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Trademark opposition practice

By Ludmila M. Serova

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In our firm 's practice trademark registrations which reproduce well-known trademarks of foreign owners or similar to them meet routinely.

The grounds for getting such registrations by unfair players are quite clear, but it should be kept in mind that according to the Russian Trademark Law they might be opposed and canceled. We would like to illustrate the aforesaid with several examples. In 1997 the trademark WHITE & MACKAY was registered in the name of "FRINO " Ltd.,(Russia)with respect to services in Classes 35,36,part of services in Class 39,namely "transportation, packing and storing of goods excluding alcoholic drinks " and Class 42,namely "restaurants, hotels, realization of goods excluding alcoholic drinks ".

When it revealed, an opposition to said registration was filed for our client, the well-known producer of beverages, owner of the Russian trademark registration of WHITE & MACKAY, with respect to the goods in Class 33 "alcoholic beverages, whisky ".The opposition mentions that the registration in the name of "FRINO " Ltd .is obtained in violation of Article 7 (1)of the Russian Trademark Law, which prohibits a registration of designations confusingly similar to trademarks earlier registered in Russia by other individual or legal entity with respect to similar goods and services. Moreover, said registration of "Frino " Ltd. contradicts to Article 6 (2)of the Law that says "a registration should not be granted to a trademark which might mislead a consumer with respect to the person who renders services."Among arguments in the opposition we put the following. WHITE and MACKAY are common English surnames.

MACKAY might be associated with English or Scottish origin of the registration owner, which is not true in respect of "FRINO " Ltd. located in Ingushetiya, Russia.

From geographic sources it was showed that WHITE and MACKAY are also geographical names, i.e. WHITE is an island in South-East England, MACKAY is the name of the town in the State of Idaho (USA) and the name of the town in Australia. Also data about popularity of the mark WHITE & MACKAY were supplied, namely, that WHITE & MACKAY Scotch whiskey had been produced since 1844 and enjoyed by consumers all over the world. Additionally numerous registrations of said trademark

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throughout the world were presented to the Board of Appeals of the Russian PTO which accepted some of the arguments and stated that the opposed and the cited marks were similar in view of phonetic and semantic identity thereof, with high degree of visual similarity.

Some of the services in Classes 35,39,42 are related to the realization of goods, and in view of high degree of similarity of the compared marks, a consumer may misunderstand that all these services and goods belong to one and the same producer. Having considered all the grounds the Board of Appeals satisfied the opposition and canceled the registration of "Frino " Ltd. partially by deleting the services in Class 35 related to advertising, services in Class 39 related to transportation, delivery and storage of goods, services in Class 42 related to restaurants, hotels and realization of goods.

Another example of successful enforcement of trademark owner rights is cancellation of Cyrillic

trademark registration (in English –RAMKA) in the name of "Tandem " (Saint–Petersburg, Russia) for "butter and food fats " and other goods.

Said registration was opposed by Unilever N.V., one of the largest producers of butter and food fats, the owner of several registrations for RAMA, who had been spending large budget to advertise their trademark for several years and are still spending money for advertising of the products under mark RAMA. The products marked by RAMA are well known to Russian consumers. The Russian company decided to get a benefit from such popularity, filed an application for a Cyrillic trademark of PAMKA and obtain its registration. Non–Russian consumers do not see how much similar the Cyrillic words PAMA (in English RAMA) and PAMKA (in English RAMKA) are, and they need additional explanation. But first of all we should mention that Unilever N.V. who has been successfully marketing their products on the Russian market for many years, has not forgotten to register their mark in Cyrillic. Though many foreign companies neglect our advice and do not register Cyrillic versions of their trademarks. Anyway, Unilever N.V. got a registration for Cyrillic version of their trademark RAMA, namely, PAMA (in Cyrillic).

The word of RAMKA in Russian is a diminutive for RAMA and means a frame of smaller size. Thus the Cyrillic words in question of PAMKA and PAMA are similar against phonetic, semantic and visual criteria. While comparing the word of RAMA with Cyrillic PAMA, one could notice only phonetic similarity, but Cyrillic PAMA and Cyrillic PAMKA are similar also semantically and visually. The Board of Appeals accepted the arguments provided by GORODISSKY & PARTNERS and canceled the registration of the Russian company.

One more example is our opposition to the registration of SCANDY trademark.

The trademark of SCANDY was registered in the name of one Russian company with respect to such goods as "stainless kitchen sinks "in Class 6 and "sanitary technical equipment for bathrooms, sinks for kitchen "in Class 11.

Said registration was opposed by our client CANDY S.p.A., the Italian manufacturer of popular sanitary equipment and the owner of the well–known trademark CANDY in Russia.

Our opposition mentioned that the opposed trademark was confusingly similar to the trademark of CANDY earlier registered in the name of CANDY S.p.A. for similar goods, and therefore the opposed registration was granted in violation of Article 7(1) of the Russian Trademark Law. Trademark attorneys of GORODISSKY & PARTNERS provided comparative analysis against phonetic and visual criteria, and concluded that the marks were confusingly similar. The Board of Appeals accepted their arguments and canceled registration for SCANDY of the Russian company.

It should be mentioned that in this case the Russian company tried to appeal the Decision of the Board of Appeals at the Higher Patent Chamber of the Russian PTO but failed.

What Are Trademarks?

By David Sanders

Different companies, products and services have different trademarks but they are all aimed at creating a distinct symbol that will identify that particular product or company. The use of trademarks has legal implications and it is protected by the common law as well as Federal laws.

A trademark owner is entitled to the exclusive use of the trademark in the product specifically intended to be identified by the trademark or to other related product which he owns.

The trademark user and owner can register his trademark with the Patent Office. Any trademark can be registered for as long as it is not own by anyone and that the entity seeking its registration is already using or is planning to use the trademark in the future. However, unregistered trademarks are still protected under the common law as long as the owner can establish his use of the trademark.

A trademark can be a word or combination of words or symbols that differentiates a certain products from the others. Trademarks are different from patents and copyrights in the sense that a copyright is geared towards the protection of original works of art including music or literary works while a patent is geared towards the protection of an invention.

Why should individuals or companies register their trademarks if these are already protected by law even if they are unregistered? Registration of trademarks is encouraged because the fact of registration serves as legal and practical notice to the public that it is already being used and owned by another. The owner can also sue another entity in Federal Court, for using a registered trademark. Such registration can also be used as a basis for registering the same trademark in other countries.

Anyone can already use the trademarks sign "TM: or the service mark "SM" even if the marks have not yet been registered.

However, the Federal symbol of registration can only be used after the mark has been registered with the United States Patent and Trademark Office.

Registration of trademarks or service marks can be done through the internet. After submitting the form online, the registrant can expect an immediate reply or issuance of an initial receipt from the

Trademark Office. Applications can also be delivered to the Trademark Office.

The registration process is actually easy and self explanatory that there is no need to hire a lawyer. You must however comply with all the requirements for registration for a quick processing of your application.

The author is a regular contributor to

where more information about

business and trademarks is available.



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