

HOW MAKE YOUR TRADEMARK STRONG IN TERMS OF NON-DECEPTIVENESS (CIS PRACTICE)

[IPR GROUP]



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Those who are concerned about efficient protection of their brands in the CIS region shall keep in mind that one of grounds for the refusal in granting protection to a trademark in these jurisdictions, and most common ground in some of them like, for instance, Russia, could be trademark deceptiveness, i.e. its misleading character of the applied designation as to the origin of the applied goods/services, goods/services manufacturer, etc.

For the purposes of avoiding any potential risks of refusal of your trademark application on the aforesaid ground, we would like to give a brief overview of the trademark deceptiveness criteria illustrated by the cases from our practice concerning

both international and national trademark registrations.

- *Deceptiveness/misleading character of a trademark as to the origin of the applied goods/services:*

We would like to mention one of the cases vividly illustrating such a ground of the refusal.

The total provisional refusal was issued for **IR 1144607 TM DT SWISS** by the Russian Trademark and Patent Office as the element SWISS was considered by the examination to be capable to mislead the consumers as to the origin of the applied goods. Furthermore, the Russian TMO cited three prior marks and some doublets in the goods specification. Since the holder of the opposed marks was the affiliated company with the applicant DT Swiss Deutschland GmbH, this ground of the refusal was easily overcome by submitting the Letter of Consent from DT Swiss AG (CH) and providing the documents confirming the connection between the companies. The doublets did not present a serious obstacle

as well. The key challenge was to overcome the deceitful character of the element SWISS.

Sometimes when the Russian TMO cites such a ground of the refusal as deceptiveness/misleading character of a trademark as to the origin of the applied goods/services, it can be overcome by providing the documents confirming the connection of the applicant as to the country to which, in the opinion of the Examiners, the trademark could refer. Such connection can be illustrated by the documents confirming, for instance, that the applicant buys raw materials or productions facilitates are situated in other state, or designers of goods are from that country in question. Like, for example, it was with IR 1013430 TM Solemar Alimentaria CALIDAD SUPERIOR PRODUCTO DE PATAGONIA whose Russian part faced a refusal from the Russian Trademark Office, though upon filing of the documents proving that the raw materials are indeed supplied from Patagonia, these

arguments were accepted by the Russian Examination at the Appeal stage though.

However, we should admit that the Russian Trademark Office imposes very tough requirements as to the marks that contains the elements representing geographical names while the applicant is from the country other than that one cited in the applied mark. In most cases the only possible solution to achieve trademark protection in Russia is to assign the applied mark in the name of the affiliated/branch company from the country a reference to which is allegedly included in the applied designation.

Let's revert to the aforesaid case of IR 1144607 for TM **DT SWISS**. This case was successfully resolved at the Appeal stage by assigning the Russian part of the international application in the name of Switzerland-based parent company - DT Swiss AG.

As we earlier mentioned, this ground is mostly often cited by the Russian Trademark Office, though the trademark legislation of other CIS states also prohibits registration on such a ground. For instance, in Ukraine we can mention the case of **IR 1229164 TM SWISSE** designating Ukraine, Russia and a series of other CIS countries. The applicant – the Turkish company - has no


connection to Switzerland to which the said mark could refer the consumers as it resembles and imitates the official name of the State (as it was cited in the provisional refusal decision issued by the Ukraine Trademark Office). Therefore, the arguments in favour of the fanciful character of this trademark submitted with the Ukrainian Trademark Office have limited chances of success.

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Deceptiveness/misleading character of a trademark as to kind/type/purpose of the applied goods or services:

We would like to dwell on several cases from our practice demonstrating the Office actions from the Russian and Ukrainian Trademark Offices issued on the aforesaid grounds and ways to resolve them.

1) **IR 1181935** TM

 designating Russia among other jurisdictions was filed for rather a wide range of goods including those not related to bedding and similar goods/services. Accordingly, the provisional refusal was issued for the subject mark by the Russian Trademark and Patent Office under which the element Bedding is descriptive as to some of the applied goods/services, whereas it is deceitful in respect of the rest of the goods/services applied for.

We advised the client to limit the list of allied goods/services to bedding and related goods/services and accept a disclaimer of the element Bedding, since it has no distinctive ability due to its descriptiveness in respect of the goods/services relating to bedding and therefore according to the Russian Trademark Law and Rules of Trademark examination it shall be excluded from protection.

RPTO accepted our arguments and issued the Grant of protection decision for IR 1181935 TM isbir Bedding in Russia in respect of the goods and services relating to bedding and similar goods/services with a disclaimer of the non-protectable element “BEDDING”.

2) National Trademark Application No. **m201406066** for the mark **W Watch** in the name of LG Electronics was filed in Ukraine in respect of the goods in classes 09, 10 and 14 covering the goods not relating to watches among other goods. Accordingly, the partial provisional refusal was issued for the subject mark by Ukraine Trademark and Patent Office for some goods in classes 09, 10 and 14, as the applied mark was considered by the Examination to be deceitful in respect of the applied goods that are not covered by the term “watches”. After filing an

Objection to Office action accepting the Examination's decision, the Grant of Protection decision was issued in Ukraine in respect of the following goods in class 14: *Watches with the function of wireless communications with electronic appliances such as smartphones, tablet computers, PDA, computers; watch bands with the function of wireless communications with electronic appliances such as smartphones, tablet computers, PDA, computers; wristwatches with the function of mobile communications; clocks; wristwatches; electronic clocks and watches; dials (clock and watch making); watch crystals; watch chains; watch cases; parts for watches; watch pouches.*

3) we should note that sometimes when the applied mark is refused on the ground of its deceitfulness in respect of the kind/purpose of goods/services such ground of the refusal can be overcome by submitting the arguments in favour of the fanciful character of the said mark of its acquired distinctiveness and fame among the consumers.

In this regard we would like to mention **IR 1177806 TM MONTURA** designating Russia covering classes 12, 18 and 25 was partially refused for all goods in class 25 as the verbal element "MONTURA" according to

the Russian Examination indicates the type of the applied goods (meaning "military dress, uniform"), therefore it can mislead the consumers as to the kind and purpose of products applied in class 25. Furthermore, several doublets in the class 25 goods specification were found by the Russian Examination, though it could easily be overcome by accepting their exclusion.

As for the deceitful character of the applied mark in respect of class 25, we advised the client to try overcome it by providing a solid package of the documents confirming the active long-term use of the said trademark in the territory of Russia before the filing date in respect of goods in class 25 and therefore, to prove the fact that the said trademark has become recognizable and identifiable within the relevant circles of Russian consumers. Upon submission of the evidences of trademark use along with the Objection, protection was granted by the Russian Trademark Office for **IR 1177806 TM MONTURA** in respect of class 25.

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Deceptiveness/misleading character of a trademark as to the goods

manufacturer/services provider:

This ground is one of the most often cited grounds of the refusal in Russia. However, in other CIS member states it could be faced by the applicant as well, though far more rarely.

The Patent and Trademark Offices examines the applied designations not only as to their confusability to prior trademarks but also as to the goods/services, which are available on the market already.

We can mention several cases successfully resolved by our company where such a ground of the refusal was cited by the Russian Trademark and Patent office.

1) **IR 1177055 TM TOTOLINK** designating Russia among other states was provisionally refused for all applied goods, since it was found to be misleading the consumers as to the manufacturer of goods, as the Examination refers to the website <http://www.totolink.net/>.

According to the information available on the aforesaid web-site "TOTOLINK is a brand of ZIONCOM TECHNOLOGY Ltd", which, as we supposed, is affiliated with the applicant company. Furthermore, according to the Whois

domain database the registrant of the aforesaid website is KOO JA CHUN, Seoul, Korea, who, as we assumed, is also connected to ZIANCOM Group of companies.

Accordingly, in order to try achieve trademark protection in Russia, we advised the client to provide the following documents to be filed with RPTO along with an Objection:

a) an extract from WHOIS database;

b) the Letter of Consent from Mr. KOO JA CHUN to registration of the applied designation in the applicant's name in Russia.

c) the document confirming the connection of Mr. KOO JA CHUN with the applicant ZIONCOM ELECTRONICS (SHENZHEN) LTD (with the English notarized translation);

d) the Letter of Consent from ZIONCOM TECHNOLOGY Ltd, which is mentioned as TOTOLINK brand owner on <http://www.totolink.net/> where the affiliation of the applicant and this company is mentioned:

e) the document confirming the affiliation of this company with the applicant ZIONCOM ELECTRONICS (SHENZHEN) LTD (with the English notarized translation);

The client was able to provide the aforesaid documents, though with regard to the abovementioned point e) it submitted the affidavit confirming that ZIONCOM ELECTRONICS (SHENZHEN) LTD and ZIONCOM TECHNOLOGY Ltd are two variants of the name of the applicant company. In support of this fact a corporation business license was also submitted. A set of these documents was filed with RPTO along with the Objection and allowed to achieve trademark protection in Russia.

2) The provisional refusal was issued by the Russian Trademark Office for IR 1045436 TM LA MARZOCCO, as it was considered by the Examiner to be capable to mislead the consumers as to the manufacturer of goods, because according to the information available on the website (<http://www.lamarzocco.com>) the products marked with TM La Marzocco are produced by Italy-based La Marzocco S.r.l, which is also a registrant of the aforesaid web-site, while the applicant is from the US.

Upon the receipt of the documents, confirming the connection of La Marzocco International, L.L.C with La

Marzocco S.r.l as well as the document where the Italy-based company La Marzocco S.r.l expressed its consent to registration of the applied trademark in Russia on behalf of the US-based company La Marzocco International, L.L.C the Objection to the provisional refusal was filed with RPTO and soon protection was granted for the subject mark in Russia.

In light of the above, we should note that when the applied mark is refused on such ground as deceptiveness/misleading character of a trademark as to the goods manufacturer/services provider, it shall be kept in mind that it will most likely be required to support the response to Office action with the documents confirming the connection of the applicant and the company to which the web-site cited by the Examination belongs and also from the web-site registrant, if it differs from the company mentioned on the web-site as well as the consent documents from this entities/individuals, otherwise, the chances of success to achieve trademark protection in Russia would be limited.

3) sometimes the applied trademarks are capable to mislead the consumers as to the goods manufacturer/services

provider, since they consist of or contain the names and/or surnames of famous persons, i.e., fashion designers, sports stars, movie stars, etc. Accordingly, in such cases it is impossible to register such a trademark without the consent of this person or his/her ancestors.

Furthermore, it shall be kept in mind that in some cases the applicant uses his/her own name in the mark, though in a short or slightly modified form. Like, for instance, it was with the case of **TM RON ABRAHAM IR 1127137**, which was provisionally refused in Russia for all goods, as it represents the name and surname, which are different from the applicant's name and surname, i.e. HAGEGE Ronald, and therefore it could mislead the consumers as to the manufacturer of applied goods.

Bearing in mind that the applicant's full name is Ronald Abraham Hagege, for

overcoming the refusal, it was sufficient to submit the document confirming the fact that Ronald Hagege and Ron Abraham is the same person with Ron Abraham being a short name for Ronald Abraham Hagege. Therefore the Objection was supported with a copy of the applicant's ID card (passport) where a full name is indicated.

In other cases the applicant can be the owner/CEO of the company in whose name protection of the mark is sought. Accordingly, in such cases it is, as a rule, sufficient to provide the documents confirming the fact that the person whose name and/or surname is used in the applied mark owns or runs the applicant company and to submit the Letter of Consent to registration of the subject mark in the name of this company.

We hope our overview of the recent cases from our practice of overcoming

provisional refusals for the trademarks applied and registered under the international and national procedure in the CIS region covering 12 jurisdictions - Ukraine, Russia, Belarus, Georgia, Armenia, Azerbaijan, Kazakhstan, Kyrgyzstan, Tajikistan, Turkmenistan, Uzbekistan, Moldova will be useful for IP practitioners and individual or corporate applicants who would like to achieve protection of their marks in the aforesaid jurisdictions.

We would be glad to offer our professional advice including free-of-charge preliminary opinion with the estimation of probable costs and assistance for IP matters in Russia, Ukraine, Belarus, Georgia, Armenia, Azerbaijan, Kazakhstan, Kyrgyzstan, Tajikistan, Turkmenistan, Uzbekistan and Moldova.



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2011 – Joined the IPR Group. Holds the position of Senior Trademark Administrator.

Her particular specialization within IP is management of trademark cases, including preparing trademark applications, searches, evaluation of provisional refusals, drafting of objections; trademark assignment and licensing; negotiating the letters of consent and co-existence agreements.

During the carrier Victoria has managed a lot of trademark cases, evaluated and successfully handled hundreds of provisional refusals in various jurisdictions of the CIS.

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