

HOW TO REGISTER A TRADEMARK: LIFE HACKS AND PITFALLS

Starting from June 29, 2023, any individual can register a trademark in their name, thanks to recent amendments to the Russian Civil Code.



A trademark (TM) is a designation that helps to individualize goods and services on the market and distinguish them from the others



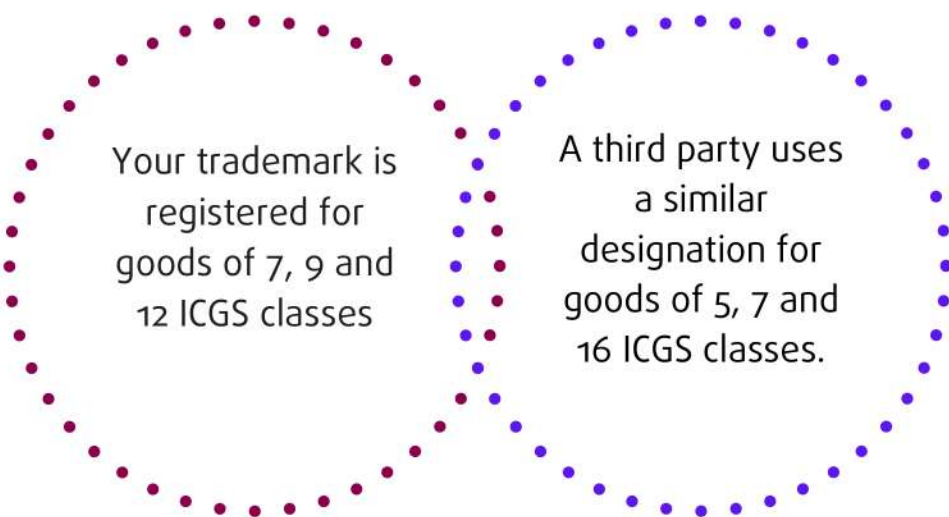
A trademark owner holds an exclusive right to the trademark



No one can use the designation to individualize their goods and services without the trademark owner's consent

BUT!

No absolute monopoly for the trademark owner – the designation is registered only for certain goods and services divided by classes in accordance with the International Classification of Goods and Services (ICGS or the Nice Classification, NCL)



The third party cannot use a designation identical or confusingly similar to your trademark for goods of 7 ICGS class (machines, engines) and goods of the same kind.

For example, the following goods of different ICGS classes may be treated as being of the same kind:

- “baby food” (5 ICGS class) and “dairy products” (29 ICGS class) as well as “milk porridges” (30 ICGS class);
- “bread for diabetics” (5 ICGS class) and “bread” (30 ICGS class).

If you want to actively promote your brand, protect your business from unfair copying, have an effective legal instrument against competitors, then registration of a trademark would be an excellent solution

YOU CAME UP WITH THE PERFECT DESIGNATION FOR REGISTRATION, BUT THERE IS A CATCH

The following designations are prohibited for registration in Russia (Article 1483 of the Russian Civil Code):

1 A designation is not distinctive (has become common use, is a common word, gives a direct definition of the goods)

E.g. trademark "Milk" cannot be registered for dairy products

An abbreviation can be registered if you can prove to Rospatent that consumers perceive the combination of letters as a meaningful word or that the abbreviation has become distinctive after being in use for a long time

2 The designation contains national symbols, or symbols used in names of international organizations, or symbols of official awards

Rospatent will not register a trademark with an image of the Russian flag

3 The designation is false and can mislead consumers about the goods, their manufacturer or place of production

In case SIP-1066/2020, it was established that the designation "Ognennaya voda" [Firewater] is false for wine products

4 The designation contradicts public interests and humane and moral principles

Rospatent denied registration of trademark "Dolgozhitel" [A long-lived person] for alcoholic beverages on grounds that it contradicts the public interests: alcohol can severely damage the human health

5 The designation is identical to a well-known work of science, literature or art, character or quotation, art work or its fragment, without the rightholder's consent

The registration of trademark "Spider Man" was declared invalid upon request of the rightholder, Marvel Characters Inc.

6 The designation reproduces or imitates geographical indications or appellations of origin (regional brands)



You cannot register the designation "Vologodskoye" for "butter," unless you are the owner of the appellation of origin "Vologodskoye Butter"

7 The designation is confusingly similar to third-party trademarks for which applications for registration were filed earlier

If you have been using a business designation for a long time, you should not hesitate to register a trademark – bad-faith persons could take advantage of you and register your designation earlier

TRADEMARK STATE REGISTRATION

1

Application
submission
and
registration

Article 1492 of the
Russian Civil Code

An application for registration of a trademark must contain:

- Information on the applicant and applicant's representative
- The designation for registration
- The list of goods and services (by ICGS classes) for which the trademark registration is requested
- Text description of the designation in question

Application form is published on [Rospatent's web site](#)

Up to 5 work
days

2

Formal expert
examination
of the
application

Article 1498 of the
Russian Civil Code

Rospatent verifies whether all documents have been submitted and all fees have been paid:

- For formal expert examination: RUB 3,500 + RUB 1,000 for each ICGS class for which the registration is requested in excess of 5
- For expert examination of the designation: RUB 11,500 + RUB 2,500 for each ICGS class for which the registration is requested in excess of 1

1 month

+ 3 months if
Rospatent
requests
additional
documents

3

Examination
of the
designation
on its merits

Article 1499 of the
Russian Civil Code

Rospatent verifies whether the designation in question meets legal requirements:

- The designation is distinctive
- The designation can be registered
- The designation is not identical or confusingly similar to prior third-party trademarks or applications

12 months

+2 to 8 months if
Rospatent has
notified of a
preliminary denial
of the registration

4

Trademark
state
registration

Article 1503 of the
Russian Civil Code

A fee must be paid to complete the registration:

- For trademark registration: RUB 16,000 + RUB 1,000 for each ICGS class for which the registration is requested in excess of 5
- For issue of a trademark registration certificate: RUB 2,000

2 months

!

In accordance with Rospatent's Administrative Regulations, the timeframe for state registration of a trademark constitutes 18 months and 2 weeks, but it may be increased.

●

The state registration can be expedited (to 2 to 3 months) by ordering a paid service from Rospatent (from RUB 94,400 per one trademark).

The minimum amount of fees is RUB 33,000. If an application for registration of a trademark is filed in electronic form, a 30% discount applies to all fees specified.

MY TRADEMARK HAS BEEN REGISTERED: WHAT'S NEXT?

Keep an eye on the validity term of the exclusive right to the trademark (Article 1491 of the Russian Civil Code)



The exclusive right to a trademark is valid for 10 years from the date the trademark registration application is submitted

The legal protection of a trademark can be extended for another 10 years if the rightholder submits an application for extension to Rospatent within the last year when the exclusive right is valid

Upon expiry of the indicated timeframe, the rightholder may, upon request, be granted an additional 6 months for submitting an application for extension

The exclusive right to a trademark can be extended indefinitely

The trademark must be actually used for registered goods and services (Article 1486 of the Russian Civil Code)

Legal protection of the trademark may be terminated early by court upon a claim of an interested party if:

- the trademark has not been used continuously within three years
- the rightholder refuses to enter into an agreement for alienation of exclusive rights to an interested party

MY TRADEMARK REGISTRATION HAS BEEN DENIED: WHAT'S NEXT?

- **If Rospatent notifies of a preliminary denial at the designation examination stage (Clause 3 Article 1499 of the Russian Civil Code)**

You may submit a reply to Rospatent's notice justifying your position and together with necessary documents within 6 months

E.g. if the examination finds that your designation matches a third-party's prior trademark, you can try to contact and obtain approval from the rightholder for registration of your designation

- **If the examination finds that your designation matches a third-party's prior trademark, you can try to contact and obtain approval from the rightholder for registration of your designation**

The decision on denial may be appealed to the Chamber for Patent Disputes within 4 months after the decision is made

The decision of the Chamber for Patent Disputes may be appealed to the Intellectual Property Court within 3 months after the decision is made

If you need assistance with drawing up an application for registration of a trademark or support for the registration process or appealing the denial, we would be happy to help.

HOW TO INCREASE YOUR CHANCES OF REGISTERING A TRADEMARK

Associates of CLS offer some tips to increase your chances of successful trademark registration:

1 Before you submit an application for registration, we recommend that you do preliminary search – you might want to look through open databases of registered trademarks and search for trademarks that are identical or confusingly similar to your designation

You may use free services or find specialists who have access to fee-based trademark databases



The CLS team would be happy to help you with the preliminary search

If the preliminary search reveals similar trademarks, you can:

- change your designation (e.g. add verbal elements or one-of-a-kind graphic elements)
- initiate negotiations with the rightholder of similar trademarks to obtain approval for registration of your designation

2 Composite designations have more chances than verbal designations.

If your designation is in the risk zone (e.g. if it is an abbreviation or can be recognized as a common non-distinctive word), we recommend adding visual elements – style of the word, color combinations or graphics.

! However, the verbal element in the composite designation may be deemed unprotected on grounds described in Article 1483 of the Russian Civil Code.

In such case, the composite trademark will be protected only in its graphic form as registered, and you will be unable to protect your rights to the verbal element separately from the graphic elements.



3 An application with a limited list of goods and services of ICGS classes has more chances of successful registration.

We recommend indicating in the application only the goods and services for which you will actually use the designation and do not recommend indicating all 45 ICGS classes to obtain the broadest legal protection possible.

In such event, Rospatent may find many similarities with someone else's trademarks in different ICGS classes and as a result will block registration of your designation.

**WE WILL BE HAPPY TO ANSWER YOUR
QUESTIONS AND HELP YOU WITH REGISTRATION
OF YOUR TRADEMARKS!**



ANTONINA SHISHANOVA

Head of IP practice

Practice areas:

- Intellectual Property
- IT
- Personal Data



ashishanova@cls.ru



+7 495 970 10 90
+7 812 346 79 90



VICTOR KALUZHSKI

Associate

Practice areas:

- Intellectual Property
- IT



vkaluzhski@cls.ru



+7 495 970 10 90
+7 812 346 79 90



cls.ru



cls@cls.ru



LegalRecipes