

# Observation and Case-study for Overcoming Provisional Refusals in Trademark Practice in CIS Member States

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**T**he Commonwealth of Independent States (CIS) was established in 1991 as a regional organization with participating countries of the former Soviet Union (SU) and unites 11 states with a cumulative population of about 280 million. Its role in integrating economic, social and cultural links between the member states leads to conclusion of numerous agreements in all spheres of life. Also these countries represent a huge market for distribution, which international foreign companies actively seek to penetrate. This case study includes information from Georgia as well, though it is not a member of CIS, it is a former SU republic state.

The procedure for obtaining a trademark

registration through national procedures in CIS countries is a full examination of the application. The first stage is the formal examination and the second is the substantive examination. Regular period for achieving trademark registration is 1-1.5 years. The only exception is Belarus, where the examination is held within 36 months, though an official procedure of acceleration is available. The registration is valid for 10 years from the filing date. The opposition period is provided by law in Armenia, Moldova, Georgia, and Turkmenistan both for national and international applications. In Azerbaijan there is an opposition period only for national registrations.

Declaration of Use is not required by the Patent and Trademark Office (PTO) during the period of registration or afterwards. Thus, the cancellation on the ground of non-use is possible by third parties after expiration of a grace period, which is 3 years from registration (publication) date in Kazakhstan, Kyrgyzstan, Russia, Tajikistan, Turkmenistan and Ukraine and 5 years from registration (publication) in Armenia, Azerbaijan, Belarus, Georgia, Moldova and Uzbekistan.

For more than a decade, starting in 1999, attorneys for the IPR Group have developed a wide range of tactics for handling IP matters. Observation of numerous cases and examples from the practices of IPR Group shows typical and non-typical obstacles for

trademark registrations and proper solutions realized in 12 CIS states. According to our practice, after having received the provisional refusal in one country where the trademark was designated to, it is likely to obtain the similar refusal in other countries with the same rules of examination.

1. During the trademark examination, it could be refused on absolute and relative grounds. Absolute grounds for refusal include justifications that the trademarks:

- are usually devoid of distinguishing capacity and do not obtain such a capacity through their use;
- consist exclusively of signs that are commonly used as the signs of goods and services of a certain type;
- consist exclusively of signs or data that are descriptive regarding use for goods and services defined in the application or with respect to them, in particular signs or data that indicate kind, quality, composition, quantity, properties, purposes, value of goods and services, the place and time of manufacturing or sale of goods or rendering of services;
- are deceptive or liable to mislead as to goods / services;
- consist exclusively of signs that are commonly used symbols and terms;
- present only the form caused by the natural state of goods, or by the necessity to obtain a specific technical result, or the form imparting the essential value to the goods.

The interpretation of the criterion of generally used symbols or terms and descriptiveness is common to all CIS countries.

According to the national trademark laws and examination practice, if descriptive elements or elements which do not possess the distinctive ability are used in the trademark, they can be included in the trademark as non-protected elements unless they do not occupy a dominant position. The provisional refusal of the trademark for the abovementioned reason is possible in Russia, Armenia, Kazakhstan, Uzbekistan, Tajikistan, Turkmenistan and Azerbaijan. For instance, we can name TM



IR 1005400, which was refused in Russia, Kazakhstan and Uzbekistan as the element “INTERNATIONAL” was considered by examiners as generally used term. There is only one way to overcome such kind of provisional refusal, and that is filing a response with the request for a disclamation of the non-protected element. In such countries as Ukraine, Georgia, Kyrgyzstan, Moldova, and Belarus, the protection will be granted to the trademark without disclamation, but it would be impossible to exercise an exclusive right for a separate element.

2. The lack of distinctive ability as a ground of provisional refusal is indicated by the examination in Russia, Uzbekistan, Kazakhstan and Kyrgyzstan if a trademark consists of a few letters or figures. In case the trademark is refused due to the lack of distinctiveness, in general, in Russia, Kyrgyzstan and Uzbekistan the protection could be granted by proving the distinctive ability obtained as a result of the trademark use in the state where trademark is applied for registration. The evidences should contain the information about trademark use before the date of application filing. They could be as follows:


- volumes of production and sales of product, marked by the applied trademark;
- territories of retail of the products marked by the applied trademark;
- duration of use of the declared

designation for marking of the goods indicated in Application;

- volumes of advertising expenses of the goods marked by the applied trademark;
- data on consumers level of knowledge of the applied trademark and of the goods producer the marked goods, including results of sociological surveys;
- data on publications about the products marked by the applied trademark in public media;
- data on exhibiting products marked by the applied trademark at expo-shows.

Provisional refusal based on similarity to earlier registration is as a common example of refusal on relative ground.



As an example of the provisional refusal grounded on confusing similarity we would like to mention the provisional refusal issued

for TM  Wincom Technologies IR 988591 by Patent and Trademark Offices in Russia and Ukraine. This case is illustrative for both aforementioned criteria.

In Russia the refusal was grounded on Art. 1483(3) of the Civil Code: descriptiveness of services, including indication of its kind, quality, quantity, property, purpose, value, or time, place and method of their manufacture or sale.

Trademark contains the verbal element “TECHNOLOGIES” that according to the Trademark Law and Rules of Trademark Examination is not eligible for protection.

The provisional refusal issued for IR 988591 TM WINNCOM TECHNOLOGIES was successfully overcome through filing a request for disclamation of the non-protectable element.

In Ukraine the refusal was grounded on similarity to national registrations for TM Vincom City Tower, TM  and TM VINCOMM . The statement of arguments used in the objection contained a few positions:

- dissimilarity by visual, phonetic and semantic criteria as besides the word elements, the applied trademark contained the logo design which increased the range of dissimilarity;
- the trademark was applied for using

a very specific list of services, while the opposed trademarks in class 35 possibly covered a wide list of standard terms of the class.

- the opposed trademarks had a heterogeneous list of services;
- information about the services offered by the applicant was well promoted over the Internet, which means there are the relevant circles of consumers who are familiar with and are able to identify the services provided under the applied trademark;
- word elements of the applied trademark are the part of the company's trade name.

The main feature of this case is that the objection was grounded on dissimilarity of circles of customers to whom the services under trademarks are addressed and channels of distribution as well as differences by visual, phonetic and semantic criteria, i.e. the typical criteria for assessing the likelihood of confusion.


In cases when the trademark is refused for granting right protection due to earlier registration, this trademark is likely to be provisionally refused in the rest of the countries of CIS region where the earlier trademark has been registered, while the chances to overcome refusals as well as the package of documents required to overcome the refusals will be quite similar.



The following analysis provides an insight into another one of the recent IP cases that has been successfully handled by the IPR Group Attorneys.

It concerns for example TM SIMpass IR 999750 and TM  IR 1000191 applied

for goods/services in class 09 of the Nice Classification, which were refused on the ground of similarity to TM SiPass IR 861635 in Ukraine, registered in favour of goods/services in classes 09, 38 of the Nice Classification, and similarity to TM SiPass IR 861635 registered in favour of goods/services in classes 09, 38 and TM SIMPAX IR 794053, registered in favour of goods/services in classes 09, 42 of the Nice Classification, in Russia. By proving the heterogeneity of the goods, difference in circles of consumers and distributions channels and some difference

in semantic meaning of the trademarks the refusals were successfully overcome. The right holder of the opposed registration specialized in manufacturing of security systems—Integrated Access Control system which is made to simplify physical security management by facilitating threat detection and identification. While the right holder of the applied trademarks used for mobile proximity payments was gaining global momentum, allowing people to use their handset for shopping, bus, subway etc. by simply tapping their mobile phone onto the contactless reader. The main feature of this case was that the objection was grounded mainly on dissimilarity of circles of customers and channels of distribution and to a less extent on dissimilarity of trademarks.

Another typical and non-typical case was TM  IR 1044020 and TM

 IR 1043658 faced with the provisional refusal issued in a number of CIS states, i.e. Ukraine, Georgia due to opposition to the earlier registered in these states TM Cadillac ATS. The non-typical feature of this case was that there was an opposed relating registration TM 

IR 543871 owned by an affiliated company (in Ukraine, Kazakhstan). For overcoming the refusals the Letters of Consent were submitted. In Ukraine, while submitting the Letter of Consent, it should be signed by the right holder of registration and contain its company stamp/seal. Requirements for the rest countries are the same. Notarization is required if there is no company stamp or seal. The only exclusion is Kazakhstan where the Letter of Consent authorization with apostil is obligatory.

The Letter of Consent can not be accepted if the trademarks are identical, as national law protects both a producer and a consumer. In such cases Letter of Consent does not protect the consumer from misleading as to the producer of the goods.

The other ground for refusal, which is the same in Ukraine and Georgia, was the opposition filed against the applied


trademarks by General Motors LLC, the owner of the prior national registration for TM Cadillac ATS. In Ukraine the responses were filed on the grounds that there were differences between the applied and opposed trademarks by visual, phonetic and semantic criteria. In objection IPR Group insisted on the fact that goods under the applied trademarks had already been known in Ukraine for many years, while the goods under TM Cadillac ATS were going to be produced at the end of 2012. The objection insisted on the fact that in Ukraine there's a relevant circle of customers who were well aware of the goods manufactured under applied trademarks.


In the objection IPR Group also indicated additional grounds for granting protection: verbal elements of applied trademarks are also a trade name related to the applicant and is protected without registration; the affiliated trademark IR 543871 also contains the ATS element and has earlier priority. Moreover, we drew the attention of the Examination to the fact that goods of the applicant are sold in the territory of Ukraine with the dominant element ATS, while General Motors production is known firstly for Cadillac, and element ATS is just name of the series. The objection also argued the fact, that serial name or model name, especially if it consists of a few letters/numbers, has low distinctive ability in the trademark. Letter and number combinations are largely used for the type of car model. E.g. Mercedes-Benz CLS, Mercedes-Benz SLK, Infiniti QX56, Infiniti EX35, Aston Martin DBS, Lexus GS, Lexus ES, Mazda RX7, Honda CRX etc.. The verbal elements which indicate the car name has dominant position and the index of the model without the car name could hardly define the exact good for an average consumer. Therefore the refusal was overcome and the protection was given to the specified list of goods, but none of the positions in class 12, which were of particular importance for the applicant, were refused.

The same argumentation could be used while filing the Appeal in Georgia, as there is no procedure for filing the Objection

against the provisional refusal notification, but only the Appeal procedure in this state.

As a non-typical reason for refusal a party can mention the confusing similarity to the prior trademark owned by an affiliated company or person. This kind of refusal could be overcome through proving the connection between right holders of the opposed and applied trademark. The other option is to assign the registration to one right holder.

One example of the application of this tactic was the case for TM  IR


1017745 and TM  IR 1017744 presently owned by MAN SE. It was refused on the ground of similarity to a few trademarks owned by an affiliated company and one trademark owned by the merged company. Similar refusals were issued in Russia, Ukraine, Moldova, Kazakhstan, and Uzbekistan. As the changing of ownership had not been recorded before the expiration of the deadline for filing the Objection, to overcome the refusals, the company used extracts from Trade Registers confirming the merger and Letters of Consent from the affiliated company.

3. The other particular feature of examination is requirements concerning the limitation of the list of goods in case it is required to overcome the refusal. Limitation of goods or services through national Trademark Offices is possible in Russia, Ukraine, Azerbaijan, Belarus, Moldova, Kyrgyzstan and Kazakhstan. In this case the PTO can issue the final decision and grant the protection to such a restricted list of goods. In Uzbekistan, Armenia, Georgia, Turkmenistan or Tajikistan any amendments are accepted only after confirmation of these amendments by the World Intellectual Property Organization (WIPO).

Representation through local attorneys is required to respond to an office action. Restrictions of the list of goods through national Trademark Offices allow right holders to avoid additional expenses for restriction through the WIPO.

4. Separately, one purpose of this analysis

is to note that the possibility of canceling the opposed registration on the ground of non-use in some cases is the only possible option and also an effective solution. Though in some countries, e.g. Azerbaijan, Kazakhstan, Moldova, Turkmenistan and Belarus, it is possible to do so through a special body in the structure of the Patent Offices; in other countries like Russia, Ukraine, Uzbekistan, Armenia, Georgia, Tajikistan and Kyrgyzstan, the cancellation on the ground of non-use is possible only through court proceeding. Because there are no specialized Patent Courts in CIS countries and considering the current condition of the court system, it is much better to file a cancellation procedure through PTO, which has more professional approaches to consider such cases.

This article outlines key issues that should be born in mind when applying for trademark registrations in the CIS region. Hopefully this in-depth and full-scale analysis will help potential applicants choose the best trademark registration strategy in order to avoid and overcome obstacles when registering for trademarks in CIS member states. 



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Since 2007: Managing Partner of the parent (Ukraine-based) company IPR GROUP;

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Mr. Kistersky went through all career stages from the beginning. He specializes in Trademark Law. Practice area: the appeal of decisions of the National Patent Offices (objections, appeals) and IP Litigation.



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Since 2009: Joined the IPR Group. Holds the position of Legal Adviser, and Trademark Administrator.

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