYSTAL pen was declared the top-selling pen in history, with the total number of sold items being 100 billion. The appeal further stated that the unique BIC CRYSTAL design of the pen was repeatedly recognised by the NY Museum of Modern Art, where one of the ball pens is constantly displayed as an exhibit.

As regards the local market, it was mentioned in the appeal that the sale of the BIC CRYSTAL branded pens commenced as early as the 1960s, and over recent years, the pen was intensively promoted in Russia through various trade channels, including the largest retail chains (such as Metro, Cash&Carry, Auchan, O’Key hypermarkets) as well as different marketplaces operating in Russia. The applicant further claimed that it was sponsoring promotional events in Russia and that the applied designation became quite famous in Russia because of the very active trading activities. In support of the claims, the applicant produced an affidavit, various promotional materials, shipment documents, and opinion poll results demonstrating high awareness and recognition among consumers in Russia.

Despite the large amount of evidence submitted, the appeal authorities did not find it persuasive enough to overturn the refusal.

First of all, the Board insisted that the shape of the pen was quite traditional for the market as it contained the main constructive elements specific to such kind of goods (faceted body, cap and protective cover) that looked quite similar to those used by other traders. In support of its arguments, the Board referred to the existing pen designs of other traders.

This fact made the Board believe that the proposed shape was more or less functional and inherently non-distinctive due to the lack of original decorative elements that could make it sufficiently distinguishable from third parties’ pen shapes represented on the market.

On the other hand, the evidence of acquired distinctiveness submitted by the applicant was disregarded by the Board as it related to the mark that was essentially different from the applied one in that it was used in combination with additional distinctive elements such as the words BIC CRYSTAL or BIC logo that was not part of the applied designation. Further, according to the Board, some of the sales figures referred to in the appeal were not confirmed by documents (e.g. sale and purchase contracts, advertising agreements, etc.), whereas some of the documents mentioned third-party companies as a consignor, although no documents to confirm the relationship between the applicant and the third parties were produced.

Finally, the Board made it clear that, given the lack of factual proof of the use of the mark as applied, the poll results, even though favourable overall, could not change the Board’s opinion that the mark was not entitled to protection as being devoid of distinctiveness.

This case allows us to make the following conclusions.

1. The registrability requirements are the same for both traditional and non-traditional marks, such as shape marks.
2. The evidence of acquired distinctiveness should relate to the mark as applied without additional elements. Before the priority date, it must demonstrate intensive and long-standing use in the local market.
3. If the mark is promoted on the local market by related/affiliated companies or third-party contractors, then the respective evidence attesting to the relationship between all the parties involved in the supply chain should be submitted.
4. The evidence submitted is considered in the aggregate, and different types of evidence used in defence should correspond. As such, the poll results, even though favourable, may not prove sufficient to argue acquired distinctiveness if there is a shortage of factual use evidence.



Another interesting case from the recent practice worth highlighting is the one related to a combined mark featuring some non-distinctive elements, such as the state flag and descriptive text.



The mark was applied for registration with respect to cheese in Class 29 in the name of Savencia S.A. (France) and, as a result of the examination, was refused protection due to lack of distinctiveness. In particular, the PTO found the mark to be non-distinctive based on the fact that the non-protected elements of the mark, such as descriptive signs denoting specific types and properties of goods, allegedly dominated the mark, making the mark non-distinctive as a whole. Also, the examining attorney insisted that the applicant should submit permission from a competent body to use a depiction imitating the state French flag as part of the mark.

In an attempt to dispute the refusal decision, the applicant agreed with the Registry's position in that certain elements of the mark, especially the words elements "French Soft Cheese" in Russian, "Incredible Cream Taste" in Russian and the word SUPREME on its own, might in fact be non-distinctive. In the meantime, the applicant was of the opinion that the mark if viewed as a whole, was quite distinctive because of the unique composition and colouristic solution, as well as stylisation, utilised in respect of an eye-catching word element SUPREME. The applicant further argued that it was in a position to delete the graphic element that imitated the state symbol of France and requested the respective amendments to the mark.

However, the appeal was unsuccessful, and the Registry left the refusal in force. The refusal decision could still be subject to a further appeal with the IP Court, and the applicant made a further attempt to have the refusal decision overturned to pave the way for the mark to proceed to grant.

In the first instance, the Court satisfied the appeal and obliged the PTO to have the mark registered. In finding the mark registrable as a whole, the Court referred to the fact that the applied designation was a label that featured original graphic composition due to the oval-shaped form, unique combination of elements, usage of distinctive stylisation and colouristic solutions that all together contributed to the distinctiveness

of the mark. The Court also considered that the applicant owned exclusive rights in and to the word mark SUPREME in Russian transliteration. That said, the mark was found distinctive as a whole, and no disclaimer requirement was issued.

However, that was not a "happy end" in the proceedings, and the case went further to the Cassation Court, where the favourable decision was totally annulled and returned to the lower court instance for reconsideration. The annulment resolution was motivated by the fact that the first instance Court did not pay due attention to the possible perception of the mark when used on the applied goods by the respective consumers, nor did it analyse the elements incorporated by the label to establish which one of them was distinctive or descriptive and which elements were dominating. Also, the Cassation Court insisted that it was not clear whether the non-distinctive elements, when viewed as a whole, formed a graphically unique composition with a completely different perception level.

This case shows that label marks may face serious non-distinctiveness objections as the non-protected elements (such as descriptive signs) that are quite common and specific for the labels may be deemed dominating. If so, the main issue is to understand whether such elements, although descriptive in their nature, when put together, form a composition that is perceived differently by consumers as compared with those elements if viewed individually.

**Overall, the distinctiveness issue is one of the key criteria for establishing the registrability.**

**The distinctiveness may be inherent or acquired. The inherent one may not be obvious in many cases, and additional analysis may be necessary. The acquired distinctiveness requires persuasive proof of intensive use, which may be a difficult task.**

**Nevertheless, it appears that the basic principles and legal approaches that have been worked out in practice have remained unchanged for a long time, which makes the outcome in such cases quite predictable in accordance with the legal expectation doctrine.**

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