

REGISTRABILITY OF TRADEMARK CONSISTING OF SINGLE NUMBERS/LETTERS OR COMBINATIONS THEREOF. CIS PRACTICE.

[IPR GROUP]



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Everyone who is going to secure his rights to the trademark in the Russian Federation and other CIS republics, such as Tajikistan and Uzbekistan should keep in mind the provisions of the trademark law referring to non-distinctiveness of the trademarks consisting of single numbers/letters or combinations thereof, which have no verbal nature.

For instance, the Russian Trademark Law prohibits registration of designations that have no distinctive ability. Furthermore according to

subparagraph 1.1., Paragraph 2.3 of the Rules for drafting, filing and examination of an application for registration of a trademark and service mark:

“May not be registered as trademarks:

...(2.3.1) signs that have no distinctive ability, in particular designations representing letters, numbers having no specific graphic implementation or a combination of letters that have no verbal nature...”

The similar provisions are in effect in all aforesaid jurisdictions, namely, Russia, Tajikistan and Uzbekistan, while in Armenia, Azerbaijan, Belarus, Georgia, Kazakhstan, Kyrgyzstan, Moldova, Turkmenistan, Ukraine such marks are eligible for

protection if no other grounds of refusal of protection are found by the Examination and accordingly, the provisional refusal is not issued by the Trademark Office on absolute grounds.

It's worth mentioning that the marks consisting of letters/numbers or combinations thereof having no verbal nature, as a rule, could obtain protection in Russia, if the mark is implemented in a stylized manner and therefore have the required distinctiveness. We would like to mention the application for

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TM which was recently granted protection with a disclaimer of the element STUDIO in Russia in

respect of services 36, 37 and 42.

Another aspect that should be kept in mind when applying for registration of such a mark is if the sufficient use of the mark in the jurisdiction that refused the application on the ground of non-distinctiveness could be proved. Please note that according to the above cited law of Russia

“The provisions referred to in subparagraphs (2.3.2.1), (2.3.2.2), (2.3.2.3) and (2.3.2.4) of this paragraph shall not apply to signs which have acquired distinctiveness as a result of their use for particular products.

The evidences of the obtained distinctive ability shall be submitted by the applicant. Such evidences, in particular, shall include information on duration of use of the designation, the intensity of its use, etc.”

Accordingly, even if the provisional refusal was issued for the applied designation consisting of letters/numbers or combinations thereof having

no verbal nature, it is nevertheless possible to achieve trademark protection if the mark was in use in the jurisdiction, which initially refused protection.

The Examination should be provided with the evidences containing the following information:

- *Volumes of production and sales of product/scope of services, marked by the declared designation;*

- *Territories of retail of the products/offering services marked by the declared designation;*

- *Duration of use of the declared designation for marking of the goods/services indicated in the Application;*

- *Volumes of advertising expenses of the goods/services marked by the declared designation;*

- *The information about consumers' level of awareness of the declared designation and of the producer of the marked goods/ provider of the*

services, including results of sociological surveys;

- *Publications about the products/services marked by the declared designation in the public media;*

- *Information about exhibiting products/services marked by the declared designation at expo shows, etc.*

The best evidences are promotional and advertising materials (catalogues, brochures), publications in the media, information about participation in the expo shows in the relevant jurisdiction and abroad (any diplomas, awards, participation certificates etc.) invoices, delivery bills, contracts, price lists, etc.

One of the key aspects that should be kept in mind is that the evidences should be provided for the trademark in a view it was applied for registration.

We would like to mention the successful case in Russia when **IR 1034523 TM CTX** was refused by the Russian Trademark Office on the

ground of the lack of distinctiveness, however, the mark was in use in Russia and therefore, we filed an Objection supported by a solid package of evidences of trademark use in respect of Russia and the grant of protection decision followed.

We should note that sometimes if the designation is applied for a broad range of goods/services, while it is not in use in respect of all goods/services applied for, we recommend to specify the list of goods/services up to the items, for which the designation is actually used. It should be kept in mind that when it comes to the designations lacking distinctiveness the local trademark offices carefully examine the documents confirming the use of the trademark in this jurisdiction and worldwide. Protection could therefore be granted only in respect of the particular goods and services, in respect of which the sufficient use could be proved.

We would like to mention that we successfully overcame the provisional refusal issued by the Russian Trademark Office for IR 1074007 TM **VKP80III**. Under the trademark ticket printers for various applications (Self-service kiosks, ATMs & Banking machine, Gaming machine, Parking payment terminal, Vending machine, Queue management system) are offered. The mark was applied for a narrow list of goods in class 09, namely, automatic distribution machines; mechanisms and part of automatic distribution machines, namely electronic operated printers for printing receipts, sales checks and tickets; electronic operated receipts, sales checks and tickets dispensers; cash registers. Though in our Objection we mentioned that the applicant agrees to limit the goods even further, the protection was granted in respect of all applied goods with due consideration of the evidences of trademark use in Russia, the applicant was able

to provide, which were regarded by the Examiners to show sufficient use in respect of all goods applied for.

We should say some words concerning Kazakhstan practice of Examination of the trademarks consisting of letters/numbers or combinations thereof having no verbal nature. According to the paragraph 8 of the Article 6 of the Kazakh Trademark Law, which was in effect until January 31, 2012, the trademarks consisting of less than three letters and/or figures do not have a distinctive ability and therefore were not eligible for protection in this country. However, the paragraph 8 of the Article 6 prohibiting the registration of such trademarks was excluded from the Kazakh Trademark Law, due to the amendments, which entered into force starting from January 31, 2012. Accordingly, at the current moment there are no obstacles to registration of such designations in Kazakhstan.

It could be illustrated by the following case: The provisional refusal was issued for **IR 1064878 TM D3** in Kazakhstan on February 03, 2012 in respect to all applied goods. Though the refusal date was after the amended trademark law allowing registration of such marks came into force, we informed the client that at that moment we saw no chances to overcome the provisional refusal, as the application for the said trademark in the name of D3 LED, LLC was filed on **January 12, 2011** and therefore, it shall be examined in accordance with the Kazakh Trademark Law, which was in effect before January 31, 2012, as the law has no retroactive force in Kazakhstan. Accordingly, we recommended to reapply for registration of the cited trademark in Kazakhstan under national or international procedure a little bit later allowing the new examination practice to take shape. A national application for TM D3 in the name of D3 LED, LLC was filed in Kazakhstan on June 21, 2012

and the Grant of Protection decision followed on July 25, 2013.

Another example, which is illustrative of the practice of examination of trademarks consisting of letters/numbers or combinations thereof having no verbal nature in both Russia and Kazakhstan, is the **Trademark MJ IR 1043484**, which was refused protection in these countries on the ground of non-distinctiveness. Following the consultations with our company as to registrability of this mark in these jurisdictions, the applicant decided to file a national application in Russia for the trademark in a view it is used and is displayed on the applicant's website, i.e



(application date April 24, 2012), which successfully proceeded to registration on April 26, 2013. With regard to Kazakhstan the applicant opted for filing an application for a word mark **MJ**, as at that moment the new changes to Kazakhstan

Trademark law took place already, of which we informed him and the registration of such marks became possible. The application was filed in Kazakhstan on April 23, 2012, the registration date is October 15, 2013.

In our opinion, the approach to the examination of applications where no issues are raised in respect of designations consisting of single numbers/letters or combinations thereof, which have no verbal nature, is more correct and meets today's realities, because such an approach does not create obstacles to registration, and therefore it complies with the essence of the relationship between the object of rights and the reality in which it exists - a market economy tending to efficiency. Naturally less applicant's efforts for acquisition of rights due to less bureaucracy and unnecessary excessive regulatory procedures of public services (Examination), enhance the position of the right holder (s) in the market environment.

The applicant fully understands that low distinctiveness of his/her mark is not primarily in his interests, and that there is probability that the use of such a designation could activate the purely market regulation mechanism – consumers' inattention to products offered under the mark poorly performing its function, and will have the relevant consequences for the applicant. However, a lack of distinctiveness of marks consisting of several letters and/or numbers traditionally regarded as non-distinctive is questionable. The existing examples show that such combinations of letters as GMC, JVC, TWR or even LG and J7 perfectly perform the functions of a trademark and it does not impair their recognizability. Obviously the

existence and development of brand awareness concerning such marks ("life of the brand") largely depends on purely marketing actions taken by their owner – maintaining the quality of products/services, successful advertising, marketing and so forth, rather than the number of symbols the mark contains. Therefore, we assume that taking over unnecessary regulatory functions, the examination of the Trademark Offices with such a practice imposes unnecessary burden on the applicant that in principle doesn't comply with the nature of the environment of an object of right, i.e. its efficiency.

We hope our brief overview of the cases from our practice concerning the registrability of designations consisting of single numbers/letters or

combinations thereof, which have no verbal nature, would be useful and helpful for both IP practitioners and companies who are seeking to achieve protection of their brands in CIS states – not yet highly developed but one of the most promising markets. We would be glad to offer our professional advice regarding each particular case and services for any IP matters in ***Ukraine, Russia, Belarus, Georgia, Armenia, Azerbaijan, Kazakhstan, Kyrgyzstan, Tajikistan, Turkmenistan, Uzbekistan, Moldova.***



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2011 – Joined the IPR Group. Holds the position of Trademark Administrator. Her particular specialization within IP is management of trademark cases, including preparing trademark applications, trademark renewal applications; trademark assignment and licensing; negotiating the letters of consent and co-existence agreements; liaison with local company offices. During the carrier, managed a lot of trademark cases, Victoria has obtained hundreds of LoC, as well reached and drafted Coexistence Agreements on behalf of the clients.

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